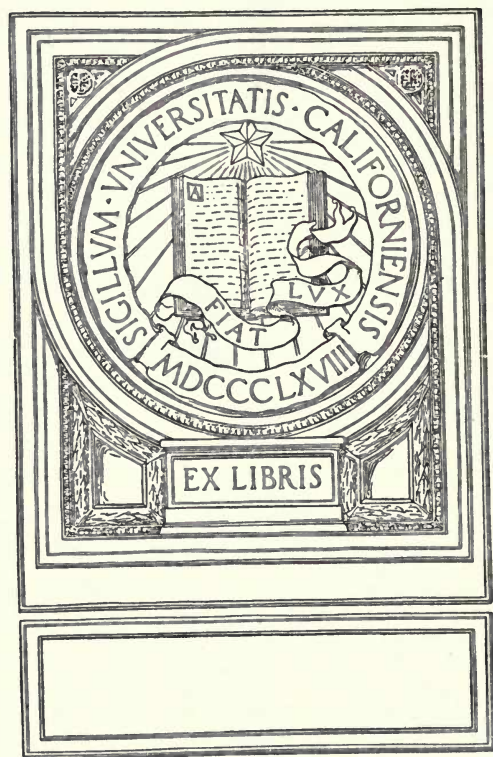


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# PATENTS

BY CHARLES HOLLAND DUELL\*

## I. NATURE OF PATENTS, 815

- A. *In General*, 815
  - 1. *Grant*, 815
  - 2. *No Common-Law Right*, 815
  - 3. *Consideration For Grant*, 816
  - 4. *Creation of Statute*, 816
  - 5. *Contract*, 816
  - 6. *Monopoly*, 816
- B. *Rights of Patentees*, 817
  - 1. *Nature of Right*, 817
  - 2. *Territory Covered by Right*, 817
  - 3. *Need Not Use Invention or License Others to Use*, 817
  - 4. *Right of Government to Use Invention*, 818
  - 5. *Government Cannot Cancel Patent*, 818
- C. *Patents as Property*, 819
  - 1. *Personal Property*, 819
  - 2. *Location*, 819
  - 3. *How Reached by the Courts*, 819
- D. *Constitutional Authority For Patents*, 819
  - 1. *In General*, 819
  - 2. *Grant to Inventors Not to Importers*, 820
  - 3. *Patents Granted by State*, 820

## II. SUBJECTS OF PATENTS, 820

- A. *Patentable Subject-Matter*, 820
  - 1. *In General*, 820
  - 2. *Statutory Classes of Invention*, 820
  - 3. *Physical Things Only Are Patentable*, 820
  - 4. *Result of Principle Not Patentable*, 821
  - 5. *Means Are Patentable*, 822
- B. *Art*, 822
  - 1. *In General*, 822
  - 2. *Must Produce Physical Result*, 824
  - 3. *Function Not Patentable*, 824
  - 4. *Independent of Apparatus*, 824
  - 5. *Chemical or Elemental Action*, 825
  - 6. *Mechanical Processes*, 825
  - 7. *Knowledge of Principles Involved Unnecessary*, 825
- C. *Machines*, 825
- D. *Manufacture*, 825
- E. *Composition of Matter*, 826
- F. *Improvement*, 826
  - 1. *In General*, 826
  - 2. *Superiority Unnecessary*, 826
- G. *Designs*, 827
  - 1. *In General*, 827
  - 2. *Term*, 828

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The author acknowledges valuable assistance from John M. Coit, Esq., of the Washington City Bar. Mr. Coit was for many years Law Clerk of the Patent Office and later Examiner-in-Chief.

268187

## III. PATENTABILITY, 828

A. *In General*, 828B. *Novelty*, 8281. *In General*, 8282. *Prior Knowledge in This Country*, 8293. *Extent of Prior Knowledge*, 8294. *Date of Knowledge*, 8295. *Prior Knowledge or Use Abroad*, 8296. *Publication or Patent Abroad*, 8307. *Novelty of Means*, 8308. *Novelty of Function or Result*, 8309. *Novelty of Form*, 83110. *Novelty in Combination*, 831C. *Anticipation*, 8321. *In General*, 832a. *Introductory Statement*, 832b. *Full Disclosure Necessary*, 832c. *Identity*, 832d. *General Knowledge of Public Unnecessary*, 834e. *Patentee's Knowledge of Anticipation Unnecessary*, 8352. *Prior Patents*, 835a. *In General*, 835b. *Foreign Patents*, 835c. *Paper Patents*, 836d. *Secret Patents*, 836e. *Sufficiency of Description*, 836f. *Failure to Claim Immaterial*, 8373. *Prior Publication*, 837a. *In General*, 837b. *Sufficiency of Publication*, 837c. *Sufficiency of Description*, 8384. *Prior Knowledge and Use*, 838a. *Sufficiency of Knowledge*, 838b. *Mental Idea Insufficient*, 838c. *Necessity For Perfected Invention*, 838d. *Necessity For Demonstration of Success*, 839e. *Abandoned or Unsuccessful Experiments*, 839f. *Models and Unpublished Drawings*, 840g. *Accidental Production of Invention*, 840h. *Lost Art*, 841i. *Combination of Old Elements*, 841j. *Non-Analogous Use*, 842k. *Evidence*, 842(I) *Presumptions and Burden of Proof*, 842(II) *Admissibility*, 842(A) *In General*, 842(B) *Application For Patent*, 843(III) *Weight and Sufficiency*, 844D. *Utility*, 8451. *In General*, 8452. *Evidence of Utility*, 846E. *Invention*, 8471. *Necessity*, 8472. *Nature*, 8473. *Invention and Discovery Synonymous*, 8484. *Prior Art Considered*, 8485. *Novelty and Superiority Not Invention*, 848



6. *Simplicity Does Not Negative*, 849
7. *Complexity Not Proof of Invention*, 849
8. *Mechanical Skill*, 849
9. *Superior Finish or Form Not Invention*, 850
10. *Difference in Degree Not Patentable*, 851
11. *Duplication of Parts*, 852
12. *Double Use*, 852
13. *New and Non-Analogous Use*, 854
14. *Substitution of Equivalents*, 855
  - a. *In General*, 855
  - b. *Superiority of Substituted Part No Test*, 856
15. *Substitution of Material*, 856
16. *Change of Location of Parts*, 857
17. *Omission of Parts*, 857
18. *Making Parts Integral or Separate*, 858
19. *Making Device Portable*, 858
20. *Combination*, 858
  - a. *In General*, 858
  - b. *Lack of Novelty in Elements Immaterial*, 859
  - c. *Coaction of Elements Necessary*, 859
21. *Aggregation*, 860
  - a. *In General*, 860
  - b. *Multiplication of Elements*, 861
  - c. *Novel Elements*, 861
22. *Evidence of Invention*, 861
  - a. *Unsuccessful Efforts of Others*, 861
  - b. *Supplying Long-Felt Want*, 862
  - c. *Popularity of the Supposed Invention*, 862
- F. *Statutory Forfeiture Regardless of Intent*, 863
  1. *In General*, 863
  2. *Publication Two Years Before Application*, 863
  3. *Foreign Patent*, 864
  4. *Concealment of Invention*, 864
  5. *Date of Application*, 864
  6. *Renewal or Substitute Application*, 864
  7. *Divisional Applications*, 865
  8. *Prior Public Use or Sale*, 865
    - a. *As Bar to Patent*, 865
    - b. *Nature of Use Sufficient to Bar Patent*, 866
      - (I) *In General*, 866
      - (II) *Single Instance Sufficient*, 866
      - (III) *Knowledge or Consent of the Inventor*, 866
      - (IV) *Invention Must Be Complete*, 867
      - (V) *Experimental Use*, 867
      - (VI) *Secret Use*, 867
      - (VII) *Natural and Intended Use*, 867
      - (VIII) *Use For Profit*, 867
      - (IX) *Use in a Foreign Country*, 868
    - c. *On Sale*, 868
      - (I) *In General*, 868
      - (II) *Single Sale Sufficient*, 868
      - (III) *Offer For Sale*, 868
      - (IV) *Sale For Experiment*, 868
      - (V) *Conditional Sale*, 869
      - (VI) *Perfected Invention*, 869
      - (VII) *Burden of Proof*, 869
- G. *Abandonment of Invention*, 869

1. *In General*, 869
2. *Question of Intent*, 870
3. *Express Abandonment*, 870
4. *Abandonment by Conduct*, 870
5. *Necessity of Disclosure to Public*, 871
6. *Abandoned Experiments*, 871
7. *Failure to Claim in Patent*, 871
8. *Abandonment of Application*, 871
9. *Evidence of Abandonment*, 872

#### IV. PERSONS ENTITLED TO PATENTS, 872

- A. *Original and First Inventor*, 872
  1. *In General*, 872
  2. *First Inventor*, 873
  3. *Originality of Invention*, 873
  4. *Citizenship of Inventor*, 874
  5. *Reduction to Practice*, 874
    - a. *In General*, 874
    - b. *Constructive Reduction to Practice*, 875
  6. *Diligence*, 876
  7. *Models, Drawings, and Description*, 877
  8. *Assistance by Others*, 877
  9. *Invention Made Abroad*, 878
  10. *Evidence as to Originality and Priority*, 878
    - a. *Presumptions and Burden of Proof*, 878
    - b. *Admissibility and Sufficiency*, 878
- B. *Joint Inventors*, 879
  1. *In General*, 879
  2. *Joinder and Grant*, 879
- C. *Employer and Employee*, 880
  1. *In General*, 880
  2. *Perfection of Employer's Ideas*, 881
  3. *Presumptions as to Inventorship*, 881
- D. *Government Employees*, 881
- E. *Assignees*, 882
- F. *Personal Representatives*, 882
- G. *Heirs*, 882
- H. *Guardian of Insane Person*, 882

#### V. APPLICATION AND PROCEEDINGS THEREON, 882

- A. *In General*, 882
- B. *Requisites of Application*, 882
  1. *In General*, 882
  2. *Specification or Description*, 883
    - a. *In General*, 883
    - b. *Matters of Common Knowledge*, 884
    - c. *Uses of Invention*, 884
    - d. *Philosophical Principles*, 885
    - e. *Improvements*, 885
    - f. *Concealment and Deception*, 885
  3. *Claims*, 886
    - a. *In General*, 886
    - b. *Vague, Indefinite, and Inaccurate Claims*, 886
    - c. *Must State Means, Not Function or Result*, 886
    - d. *Breadth of Claim*, 886
    - e. *Alternative Claims*, 887
    - f. *Multiplicity of Claims*, 887
  4. *Drawings*, 887



5. *Oath*, 888
  - a. *Necessity*, 888
  - b. *By and Before Whom Made*, 888
  - c. *Absence of Written Oath*, 888
6. *Fees*, 889
7. *Subject-Matter or Scope*, 889
- C. *Examination and Proceedings in Patent Office*, 889
  1. *In General*, 889
  2. *Rejection*, 890
  3. *Evidence at Hearing*, 890
  4. *Amendment*, 891
    - a. *In General*, 891
    - b. *New Matter*, 891
    - c. *Delay in Amending*, 891
    - d. *Oath*, 892
  5. *Allowance*, 892
  6. *Forfeiture and Renewal*, 892
  7. *Abandonment*, 892
  8. *Interference*, 892
    - a. *In General*, 892
    - b. *Between Applicants and Patentees*, 893
    - c. *Evidence*, 894
      - (I) *Burden of Proof*, 894
      - (II) *Admissibility and Weight and Sufficiency*, 895
    - d. *Pleadings*, 895
    - e. *Second Interference*, 896
  9. *Appeal*, 896
    - a. *In General*, 896
    - b. *Who Entitled to Appeal*, 896
    - c. *Formalities and Proceedings*, 897
    - d. *Appealable Decisions*, 897
    - e. *Review*, 898
    - f. *Time For Appeal*, 899
  10. *Caveats*, 899
    - a. *In General*, 899
    - b. *By Whom Filed*, 899
  11. *Secrecy of Applications and Caveats*, 900
  12. *Right to Inspect and Obtain Copies of Patent Office Records*, 900
  13. *Copies of Records*, 900
  14. *Rules of Patent Office*, 900
  15. *Conclusiveness and Effect of Patent Office Decisions*, 900
    - a. *In General*, 900
    - b. *As to Application and Procedure in Obtaining Patent*, 901
    - c. *As to Patentability*, 902
    - d. *As to Originality and Priority*, 902
    - e. *As to Abandonment*, 903
  16. *Remedy in Equity For Refusal of Patent*, 903
    - a. *In General*, 903
    - b. *Time and Place of Suit*, 904
    - c. *Burden of Proof*, 904

## VI. REQUISITES AND VALIDITY OF LETTERS PATENT, 904

- A. *Form and Contents*, 904
  1. *As an Instrument*, 904
  2. *Record*, 905
  3. *Date of Issue*, 905

- B. *Validity*, 905
  - 1. *In General*, 905
  - 2. *Sufficiency of Description*, 906
  - 3. *Name of Patentee*, 906
  - 4. *Deceptive Patent*, 906
    - a. *In General*, 906
    - b. *Suppression of Facts*, 907
  - 5. *Joinder of Several Inventions*, 907
  - 6. *Double Patenting*, 907
  - 7. *Claims*, 908
    - a. *In General*, 908
    - b. *Excessive Claims*, 909
  - 8. *Delay of Application in Patent Office*, 909
  - 9. *Jurisdiction to Determine Validity*, 909
- C. *Correction or Amendment of Patents*, 910
- D. *Interfering Patents*, 910
  - 1. *In General*, 910
  - 2. *Proceedings*, 910
  - 3. *Judgment*, 911
- E. *Annulment or Repeal*, 911
- F. *Estoppel to Dispute Validity*, 912
  - 1. *In General*, 912
  - 2. *Estoppel of Infringer*, 912
  - 3. *Estoppel of Assignor*, 913
  - 4. *Estoppel of Assignee, Grantee, or Licensee*, 914
  - 5. *Expired License*, 914

## VII. TERM, 915

- A. *In General*, 915
  - 1. *Mechanical Patents*, 915
  - 2. *Designs*, 915
  - 3. *Reissues*, 915
  - 4. *Limitation by Foreign Patent*, 915
    - a. *In General*, 915
    - b. *Identity of Invention*, 916
    - c. *Date of Foreign Patent*, 917
    - d. *Term of Foreign Patent*, 917
    - e. *Lapse or Expiration of Foreign Patent*, 917
- B. *Extensions*, 918

## VIII. REISSUES, 919

- A. *In General*, 919
  - 1. *Definition*, 919
  - 2. *Power to Reissue and Grounds*, 919
  - 3. *Persons Entitled to Reissue*, 920
  - 4. *Term*, 921
- B. *Time For Application*, 921
  - 1. *In General*, 921
  - 2. *Intervening Rights of Third Persons*, 921
  - 3. *Excuses For Delay*, 922
- C. *Identity of Invention*, 923
  - 1. *In General*, 923
  - 2. *New Matter*, 925
    - a. *In General*, 925
    - b. *Intention to Claim*, 925
    - c. *Apparatus, Process, and Product*, 926
  - 3. *Reinsertion of Canceled Claim*, 926



- D. *Surrender of Original Patent*, 926
- E. *Applications and Proceedings Thereon*, 927
  - 1. *In General*, 927
  - 2. *Divisional Reissues*, 927
- F. *Reissues of Reissued Patents*, 927
- G. *Conclusiveness and Effect of Patent Office Decisions*, 927
  - 1. *In General*, 927
  - 2. *As to Grounds For Reissue*, 928
  - 3. *As to Identity*, 928
- H. *Validity, Construction, and Operation of Reissues*, 929
  - 1. *Validity*, 929
  - 2. *Construction and Operation*, 929
    - a. *In General*, 929
    - b. *Retroactive Operation*, 930

#### IX. DISCLAIMERS, 930

- A. *In General*, 930
- B. *Subject-Matter of Disclaimer*, 930
- C. *Time For Disclaimer*, 931
- D. *Effect of Failure to Disclaim*, 931
- E. *Effect of Disclaimer*, 932

#### X. CONSTRUCTION AND OPERATION OF LETTERS PATENT, 932

- A. *In General*, 932
  - 1. *General Rules of Construction Relating to Contracts Applicable*, 932
  - 2. *Liberally Construed*, 933
  - 3. *Plain Meaning Not Varied*, 933
  - 4. *Intention of Inventor*, 934
  - 5. *Proceedings in Patent Office*, 934
  - 6. *Opinion of Experts*, 935
  - 7. *State of the Art*, 935
  - 8. *Patent as Notice*, 936
  - 9. *Questions For Court and Jury*, 936
- B. *Limitation of Claims*, 936
  - 1. *In General*, 936
  - 2. *Claims Construed by Specifications*, 938
  - 3. *Effect of Words "Substantially as Described" in Claim*, 939
  - 4. *Reference Letters*, 939
  - 5. *Equivalents*, 939
  - 6. *Pioneer Inventions*, 940
  - 7. *Improvements*, 940
  - 8. *Combination*, 941
  - 9. *Amendment in Patent Office*, 941
  - 10. *Separate Claims Distinguished*, 943
  - 11. *Designs*, 943

#### XI. TITLE, CONVEYANCES, AND CONTRACTS, 943

- A. *Assignments and Other Transfers*, 943
  - 1. *In General*, 943
    - a. *Assignability*, 943
    - b. *Who May Assign*, 943
      - (I) *In General*, 943
      - (II) *Joint Owners*, 943
  - 2. *Agreements to Assign*, 944
    - a. *In General*, 944
    - b. *Future Patents*, 944

- c. *Recording*, 945
  - d. *Actions*, 945
- 3. *Requisites and Validity*, 946
  - a. *In General*, 946
  - b. *Form and Contents*, 946
  - c. *Validity*, 947
- 4. *Recording*, 947
  - a. *In General*, 947
  - b. *Notice*, 948
  - c. *Acknowledgment Before Notary*, 948
- 5. *Construction and Operation*, 948
  - a. *In General*, 948
  - b. *Warranty*, 949
  - c. *Rights and Interests Conveyed*, 949
    - (I) *In General*, 949
    - (II) *Rights in Extended Term*, 950
    - (III) *Rights in Reissue*, 950
    - (IV) *After-Acquired Title*, 950
    - (V) *Rights of Action For Past Infringement*, 950
  - d. *Covenants, Conditions, and Restrictions*, 951
    - (I) *In General*, 951
    - (II) *Remedy For Breach of Conditions*, 951
      - (A) *Rescission or Cancellation*, 951
      - (B) *Recovery of Damages*, 951
- 6. *Rights, Remedies, and Liabilities of Parties*, 952
  - a. *In General*, 952
  - b. *As to Each Other*, 952
    - (I) *In General*, 952
    - (II) *Liability For, and Recovery Of, Consideration*, 952
    - (III) *Recovery Back of Consideration by Assignee*, 953
  - c. *As to Third Parties*, 953
- 7. *Transfer by Succession or Inheritance*, 954
- B. *Licenses and Contracts*, 954
  - 1. *Licenses*, 954
    - a. *In General*, 954
    - b. *Requisites and Validity*, 954
      - (I) *In General*, 954
      - (II) *Implied License*, 955
        - (A) *In General*, 955
        - (B) *From Sale of Patented Article*, 955
    - c. *Recording*, 956
    - d. *Construction and Operation*, 956
      - (I) *In General*, 956
      - (II) *Rights and Interests Conveyed*, 956
        - (A) *In General*, 956
        - (B) *Place For Exercise of License*, 957
          - (1) *Express License*, 957
          - (2) *Implied License*, 957
        - (C) *Duration of License*, 957
          - (1) *In General*, 957
          - (2) *In Extended Term*, 958
      - (III) *Covenants and Conditions*, 958
    - e. *Rights, Remedies, and Liabilities*, 959
      - (I) *In General*, 959
      - (II) *Enjoining Use of Invention*, 959
      - (III) *Liability For and Recovery Of Consideration For License*, 960



- f. *Assignments and Sublicenses*, 960
  - (i) *In General*, 960
  - (ii) *Assent to or Recognition of Assignment by Licensor*, 960
  - (iii) *Rights and Liabilities of Parties*, 961
- g. *Revocation, Forfeiture, or Other Termination*, 961
  - (i) *By Licensor*, 961
  - (ii) *By Licensee*, 962
  - (iii) *By Death of Licensee*, 962
  - (iv) *By Dissolution of Partnership or Corporation*, 962
  - (v) *Revival of Forfeited License*, 962
- 2. *Contracts*, 962
- 3. *Royalties*, 963
  - a. *Rights and Liabilities of Parties*, 963
    - (i) *When Royalties Due*, 963
    - (ii) *Amount of Royalty*, 963
    - (iii) *Persons Entitled to Royalties*, 964
    - (iv) *Persons Liable For Royalties*, 964
    - (v) *Lien*, 965
  - b. *Remedies*, 965
- C. *Enforcement of Assignments, Contracts, and Agreements*, 966

## XII. REGULATION OF DEALINGS IN PATENT RIGHTS AND PATENTED ARTICLES, 967

- A. *By Congress*, 967
  - 1. *Failure to Mark Patented Articles*, 967
  - 2. *Marking Unpatented Article*, 968
  - 3. *Penalties*, 968
    - a. *In General*, 968
    - b. *Infringement of Design Patents*, 969
- B. *By States*, 969

## XIII. INFRINGEMENT, 971

- A. *What Constitutes*, 971
  - 1. *In General*, 971
  - 2. *Making, Using, or Selling*, 972
  - 3. *Article Made Before Patent*, 972
  - 4. *Experimental Use*, 972
  - 5. *Knowledge or Intent of Infringer*, 973
  - 6. *Identity of Infringing Device*, 973
    - a. *In General*, 973
    - b. *Limitation of Claims*, 975
    - c. *Diversity of Use*, 975
    - d. *Combination*, 975
    - e. *Process*, 977
    - f. *Composition*, 978
    - g. *Substitution of Equivalents*, 979
      - (i) *In General*, 979
      - (ii) *What Are Equivalents*, 980
      - (iii) *Necessity For Knowledge of Equivalent at Date of Patent*, 982
    - h. *Omission of Parts*, 983
    - i. *Addition of Parts*, 984
    - j. *Transposition of Elements*, 984
    - k. *Repair*, 985
      - 1. *Superiority or Inferiority as a Test of Infringement*, 986
    - m. *Patented Improvement*, 987

7. *Designs*, 988
8. *Infringement After Expiration of Patent*, 989
- B. *Contributory Infringement*, 989
  1. *In General*, 989
  2. *Selling Parts of Patented Invention*, 989
  3. *Selling Article Used With Patented Invention*, 990
  4. *Miscellaneous*, 991
- C. *Suits*, 991
  1. *In General*, 991
  2. *Jurisdiction*, 991
    - a. *In General*, 991
    - b. *Suit For an Accounting*, 992
    - c. *Expiration of Patent*, 993
  3. *Place to Sue*, 993
  4. *Grounds*, 994
  5. *Conditions Precedent*, 994
  6. *Defenses*, 994
    - a. *In General*, 994
    - b. *Estoppel*, 995
    - c. *Combination in Restraint of Trade*, 995
    - d. *Limitations and Laches*, 996
      - (i) *Limitations*, 996
      - (ii) *Laches*, 996
        - (A) *In General*, 996
          - (1) *As Bar to Permanent Injunction*, 996
          - (2) *As Bar to Preliminary Injunction*, 997
          - (3) *As Bar to Accounting For Profits*, 998
        - (B) *Excuses For Delay*, 998
          - (1) *Ignorance of Infringement*, 998
          - (2) *Other Excuses*, 998
        - (c) *Laches of Prior Owner*, 999
7. *Persons Entitled to Sue and Parties Plaintiff*, 999
  - a. *In General*, 999
  - b. *Licenses*, 1000
    - (i) *In Suits Against Strangers*, 1000
    - (ii) *In Suits Against Patentee*, 1001
8. *Persons Liable and Parties Defendant*, 1001
  - a. *In Actions at Law*, 1001
  - b. *In Suits in Equity*, 1002
    - (i) *Persons Liable*, 1002
      - (A) *Private Corporations and Their Officers*, 1002
      - (B) *Officers of United States*, 1002
      - (C) *Joint Owner of Patent*, 1003
      - (D) *Agents and Servants*, 1003
      - (E) *Joint and Several Liability*, 1003
    - (ii) *Parties*, 1003
      - (A) *In General*, 1003
      - (B) *Receivers of Private Corporation*, 1004
      - (C) *Agents and Servants*, 1004
  - c. *Addition or Substitution of Parties*, 1004
9. *Joinder of Causes of Action*, 1004
10. *Suit on Separate Claims of One Patent*, 1005
11. *Injunctions*, 1005
  - a. *In General*, 1005
  - b. *Preliminary Injunction*, 1006
    - (i) *In General*, 1006
    - (ii) *Issuance and Validity of Patent*, 1008



- (III) *Public Acquiescence in Validity*, 1010
- (IV) *Previous Adjudications*, 1010
  - (A) *As a Prerequisite to the Allowance of Injunctions*, 1010
  - (B) *As a Ground For Refusing or Granting Injunctions*, 1011
  - (C) *Effect on Question of Infringement*, 1013
- (V) *Terms and Conditions*, 1013
- (VI) *Indemnity Bond*, 1014
- (VII) *Application and Proceedings Thereon*, 1014
- (VIII) *Consideration and Judgment on Motion*, 1015
- (IX) *Modifying or Dissolving*, 1015
- c. *Permanent Injunction*, 1016
- d. *Violation and Punishment*, 1016
  - (I) *Writ or Mandate Violated*, 1016
  - (II) *Knowledge or Notice*, 1017
  - (III) *Who Liable*, 1017
  - (IV) *Acts or Conduct Constituting Violation*, 1017
  - (V) *Defenses*, 1018
  - (VI) *Proceedings to Punish*, 1018
    - (A) *Notice*, 1018
    - (B) *Evidence*, 1019
    - (C) *Hearing and Determination*, 1019
  - (VII) *Punishment*, 1020
    - (A) *Matters Considered in Mitigation*, 1020
    - (B) *Amount of Fine*, 1020
    - (C) *Distribution of Fine*, 1020
  - (VIII) *Costs*, 1020
- 12. *Damages and Profits*, 1020
  - a. *Damages in Actions at Law*, 1020
    - (I) *Right to Recover and Form of Action*, 1020
    - (II) *Amount Recoverable*, 1020
      - (A) *In General*, 1020
      - (B) *Counsel Fees and Expenses*, 1023
      - (C) *Interest*, 1023
      - (D) *Double and Treble Damages*, 1023
    - (III) *Designs*, 1023
    - (IV) *Effect of Recovery*, 1024
  - b. *Profits and Damages in Suits in Equity*, 1024
    - (I) *In General*, 1024
    - (II) *Estimation of Profits and Damages*, 1025
- 13. *Pleadings*, 1029
  - a. *In Actions at Law*, 1029
    - (I) *In General*, 1029
    - (II) *Declaration or Complaint*, 1029
    - (III) *Plea or Answer*, 1029
      - (A) *In General*, 1029
      - (B) *Notice of Special Matter of Defense*, 1030
  - b. *In Suits in Equity*, 1031
    - (I) *Bill*, 1031
    - (II) *Plea or Answer*, 1033
      - (A) *Plea*, 1033
        - (1) *In General*, 1033
        - (2) *Requisites and Sufficiency*, 1034
        - (3) *Effect of Setting Down For Argument*, 1034
      - (B) *Answer*, 1034

- (1) *Matters Required to Be Raised by Answer*, 1034
- (2) *Requisites and Sufficiency*, 1034
- (3) *Amendment*, 1035
- (4) *Admissions in Answer*, 1035
- (5) *Notice of Special Matter*, 1036
  - (a) *Necessity*, 1036
  - (b) *Sufficiency*, 1037
  - (c) *Verification*, 1037
  - (d) *Waiver*, 1037
- (III) *Cross Bill*, 1037
- (IV) *Supplemental Bill*, 1037
- (V) *Demurrer and Exceptions*, 1037
- (VI) *Amendments, Variance, and Multifariousness*, 1038
- 14. *Evidence*, 1039
  - a. *In General*, 1039
  - b. *Presumptions and Burden of Proof*, 1040
  - c. *Evidence as to Invalidity of Patent*, 1041
  - d. *Expert Witnesses*, 1042
  - e. *Estoppel*, 1042
  - f. *Evidence as to Infringement*, 1042
  - g. *Secret Inventions*, 1042
  - h. *Proving Patents and Patent Office Records*, 1042
  - i. *Judicial Notice*, 1043
- 15. *Issues, Proof, and Variance*, 1043
- 16. *Trial in Actions at Law*, 1044
  - a. *In General*, 1044
  - b. *Questions For Court and Jury*, 1044
- 17. *Hearing in Suits in Equity*, 1045
  - a. *Questions Determined*, 1045
  - b. *Submission of Issues to Jury*, 1046
  - c. *Reception of Evidence*, 1046
  - d. *Dismissal*, 1047
    - (I) *At What Stage of Cause Allowable*, 1047
    - (II) *Grounds*, 1047
    - (III) *Dismissal Without Prejudice*, 1047
    - (IV) *Operation and Effect*, 1047
- 18. *Interlocutory Decree and Accounting*, 1047
  - a. *Interlocutory Decree*, 1047
  - b. *Proceedings in Accounting*, 1048
- 19. *Costs*, 1049
  - a. *In Actions at Law*, 1049
  - b. *In Suits in Equity*, 1050
- 20. *Appeal and Error*, 1051
  - a. *In Actions at Law*, 1051
  - b. *In Suits in Equity*, 1051
    - (I) *Final Decree*, 1051
    - (II) *Interlocutory Decree*, 1051
- 21. *Rehearing*, 1053
- D. *Threats of Suit*, 1054
- E. *Operation and Effect of Decision*, 1054
  - 1. *In General*, 1054
  - 2. *Recovery by Patentee as Vesting Title in Infringer*, 1056

## CROSS-REFERENCES

For Matters Relating to:

Copyright, see COPYRIGHT.

Injunction to Restrain Slander of Title, see INJUNCTIONS.



For Matters Relating to — (*continued*)

Mandamus to Compel Issuance of Patent, see **MANDAMUS**.

Monopoly, see **MONOPOLIES**.

Patent For Land :

In General, see **PUBLIC LANDS**.

Land Under Water, Cancellation of, see **NAVIGABLE WATERS**.

Mineral Land, see **MINES AND MINERALS**.

Trade-Mark or Trade-Name, see **TRADE-MARKS AND TRADE-NAMES**.

## I. NATURE OF PATENTS.

**A. In General — 1. GRANT.** A patent for an invention is a grant by the state to the inventor, his heirs or assigns, of the exclusive right to make, use, and vend the thing patented for a definite period of time.<sup>1</sup> The inventor has a natural right to make, use, and vend his invention, and therefore the patent confers upon him no right save the right to exclude others from making, using, or selling his invention.<sup>2</sup>

**2. No COMMON-LAW RIGHT.** At common law the inventor has no right to prevent others from using his invention,<sup>3</sup> but he may keep it secret and in that way deprive the public of its benefits.

1. U. S. Rev. St. (1878) § 4884 [U. S. Comp. St. (1901) p. 3381].

Other definitions are: "A grant made by the government to an inventor, conveying and securing to him the exclusive right to make and sell his invention for a term of years." Black L. Dict.

"Public franchises granted to the inventors of new and useful improvements for the purpose of securing to them, as such inventors, for the limited term therein mentioned, the exclusive right and liberty to make and use and vend to others to be used their own inventions, as tending to promote the progress of science and the useful arts, and as matter of compensation to the inventors for their labor, toil, and expense in making the inventions, and reducing the same to practice for the public benefit, as contemplated by the Constitution and sanctioned by the laws of Congress." *Seymour v. Osborne*, 11 Wall. (U. S.) 516, 533, 20 L. ed. 33.

"Patent right."—"A monopoly of a certain way of doing a thing. It is an exclusive right of way, in the region of invention, secured to one for a limited period as a compensation for having first discovered it" (*Vose v. Singer*, 4 Allen (Mass.) 226, 230, 81 Am. Dec. 696, where it is said to be analogous to a right of way or a right to collect tolls); "the exclusive liberty conferred by letters patent from the sovereign on an inventor or his alienee of making and vending articles according to his invention" (*Avery v. Wilson*, 20 Fed. 856, 858); "the right, protected by letters patent, to use the process, combination, or appliance, discovered by the patentee, for the production of a certain result" (Com. v. Central Dist., etc., Tel. Co., 145 Pa. St. 121, 127, 22 Atl. 841, 27 Am. St. Rep. 677); "the right to make, use or vend a patented invention, or inventions claimed to be patented" (*State v. Peck*, 25 Ohio St. 26, 28); a right which is said to "resemble a franchise in being a

privilege which concerns, and is intended to benefit the public, which depends for existence and preservation upon the authority which confers it" (*Crown Cork, etc., Co. v. State*, 87 Md. 687, 698, 40 Atl. 1074, 67 Am. St. Rep. 371); it has also been said to be an exclusive right, a monopoly (*Gilbert El. R. Co. v. Kobbe*, 70 N. Y. 361, 370; *King v. Platt*, 37 N. Y. 155, 4 Transcr. App. 19, 3 Abb. Pr. N. S. 434, 35 How. Pr. 23); and is "incorporeal property, not susceptible of actual delivery or possession" (*Waterman v. Mackenzie*, 138 U. S. 252, 260, 11 S. Ct. 334, 34 L. ed. 923).

"Patented."—A thing is "patented" by the actual issuance of the patent under the seal of the government, speaking the exercise of sovereign will, investing the patentee with the grant of a monopoly, and does not mean the preliminary proceedings. *Edison Electric Light Co. v. Waring Electric Co.*, 59 Fed. 358, 364.

2. "A patent does not confer even the right to use the invention. The inventor had that right before. It is merely an incorporeal right to exclude others from using the invention throughout the United States conferred by the government upon compliance with certain requirements." *Jewett v. Atwood Suspender Co.*, 100 Fed. 647, 648. See also *Patterson v. Kentucky*, 97 U. S. 501, 24 L. ed. 1115; *Seymour v. Osborne*, 11 Wall. (U. S.) 516, 20 L. ed. 33; *Bloomer v. McQuewan*, 14 How. (U. S.) 539, 14 L. ed. 532; *Fruit-Cleaning Co. v. Fresno Home-Packing Co.*, 94 Fed. 845.

The government makes no transfer to the patentee of a right preferred, or estate therefore vested in itself.—The essential right is in the inventor before he obtains the patent. *Western Electric Co. v. Sperry Electric Co.*, 59 Fed. 295, 296, 8 C. C. A. 129.

3. *Dudley v. Mayhew*, 3 N. Y. 9; *Patterson v. Kentucky*, 97 U. S. 501, 24 L. ed.



**3. CONSIDERATION FOR GRANT.** In order that inventions may be disclosed to the public so that all may obtain the benefits,<sup>4</sup> the state grants to the inventor the exclusive right to make, use, and vend the invention for a limited time on condition that the inventor furnish such full, clear, and exact description of the invention as will enable those skilled in the art to which it relates, or to which it is most nearly related, to make and use it after the expirations of the patent.<sup>5</sup>

**4. CREATION OF STATUTE.** The exclusive right which inventors have to their inventions is statutory,<sup>6</sup> and therefore statutory provisions must be complied with in all essentials.<sup>7</sup>

**5. CONTRACT.** While a patent is a grant, it also has the elements of a contract, since it is based upon consideration flowing from the inventor to the public represented by the officials of state.<sup>8</sup>

**6. MONOPOLY.** While, under the patent laws, a patent creates a monopoly,<sup>9</sup> it is not a monopoly of what existed before and belonged to others—which is the true idea of a monopoly—but is a monopoly of what did not exist before and what belongs to the patentee.<sup>10</sup> In consequence it does not create an odious monopoly,<sup>11</sup> and the rights of patentees thereunder are to be liberally construed,<sup>12</sup>

1115; Gayler v. Wilder, 10 How. (U. S.) 477, 13 L. ed. 504; Wilson v. Rousseau, 4 How. (U. S.) 646, 11 L. ed. 1141; Wheaton v. Peters, 8 Pet. (U. S.) 591, 8 L. ed. 1055; *In re* Dann, 129 Fed. 495; Rein v. Clayton, 37 Fed. 354, 3 L. R. A. 78; American Hide, etc., Splitting, etc., Mach. Co. v. American Tool, etc., Co., 1 Fed. Cas. No. 302, 4 Fish. Pat. Cas. 284, Holmes 503; Latta v. Shawk, 14 Fed. Cas. No. 8,116, 1 Bond 259, 1 Fish. Pat. Cas. 465; Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co., 78 Off. Gaz. 171. And see *infra*, I, A, 4.

**4.** The benefit to the public by the disclosure of inventions is the primary consideration for the grant of patents (Kendall v. Winsor, 21 How. (U. S.) 322, 16 L. ed. 165; Grant v. Raymond, 6 Pet. (U. S.) 218, 8 L. ed. 376; Rubber Tire Wheel Co. v. Milwaukee Rubber Works Co., 154 Fed. 358, 83 C. C. A. 336; International Tooth Crown Co. v. Hanks' Dental Assoc. 111 Fed. 916; Liardet v. Johnson, Buller N. P. 76; Newbery v. James, 2 Meriv. 446, 16 Rev. Rep. 195, 35 Eng. Reprint 1011), the interests of the public in the granting of patents being paramount to those of inventors (Warner v. Smith, 13 App. Cas. (D. C.) 111).

The purpose of granting temporary monopoly is to induce disclosure. Gayler v. Wilder, 11 How. (U. S.) 477, 13 L. ed. 504; Carr v. Rice, 5 Fed. Cas. No. 2,440, 1 Fish. Pat. Cas. 198; Goodyear v. New Jersey Cent. R. Co., 10 Fed. Cas. No. 5,563, 1 Fish. Pat. Cas. 626, Wall. Jr. 356.

**5.** U. S. Rev. St. (1878) § 4888 [U. S. Comp. St. (1901) p. 3383]. See *infra*, V, A, 2, a.

**6.** Marsh v. Nichols, 128 U. S. 605, 9 S. Ct. 168, 32 L. ed. 538; Gayler v. Wilder, 10 How. (U. S.) 477, 13 L. ed. 504; U. S. v. American Bell Tel. Co., 32 Fed. 591; Latta v. Shawk, 14 Fed. Cas. No. 8,116, 1 Bond 259, 1 Fish. Pat. Cas. 465. And see *supra*, I, A, 2.

**7.** Pennock v. Dialogue, 2 Pet. (U. S.) 1, 7 L. ed. 327; U. S. v. American Bell Tel. Co., 32 Fed. 591.

**8.** A patent is a contract and the same rules of construction apply as in other contracts. National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co., 106 Fed. 693, 45 C. C. A. 544; Atty.-Gen. v. Rumford Chemical Works, 32 Fed. 608; Harris v. Allen, 15 Fed. 106. A patent is a contract. O. H. Jewell Filter Co. v. Jackson, 140 Fed. 340, 72 C. C. A. 304; Barter v. Smith, 2 Can. Exch. 455.

**Renewal or extension.**—There is no contract by the state that the public may use the invention at the expiration of the patent and therefore the state may renew or extend the patent. Evans v. Eaton, 8 Fed. Cas. No. 4,559, Pet. C. C. 322, 1 Robb Pat. Cas. 68 [reversed in 3 Wheat. 454, 4 L. ed. 433].

**9.** Bement v. National Harrow Co., 186 U. S. 70, 22 S. Ct. 747, 46 L. ed. 1058.

**10.** Davoll v. Brown, 7 Fed. Cas. No. 3,662, 2 Robb Pat. Cas. 303, 1 Woodb. & M. 53; Goodyear v. New Jersey Cent. R. Co., 10 Fed. Cas. No. 5,563, 1 Fish. Pat. Cas. 626, 2 Wall. Jr. 356; Singer v. Walmsley, 22 Fed. Cas. No. 12,900, 1 Fish. Pat. Cas. 558.

**11.** Blanchard v. Sprague, 3 Fed. Cas. No. 1,518, 1 Robb Pat. Cas. 734, 742, 2 Story 164, 3 Sumn. 535; Goodyear v. New Jersey Cent. R. Co., 10 Fed. Cas. No. 5,563, 1 Fish. Pat. Cas. 626, 2 Wall. Jr. 356; Parker v. Stiles, 18 Fed. Cas. No. 10,749, Fish. Pat. Rep. 319, 5 McLean 44; Wickersham v. Singer, 29 Fed. Cas. No. 17,610, McArthur Pat. Cas. 645; Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co., 78 Off. Gaz. 171; Barter v. Smith, 2 Can. Exch. 455.

**Statute of monopolies.**—Patents are exempt from the statute of monopolies. Peck v. Hinds, 67 L. J. Q. B. 272.

**12.** De la Vergne Refrigerating Mach. Co. v. Featherstone, 147 U. S. 209, 13 S. Ct. 283, 37 L. ed. 138; Lein v. Myers, 97 Fed. 607; McBride v. Kingman 72 Fed. 908; Fitch v. Bragg, 8 Fed. 588; Goodyear v. New Jersey Cent. R. Co., 10 Fed. Cas. No. 5,563, 1 Fish. Pat. Cas. 626, 2 Wall. Jr. 356;



and in harmony with the intent and purpose of the patent law and doubts resolved in their favor.<sup>13</sup>

**B. Rights of Patentees<sup>14</sup> — 1. NATURE OF RIGHT.** The grant of a patent gives nothing to the patentee except the right to exclude others from making, using, or selling his invention;<sup>15</sup> but the right is transferable by an instrument in writing.<sup>16</sup>

**2. TERRITORY COVERED BY RIGHT.** The right conferred by a patent extends to all territory mentioned in the grant and in the statutes authorizing the grant.<sup>17</sup> In the United States it extends throughout the several states and territories,<sup>18</sup> but not to unorganized territory in its possession;<sup>19</sup> nor are the rights of the patentee operative outside of the limits of the United States.<sup>20</sup> While the rights extend to American vessels on the high seas,<sup>21</sup> they do not extend to foreign vessels in our ports.<sup>22</sup>

**3. NEED NOT USE INVENTION OR LICENSE OTHERS TO USE.** In the United States the inventor does not forfeit his patent or his right to exclude others from using his invention by his failure to make use of it himself,<sup>23</sup> or his refusal to license others to use it upon reasonable terms.<sup>24</sup> The question of licensing others to use his invention is one which the patentee alone has the right to answer, and courts cannot lawfully compel him to make use of his invention, or to permit others to use it against his will.<sup>25</sup> In many countries it is required that the invention be worked or the patent is void.<sup>26</sup>

*Wickersham v. Singer*, 29 Fed. Cas. No. 17,610, *McArthur Pat. Cas.* 645.

Patentees are a meritorious class and all the aid and protection which the law allows this court will cheerfully give them. *Holloway v. Whiteley*, 4 Wall. (U. S.) 522, 18 L. ed. 335.

13. *McMichael, etc., Mfg. Co. v. Stafford*, 105 Fed. 380.

14. As affected by local laws see *infra*, XII, B.

15. *Patterson v. Kentucky*, 97 U. S. 501, 24 L. ed. 1115; *Seymour v. Osborne*, 11 Wall. (U. S.) 516, 20 L. ed. 33; *Jewett v. Atwood Suspendor Co.*, 100 Fed. 647.

In Canada it is held that the patentee cannot import or permit others to import patented articles without invalidating patent. *Anderson Tire Co. v. American Dunlop Tire Co.*, 5 Can. Exch. 82; *Wright v. Bell Tel. Co.*, 2 Can. Exch. 552; *Mitchell v. Hancock Inspirator Co.*, 2 Can. Exch. 539; *Barter v. Smith*, 2 Can. Exch. 455.

16. U. S. Rev. St. (1878) § 4898.

17. *Brown v. Duchesne*, 19 How. (U. S.) 183, 15 L. ed. 595.

In England the patent is effective throughout the United Kingdom and the Isle of Man. Act (1883), § 16; 46 & 47 Vict. c. 57.

18. U. S. Rev. St. (1878) § 4884 [U. S. Comp. St. (1901) p. 3381].

19. Opinion Atty.-Gen., 113 Off. Gaz. 2503, the doctrine being applied in respect of the Panama canal zone.

20. *Brown v. Duchesne*, 19 How. (U. S.) 183, 15 L. ed. 595.

21. *Gardiner v. Howe*, 9 Fed. Cas. No. 5,219, 2 Cliff. 462.

22. *Brown v. Duchesne*, 19 How. (U. S.) 183, 15 L. ed. 595.

23. *James v. Campbell*, 104 U. S. 356, 26 L. ed. 786; *Packard v. Lacing-Stud Co.*, 70 Fed. 66, 16 C. C. A. 639; *Massey v. Johnston*, 59 Fed. 613; *Campbell Printing-Press,*

*etc., Co. v. Manhattan R. Co.*, 49 Fed. 930 [*disapproving* *Hoe v. Knap*, 27 Fed. 204].

Although never used commercially, the patent is *prima facie* valid. *McKay-Copeland Lasting Mach. Co. v. Copeland Rapid-Last Mfg. Co.*, 77 Fed. 306.

Non-user of a patent does not cause a forfeiture of a patent, nor ordinarily does it justify a court of equity in withholding injunctive relief. *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405, 28 S. Ct. 748.

In England the patentee, if he fails to manufacture under his patent within four years after its grant, may have it revoked. He may also be required to grant a license under it on terms to be fixed. Act (1907), §§ 27, 24.

24. *Wilson v. Rousseau*, 4 How. (U. S.) 646, 11 L. ed. 1141; *Grant v. Raymond*, 6 Pet. (U. S.) 218, 8 L. ed. 376; *Massey v. Reiber*, 59 Fed. 614; *Campbell Printing-Press, etc., Co. v. Manhattan R. Co.*, 49 Fed. 930; *Consolidated Roller-Mill Co. v. Coombs*, 39 Fed. 803; *U. S. v. American Bell Tel. Co.*, 29 Fed. 17; *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 78 Off. Gaz. 171. *Contra, dictum*, in *Hoe v. Knap*, 27 Fed. 204.

25. *Consolidated Roller-Mill Co. v. Coombs*, 39 Fed. 803.

26. The patentee must actually manufacture the article in Canada within two years after the patent, and must stand ready to furnish the article at a reasonable price or license others to do so. Importation from abroad invalidates the patent. *Power v. Griffin*, 33 Can. Sup. Ct. 39; *Hambly v. Albright*, 7 Can. Exch. 363; *Auer Incandescent Light Mfg. Co. v. O'Brien*, 5 Can. Exch. 243; *Royal Electric Co. v. Edison Electric Co.*, 2 Can. Exch. 576; *Brook v. Broadhead*, 2 Can. Exch. 562; *Toronto Tel. Mfg. Co. v. Bell Tel. Co.*, 2 Can. Exch. 524; *Barter v. Smith*, 2



**4. RIGHT OF GOVERNMENT TO USE INVENTION.** Although the consent of the owner of a patented device is not positively necessary in order to enable the United States government to use the invention described in the letters patent, particularly in cases where it relates to the mode of construction of implements of warfare needed by the government,<sup>27</sup> it has no right to use a patented invention without compensation to the patentee.<sup>28</sup> When it grants letters patent for a new invention or discovery in the arts, it confers upon the patentee an exclusive property in the patented invention which cannot be appropriated or used by the government itself, without just compensation, any more than it can appropriate or use without compensation land which has been patented to a private purchaser.<sup>29</sup> Nevertheless, no injunction can be obtained against the government or against an official acting for the government,<sup>30</sup> unless expressly permitted by act of congress,<sup>31</sup> nor can suit be maintained against the government for damages for infringement. It is not liable to suits founded in tort.<sup>32</sup> While compensation can be obtained by suit on an express or implied contract, this is the only method by which it may be obtained.<sup>33</sup>

**5. GOVERNMENT CANNOT CANCEL PATENT.** In the United States a patent cannot be canceled by any officer of the government,<sup>34</sup> but may be canceled upon an

Can. Exch. 455; Consolidated Car Heating Co. v. Came, 18 Quebec Super. Ct. 44.

27. *Dashiell v. Grosvenor*, 74 Off. Gaz. 500.

28. *Bement v. National Harrow Co.*, 186 U. S. 70, 22 S. Ct. 747, 46 L. ed. 1058; *Russell v. U. S.*, 182 U. S. 516, 21 S. Ct. 899, 45 L. ed. 1210; *Bellnap v. Schild*, 161 U. S. 10, 16 S. Ct. 443, 40 L. ed. 599; *U. S. v. Berdan Firearms Mfg. Co.*, 156 U. S. 552, 15 S. Ct. 420, 39 L. ed. 530; *Schillinger v. U. S.*, 155 U. S. 163, 15 S. Ct. 85, 39 L. ed. 108; *Hill v. U. S.*, 149 U. S. 593, 13 S. Ct. 1011, 37 L. ed. 862; *Solomons v. U. S.*, 137 U. S. 342, 11 S. Ct. 88, 34 L. ed. 667; *U. S. v. Palmer*, 128 U. S. 262, 9 S. Ct. 104, 32 L. ed. 442; *James v. Campbell*, 104 U. S. 356, 26 L. ed. 786; *Cammeyer v. Newton*, 94 U. S. 225, 24 L. ed. 72; *Morgan v. U. S.*, 14 Wall. (U. S.) 531, 20 L. ed. 738; *U. S. v. Burns*, 12 Wall. (U. S.) 246, 20 L. ed. 388; *Gibbons v. U. S.*, 8 Wall. (U. S.) 269, 19 L. ed. 453; *McKeever v. U. S.*, 14 Ct. Cl. 396; *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288, 25 C. C. A. 267, 35 L. R. A. 728.

In England the patent excludes only subjects, and the crown reserves the right to use the invention. It, however, must pay what is reasonable. Act (1883), § 27; 46 & 47 Vict. c. 57. *In re Napier*, 6 App. Cas. 174, 50 L. J. P. C. 40, 29 Wkly. Rep. 745; *Dixon v. London Small Arms Co.*, 1 App. Cas. 632, 46 L. J. Q. B. 617, 35 L. T. Rep. N. S. 559, 25 Wkly. Rep. 142; *Ex p. Pering*, 4 A. & E. 949, 6 N. & M. 472, 31 E. C. L. 413; *Feather v. Reg.*, 6 B. & S. 257, 35 L. J. Q. B. 200, 12 L. T. Rep. N. S. 114, 118 E. C. L. 257.

In Canada the government may use any patented invention, paying what is just. St. 35 Vict. c. 26, § 21.

29. *U. S. v. Palmer*, 128 U. S. 262, 9 S. Ct. 104, 32 L. ed. 442; *James v. Campbell*, 104 U. S. 356, 26 L. ed. 786.

The United States has no such prerogative as that which is claimed by the sovereigns of

England, by which it can reserve to itself, either expressly or by implication, a superior dominion and use in that which it grants by letters patent to those who entitle themselves to such grants. The government of the United States, as well as the citizen, is subject to the constitution; and when it grants a patent the grantee is entitled to it as a matter of right, and does not receive it, as was originally supposed to be the case in England, as a matter of grace and favor. *James v. Campbell*, 104 U. S. 356, 26 L. ed. 786.

30. *Belknap v. Schild*, 161 U. S. 10, 16 S. Ct. 443, 40 L. ed. 599; *International Postal Supply Co. v. Bruce*, 194 U. S. 601, 24 S. Ct. 820, 48 L. ed. 1134.

31. *Belknap v. Schild*, 161 U. S. 10, 16 S. Ct. 443, 40 L. ed. 599.

32. *Belknap v. Schild*, 161 U. S. 10, 16 S. Ct. 443, 40 L. ed. 599; *U. S. v. Berdan Firearms Mfg. Co.*, 156 U. S. 552, 15 S. Ct. 420, 39 L. ed. 530; *Schillinger v. U. S.*, 155 U. S. 163, 15 S. Ct. 85, 39 L. ed. 108; *Harley v. U. S.*, 116 Off. Gaz. 875.

**Suits against state or county.**—Suit cannot be brought against a state for infringement, but may be brought against a county which is a quasi-municipal corporation. *May v. Fond du Lac*, 27 Fed. 695; *May v. Mercer County*, 41 Off. Gaz. 815; *May v. Ralls County*, 40 Off. Gaz. 575.

33. *Belknap v. Schild*, 161 U. S. 10, 16 S. Ct. 443, 40 L. ed. 599; *U. S. v. Berdan Firearms Mfg. Co.*, 156 U. S. 552, 15 S. Ct. 420, 39 L. ed. 530; *U. S. v. Palmer*, 128 U. S. 262, 9 S. Ct. 104, 32 L. ed. 442; *U. S. v. Burns*, 12 Wall. (U. S.) 246, 20 L. ed. 388; *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288, 25 C. C. A. 267, 35 L. R. A. 728; *Harley v. U. S.*, 116 Off. Gaz. 875; *International Postal Supply Co. v. Bruce*, 194 U. S. 601, 24 S. Ct. 820, 48 L. ed. 1134.

34. *U. S. v. American Bell Tel. Co.*, 128 U. S. 315, 364, 9 S. Ct. 90, 35 L. ed. 450,



adjudication by the courts upon proper action instituted by the government for that purpose.<sup>35</sup>

**C. Patents as Property**<sup>36</sup>—1. **PERSONAL PROPERTY.** A patent right is personal property,<sup>37</sup> and in so far as its incorporeal nature permits is subject to the general laws relating to such property,<sup>38</sup> and is surrounded by the same rights and sanctions which attend all other property.<sup>39</sup>

2. **LOCATION.** It has no definite *situs* within the territorial jurisdiction of any court but is coexistent in every part of the United States.<sup>40</sup>

3. **HOW REACHED BY THE COURTS.** It can be reached by the courts only by securing jurisdiction of the owner.<sup>41</sup>

**D. Constitutional Authority For Patents**—1. **IN GENERAL.** In the United States congress has power to grant patents under the constitutional provision that it shall have power "to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."<sup>42</sup> The power of congress to grant to inventors is general, and it is in their discretion to say when, for what length of time, and under what circumstances the patent for an invention shall be granted.<sup>43</sup> The power may, under the constitution, be exercised in making special grants to inventors,<sup>44</sup> and it may patent what is in public use.<sup>45</sup> Congress cannot, how-

in which it was said: "The only authority competent to set a patent aside, or to annul it, or to correct it, for any reason whatever, is vested in the judicial department of the government, and this can only be effected by proper proceedings taken in the courts of the United States."

35. *Michigan Land, etc., Co. v. Rust*, 168 U. S. 589, 18 S. Ct. 208, 42 L. ed. 591; *U. S. v. American Bell Tel. Co.*, 128 U. S. 315, 9 S. Ct. 90, 32 L. ed. 450; *Moore v. Robbins*, 96 U. S. 530, 24 L. ed. 848; *Providence Rubber Co. v. Goodyear*, 9 Wall. (U. S.) 788, 19 L. ed. 566; *U. S. v. American Bell Tel. Co.*, 79 Off. Gaz. 1362.

A private individual cannot maintain an action to cancel a patent. *Mowry v. Whitney*, 14 Wall. (U. S.) 434, 20 L. ed. 858.

In England a patent may be annulled by proceeding in court on petition of the attorney-general or a party interested. Act (1883), § 26; 46 & 47 Vict. c. 57.

36. As passing to trustees in bankruptcy see **BANKRUPTCY**, 5 Cyc. 346.

As subject to seizure and sale by execution see **EXECUTIONS**, 17 Cyc. 945 *et seq.*

**Subjection to payment of debts in creditors' suits** see **CREDITORS' SUITS**, 12 Cyc. 31.

37. *McCormick Harvesting Mach. Co. v. Aultman-Miller Co.*, 169 U. S. 606, 18 S. Ct. 443, 42 L. ed. 875; *De la Vergne Refrigerating Mach. Co. v. Featherstone*, 147 U. S. 209, 13 S. Ct. 283, 37 L. ed. 138; *U. S. v. Palmer*, 128 U. S. 262, 9 S. Ct. 104, 32 L. ed. 442; *Cammeyer v. Newton*, 94 U. S. 225, 24 L. ed. 72; *Seymour v. Osborne*, 11 Wall. (U. S.) 516, 20 L. ed. 33.

38. Patents pass with the personal estate to the legal representatives. *De la Vergne Refrigerating Mach. Co. v. Featherstone*, 147 U. S. 209, 13 S. Ct. 283, 37 L. ed. 138; *Wilson v. Rousseau*, 4 How. (U. S.) 646, 11 L. ed. 1141; *Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co.*, 78 Off. Gaz. 171.

**Receiver of corporation.**—Patents do not

vest in the receiver of a corporation. *Dick v. Oil Well Supply Co.*, 25 Fed. 105; *Dick v. Struthers*, 25 Fed. 103; *Adams v. Howard*, 22 Fed. 656, 23 Blatchf. 27.

39. *Densmore v. Scofield*, 102 U. S. 375, 26 L. ed. 214.

40. *Ager v. Murray*, 105 U. S. 126, 26 L. ed. 942; *Stevens v. Gladding*, 17 How. (U. S.) 447, 15 L. ed. 155.

41. *Ager v. Murray*, 105 U. S. 126, 26 L. ed. 942; *Jewett v. Atwood Suspender Co.*, 100 Fed. 647; *Wilson v. Martin-Wilson Automatic Fire Alarm Co.*, 52 Off. Gaz. 901.

42. U. S. Const. art. I, § 8.

In England the common law and the statute of monopolies permit the crown within reasonable limits to grant the exclusive right to trade in a new invention. *Reg. v. Prosser*, 11 Beav. 306, 13 Jur. 71, 18 L. J. Ch. 35, 50 Eng. Reprint 834; *Caldwell v. Vanvlisengen*, 9 Hare 415, 16 Jur. 115, 21 L. J. Ch. 97, 41 Eng. Ch. 415, 68 Eng. Reprint 571. The judicial committee of the privy council may confirm the grant of a patent. *Re Card*, 12 Jur. 507, 6 Moore P. C. 207, 13 Eng. Reprint 663; *In re Honiball*, 9 Moore P. C. 378, 14 Eng. Reprint 340; *In re Robinson*, 5 Moore P. C. 65, 13 Eng. Reprint 414. The statute for monopolies, section 6, permitted the granting of patents for the term of fourteen years to the true and first inventor. St. 21 Jac. I, c. 3.

43. *Fire-Extinguisher Case*, 21 Fed. 40; *Blanchard v. Sprague*, 3 Fed. Cas. No. 1,518, 1 Robb Pat. Cas. 734, 742, 2 Story 164, 3 Sumn. 535.

44. *Bloomer v. Stolley*, 3 Fed. Cas. No. 1,559, Fish. Pat. Rep. 376, 5 McLean 158.

45. *McClurg v. Kingsland*, 1 How. (U. S.) 202, 11 L. ed. 102; *Page v. Holmes Burglar Alarm Tel. Co.*, 1 Fed. 304, 17 Blatchf. 485 (holding that the consent of the inventor to the public use of his invention, or the withdrawal of his application for a patent, does not vest any right of property in the general



ever, take away the right of a party to use an article previously purchased by him.<sup>46</sup>

**2. GRANT TO INVENTORS NOT TO IMPORTERS.** Congress has no authority to grant patents to any one save inventors and discoverers, and hence cannot grant a patent to a party who merely imports a device not before known and used in this country.<sup>47</sup> The patentee must be the inventor.<sup>48</sup> In England, however, one who imports knowledge of an invention from abroad is entitled to a patent.<sup>49</sup>

**3. PATENTS GRANTED BY STATE.** While some states granted patents for inventions before the passage of a patent law by the United States they have no such right now that congress has assumed control of the matter.<sup>50</sup>

## II. SUBJECTS OF PATENTS.

**A. Patentable Subject-Matter—1. IN GENERAL.** In the United States patentable subject-matter consists of any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof,<sup>51</sup> or any new, original, and ornamental design for any article of manufacture.<sup>52</sup>

**2. STATUTORY CLASSES OF INVENTION.** Nothing is patentable, however beneficial and novel, unless it comes within one of the statutory classes of patentable inventions.<sup>53</sup>

**3. PHYSICAL THINGS ONLY ARE PATENTABLE.** The subject-matter of patents is limited to physical things or acts producing physical effects and does not include mental theories or plans of action.<sup>54</sup> An idea is not patentable, but only the

public, in the sense of the fifth amendment to the constitution of the United States, so as to prevent the subsequent allowance of a patent for such invention, by act of congress, unless there was, in a particular case, a reduction of the invention to use and practice, by its embodiment in some apparatus prior to the issue of such patent. *Blanchard v. Sprague*, 3 Fed. Cas. No. 1,518, 1 Robb Pat. Cas. 734, 742, 2 Story 164, 3 Sumn. 535.

*Bloomer v. McQuewan*, 14 How. (U. S.) 539, 14 L. ed. 532.

*Livingston v. Van Ingen*, 9 Johns. (N. Y.) 507.

*Kennedy v. Hazelton*, 128 U. S. 667, 9 S. Ct. 202, 32 L. ed. 576; *McClurg v. Kingsland*, 1 How. (U. S.) 202, 11 L. ed. 102; *Blanchard v. Sprague*, 3 Fed. Cas. No. 1,518, 1 Robb Pat. Cas. 734, 742, 2 Story 164, 3 Sumn. 535; *Pitts v. Hall*, 19 Fed. Cas. No. 11,192, 2 Blatchf. 229, Fish. Pat. Rep. 441; *Sparkman v. Higgins*, 22 Fed. Cas. No. 13,208, 1 Blatchf. 205, Fish. Pat. Rep. 110; *Washburn v. Gould*, 29 Fed. Cas. No. 17,214, 2 Robb Pat. Cas. 206, 3 Story 122.

*49. In re Worth*, 12 Ch. D. 303, 28 Wkly. Rep. 329; *Plimpton v. Malcolmson*, 3 Ch. D. 531, 45 L. J. Ch. 505, 34 L. T. Rep. N. S. 340; *Nickels v. Ross*, 8 C. B. 679, 65 E. C. L. 679; *In re Claridge*, 7 Moore P. C. 394, 13 Eng. Reprint 932.

Where a patent is taken out as for an original invention on an invention communicated from abroad, it is void. *Milligan v. Marsh*, 2 Jur. N. S. 1083; *Steedman v. Marsh*, 2 Jur. N. S. 391. But see *Beard v. Egerton*, 3 C. B. 97, 10 Jur. 643, 15 L. J. C. P. 270, 54 E. C. L. 97.

**50.** The power of congress is exclusive.

*Evans v. Robinson*, 8 Fed. Cas. No. 4,571, Brunn. Col. Cas. 400.

**51.** U. S. Rev. St. (1878) § 4886; *Providence Rubber Co. v. Goodyear*, 9 Wall. (U. S.) 788, 19 L. ed. 566.

**Constitutionality of statute.**—U. S. Rev. St. (1878) § 4886 [amended by U. S. Comp. St. (1901) p. 3382], is not unconstitutional because it provides that inventions or discoveries may be either arts, machines, manufactures, or compositions of matter, and that presumptively no two of these subjects are one invention. Inventions have been thus distinguished continuously since 1793, and the supreme court of the United States has frequently recognized the validity of this division. *In re Frasch*, 27 App. Cas. (D. C.) 25.

**Process and machine for performing it may be patented.** *Providence Rubber Co. v. Goodyear*, 9 Wall. (U. S.) 788, 19 L. ed. 566; *Westinghouse Electric, etc., Co. v. Dayton Fan, etc., Co.*, 106 Fed. 724 [affirmed in 118 Fed. 562, 55 C. C. A. 390].

**52.** U. S. Rev. St. (1878) § 4929, as amended May 9, 1902. See *infra*, II, G.

**53.** *Fond du Lac County v. May*, 137 U. S. 395, 11 S. Ct. 98, 34 L. ed. 714; *Singer v. Walmsley*, 22 Fed. Cas. No. 12,900, 1 Fish. Pat. Cas. 558.

**54.** *National Meter Co. v. Neptune Meter Co.*, 122 Fed. 82 [affirmed in 129 Fed. 124, 63 C. C. A. 626]; *McEwan Bros. Co. v. McEwan*, 91 Fed. 787; *Andrews v. Carman*, 1 Fed. Cas. No. 371, 2 Ban. & A. 277, 13 Blatchf. 307, 9 Off. Gaz. 1011; *Detmold v. Reeves*, 7 Fed. Cas. No. 3,831, 1 Fish. Pat. Cas. 127; *Draper v. Potomska Mills Corp.*, 7 Fed. Cas. No. 4,072, 3 Ban. & A. 214, 13 Off. Gaz. 276; *Judson v. Bradford*, 14 Fed.



means for utilizing it practically.<sup>55</sup> The mental conception must have been susceptible of embodiment, and must have been in fact embodied in some mechanical device, or some process of art.<sup>56</sup>

4. RESULT OR PRINCIPLE NOT PATENTABLE. The discovery of a new principle,<sup>57</sup> or law of nature,<sup>58</sup> or an end or result to be accomplished,<sup>59</sup> is not patentable. A

Cas. No. 7,564, 3 Ban. & A. 539, 16 Off. Gaz. 171. And see *infra*, II, B, 3; III, B, 3.

Speculation or conjecture.—A patent cannot be predicated of mere speculation or conjecture. *Westinghouse Electric, etc., Co. v. Saranac Lake Electric Light Co.*, 108 Fed. 221.

Plan for preserving and filing bonds not patentable. *Munson v. New York*, 124 U. S. 601, 8 S. Ct. 622, 31 L. ed. 586.

Intellectual notion that a thing could be done and would be useful is not patentable. *Standard Cartridge Co. v. Peters Cartridge Co.*, 77 Fed. 630, 23 C. C. A. 367 [*affirming* 69 Fed. 408].

Where the patentee has not invented a machine which will do what he claims, his patent is void. *Bloxam v. Elsee*, 6 B. & C. 169, 13 E. C. L. 88, 1 C. & P. 558, 12 E. C. L. 320, 9 D. & R. 215, 5 L. J. K. B. O. S. 104, R. & M. 187, 30 Rev. Rep. 275.

Discovery of new function for old device is not patentable. *Lane Fox v. Kensington Electric Co.*, [1892] 3 Ch. 424, 67 L. T. Rep. N. S. 440.

55. *Rubber Tip Pencil Co. v. Howard*, 20 Wall. (U. S.) 498, 22 L. ed. 410; *Wheaton v. Kendall*, 85 Fed. 666; *Foote v. Silsby*, 9 Fed. Cas. No. 4,919, 2 Blatchf. 260; *Reed v. Cutter*, 20 Fed. Cas. No. 11,645, 2 Robb Pat. Cas. 81, 1 Story 590; *Sloat v. Spring*, 22 Fed. Cas. No. 12,948a; *White v. Allen*, 29 Fed. Cas. No. 17,535, 2 Cliff. 224, 2 Fish. Pat. Cas. 440.

56. *Detmold v. Reeves*, 7 Fed. Cas. No. 3,831.

An imperfect and incomplete invention, resting in mere theory, or in intellectual notion, or in uncertain experiments, and not actually reduced to practice and embodied in some distinct machinery, apparatus, manufacture, or composition of matter, is not patentable. *Draper v. Potomska Mills Corp.*, 7 Fed. Cas. No. 4,072, 3 Ban. & A. 214, 13 Off. Gaz. 276.

57. *Le Roy v. Tatham*, 14 How. (U. S.) 156, 14 L. ed. 367, 22 How. 132, 16 L. ed. 366; *Cameron Septic Tank Co. v. Saratoga Springs*, 151 Fed. 242 [*reversed* on other grounds in 159 Fed. 453]; *National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co.*, 106 Fed. 693, 45 C. C. A. 544; *American Strawboard Co. v. Elkhart Egg-Case Co.*, 84 Fed. 960; *Steam-Gauge, etc., Co. v. St. Louis R. Supplies Mfg. Co.*, 25 Fed. 491; *Bean v. Smallwood*, 2 Fed. Cas. No. 1,173, 2 Robb Pat. Cas. 133, 2 Story 408; *Bell v. Daniels*, 3 Fed. Cas. No. 1,247, 1 Bond 212, 1 Fish. Pat. Cas. 372; *Blanchard v. Sprague*, 3 Fed. Cas. No. 1,518, 1 Robb Pat. Cas. 734, 742, 2 Story 164, 3 Sumn. 535; *Foote v. Silsby*, 9 Fed. Cas. No. 4,919, 2 Blatchf. 260; *Shaw, etc., Co. v. Love-*

*joy*, 21 Fed. Cas. No. 12,727, 7 Blatchf. 232; *Singer v. Walmsley*, 22 Fed. Cas. No. 12,900, 1 Fish. Pat. Cas. 558; *Smith v. Ely*, 22 Fed. Cas. No. 13,043, Fish. Pat. Rep. 339, 5 McLean 76 [*reversed* on other grounds in 15 How. 137, 14 L. ed. 634]; *Stone v. Sprague*, 23 Fed. Cas. No. 13,487, 2 Robb Pat. Cas. 10, 1 Story 270; *Whitney v. Carter*, 29 Fed. Cas. No. 17,583; *Wintermute v. Redington*, 30 Fed. Cas. No. 17,896, 1 Fish. Pat. Cas. 239; *Wyeth v. Stone*, 30 Fed. Cas. No. 18,107, 2 Robb Pat. Cas. 23, 1 Story 273.

Application of rule.—A claim for the art of cutting ice by an apparatus worked by any power other than human is a claim for an abstract principle and is void. *Wyeth v. Stone*, 30 Fed. Cas. No. 18,107, 2 Robb Pat. Cas. 23, 1 Story 273.

58. *In re Kemper*, 14 Fed. Cas. No. 7,687, *Cranch Pat. Dec.* 89, *McArthur Pat. Cas.* 1; *Morton v. New York Eye Infirmary*, 17 Fed. Cas. No. 9,865, 5 Blatchf. 116, 2 Fish. Pat. Cas. 320; *Roberts v. Dickey*, 20 Fed. Cas. No. 11,899, 4 Fish. Pat. Cas. 532, 1 Off. Gaz. 4.

Fumigating trees in absence of the sun's rays is not patentable. *Wall v. Leck*, 66 Fed. 552, 13 C. C. A. 630 [*affirming* 61 Fed. 291].

59. *Matter of Merrill*, 1 MacArthur (D. C.) 301; *Corning v. Burden*, 15 How. (U. S.) 252, 14 L. ed. 683; *O'Reilly v. Morse*, 15 How. (U. S.) 62, 14 L. ed. 601; *Le Roy v. Tatham*, 14 How. (U. S.) 156, 14 L. ed. 367; *Carver v. Hyde*, 16 Pet. (U. S.) 513, 10 L. ed. 1061; *Union Gas-Engine Co. v. Doak*, 88 Fed. 86; *Standard Cartridge Co. v. Peters Cartridge Co.*, 77 Fed. 630, 23 C. C. A. 367 [*affirming* 69 Fed. 408]; *New Process Fermentation Co. v. Maus*, 20 Fed. 725; *American Pin Co. v. Oakville Co.*, 1 Fed. Cas. No. 313, 3 Blatchf. 190; *Blanchard v. Sprague*, 3 Fed. Cas. No. 1,518, 1 Robb Pat. Cas. 734, 742, 2 Story 164, 3 Sumn. 535; *Burr v. Cowperthwait*, 4 Fed. Cas. No. 2,183, 4 Blatchf. 163; *Case v. Brown*, 5 Fed. Cas. No. 2,488, 1 Biss. 382, 2 Fish. Pat. Cas. 268 [*affirmed* in 2 Wall. 320, 17 L. ed. 817]; *Evarts v. Ford*, 8 Fed. Cas. No. 4,574, 6 Fish. Pat. Cas. 587, 5 Off. Gaz. 58; *Marsh v. Dodge, etc., Mfg. Co.*, 16 Fed. Cas. No. 9,115, 6 Fish. Pat. Cas. 562, 5 Off. Gaz. 398; *Sickles v. Falls Co.*, 22 Fed. Cas. No. 12,834, 4 Blatchf. 508, 2 Fish. Pat. Cas. 202; *Waterous v. Bishop*, 20 U. C. C. P. 29.

A discovery that inhaling ether produces insensibility to pain is not a patentable invention. *Morton v. New York Eye Infirmary*, 17 Fed. Cas. No. 9,865, 5 Blatchf. 116, 2 Fish. Pat. Cas. 320.

The measurement of time or expansion of steam is not patentable but only the means for utilizing it. *Whittemore v. Cutter*, 29



principle in the abstract, it has been said, is a fundamental truth; an original cause; a motive; these cannot be patented, because no one can claim in either of them an exclusive right.<sup>60</sup> The patentee is always restricted to the particular device by which he has undertaken to avail himself of the beneficial influence of the principle.<sup>61</sup> So as to laws of nature the processes used to extract, modify, and concentrate them constitute the invention. The elements of the power exist; the invention is not in discovering them, but in applying them to useful objects.<sup>62</sup> And it is for the discovery or invention of some practicable method or means of producing a beneficial result or effect that a patent is granted and not the result itself.<sup>63</sup>

**5. MEANS ARE PATENTABLE.** The means devised for utilizing the principle or accomplishing the end or result may be patentable,<sup>64</sup> whether it is by chemical agency or combination, or by utilizing principles of natural philosophy or mechanics.<sup>65</sup>

**B. Art—1. IN GENERAL.** An art or process is patentable as well as machinery.<sup>66</sup> The term "art" has been defined by the United States supreme court as follows: "It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing. . . . The process requires that certain things should be done with certain substances, and in a certain order."<sup>67</sup>

Fed. Cas. No. 17,601, 1 Gall. 478, 1 Robb Pat. Cas. 40.

**60.** *Le Roy v. Tatham*, 14 How. (U. S.) 156, 14 L. ed. 367. There is no authority to grant a patent for a "principle," a "mode of operation," or an "idea," or for any other abstraction. *Burr v. Duryee*, 1 Wall. (U. S.) 531, 17 L. ed. 650, 660, 661.

**61.** *Steam-Gauge, etc., Co. v. St. Louis R. Supplies Mfg. Co.*, 25 Fed. 491.

**62.** *Le Roy v. Tatham*, 14 How. (U. S.) 156, 14 L. ed. 367.

**63.** *Corning v. Burden*, 15 How. (U. S.) 252, 268, 14 L. ed. 683.

**64.** *Le Roy v. Tatham*, 22 How. (U. S.) 132, 16 L. ed. 366; *Carver v. Hyde*, 16 Pet. (U. S.) 513, 10 L. ed. 1051; *Cameron Septic Tank Co. v. Saratoga Springs*, 151 Fed. 242 [*reversed* on other grounds in 159 Fed. 4531]; *Union Gas-Engine Co. v. Doak*, 88 Fed. 86; *In re Henry*, 11 Fed. Cas. No. 6,371, *McArthur Pat. Cas.* 467; *Parker v. Hulme*, 18 Fed. Cas. No. 10,740, 1 Fish. Pat. Cas. 44; *Roberts v. Dickey*, 20 Fed. Cas. No. 11,899, 4 Fish. Pat. Cas. 532, 1 Off. Gaz. 4; *Smith v. Ely*, 22 Fed. Cas. No. 13,043, Fish. Pat. Rep. 339, 5 McLean 76 [*reversed* on other grounds in 15 How. 137, 14 L. ed. 634]; *Tatham v. Le Roy*, 23 Fed. Cas. No. 13,761; *Wintermute v. Redington*, 30 Fed. Cas. No. 17,896, 1 Fish. Pat. Cas. 239. And see *infra*, III, B, 7; III, E, 2.

Where result is old.—Means may be patentable where the result is old. *Hullet v. Hague*, 2 B. & Ad. 370, 9 L. J. K. B. O. S. 242, 22 E. C. L. 158; *Minter v. Wells*, 1 C. M. & R. 505, 4 L. J. Exch. 2, 5 Tyrw. 163; *Hill v. Evans*, 4 De G. F. & J. 288, 8 Jur. N. S. 525, 31 L. J. Ch. 457, 6 L. T. Rep. N. S. 90, 65 Eng. Ch. 223, 45 Eng. Reprint 1195; *Betts v. Menzies*, 10 H. L. Cas. 117, 9 Jur. N. S. 29, 31 L. J. Q. B. 233, 7 L. T. Rep. N. S. 110, 11 Wkly. Rep. 1, 11 Eng. Reprint 970; *Curtis v. Platt*, 11 L. T. Rep. N. S. 245.

[II, A, 4]

**65.** *Brush Electric Co. v. Electric Imp. Co.*, 52 Fed. 965; *Brush Electric Co. v. Ft. Wayne Electric Light Co.*, 40 Fed. 826; *Burr v. Cowperthwait*, 4 Fed. Cas. No. 2,188, 4 Blatchf. 163.

Means for utilizing law of nature is patentable. *Hammerschlag v. Scamoni*, 7 Fed. 584; *Hall v. Wiles*, 11 Fed. Cas. No. 5,954, 2 Blatchf. 194, Fish. Pat. Rep. 433.

Discovery that a substance is soluble and useful for a new purpose is patentable. *Badische Anilin, etc., Fabrik v. Kalle*, 94 Fed. 163.

**66.** *New Process Fermentation Co. v. Maus*, 122 U. S. 413, 7 S. Ct. 1304, 30 L. ed. 1103; *Tilgham v. Proctor*, 102 U. S. 707, 26 L. ed. 279; *Cochrane v. Deener*, 94 U. S. 780, 24 L. ed. 139; *Providence Rubber Co. v. Goodyear*, 9 Wall. (U. S.) 788, 19 L. ed. 566; *Corning v. Burden*, 15 How. (U. S.) 252, 14 L. ed. 683; *McClurg v. Kingsland*, 1 How. (U. S.) 202, 11 L. ed. 102; *French v. Rogers*, 9 Fed. Cas. No. 5,103, 1 Fish. Pat. Cas. 133; *Roberts v. Dickey*, 20 Fed. Cas. No. 11,899, 4 Fish. Pat. Cas. 532, 1 Off. Gaz. 4; *Smith v. Downing*, 22 Fed. Cas. No. 13,036, 1 Fish. Pat. Cas. 64; *Wintermute v. Redington*, 30 Fed. Cas. No. 17,896, 1 Fish. Pat. Cas. 239; *Badische Anilin, etc., Fabrik v. Levinstein*, 12 App. Cas. 710, 57 L. T. Rep. N. S. 853; *Cornish v. Keene*, 3 Bing. N. Cas. 570, 2 Hodges 281, 6 L. J. C. P. 225, 4 Scott 337, 32 E. C. L. 265; *Boulton v. Bull*, 2 H. Bl. 463, 3 Rev. Rep. 439; *Booth v. Kennard*, 1 H. & N. 527, 3 Jur. N. S. 21, 26 L. J. Exch. 23, 5 Wkly. Rep. 85; *Hills v. Liverpool United Gas Light Co.*, 9 Jur. N. S. 140, 32 L. J. Ch. 28, 7 L. T. Rep. N. S. 537; *Crane v. Price*, 12 L. J. C. P. 81, 4 M. & G. 580, 5 Scott N. R. 338, 43 E. C. L. 301; *Otto v. Linford*, 46 L. T. Rep. N. S. 35; *Hornblower v. Boulton*, 8 T. R. 95, 3 Rev. Rep. 439.

**67.** *Cochrane v. Deener*, 94 U. S. 780, 788, 24 L. ed. 139.



In patent law the term has a different and more restricted meaning than it has in ordinary usage.<sup>68</sup> It has reference to the steps followed or successive acts performed in producing some desired physical effect.<sup>69</sup> It must produce some article or substance or change the physical condition of some article or substance;<sup>70</sup> but

**Other definitions or descriptions.**—" [A term] used as it is in the statute in the sense of the employment of means to a desired end, or the adaptation of powers in the natural world to the uses of life." *Piper v. Brown*, 19 Fed. Cas. No. 11,180, 4 Fish. Pat. Cas. 175, Holmes 20.

"A mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing." *Appleton Mfg. Co. v. Star Mfg. Co.*, 60 Fed. 411, 413, 9 C. C. A. 42.

A result or effect produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another; in another and more vague sense it represents the function of a machine, or the effect produced by it on the material subjected to the action of the machine. *Corning v. Burden*, 15 How. (U. S.) 252, 267, 14 L. ed. 683.

"The application or operation of some element or power of nature, or of one subject to another." *Boyd v. Cherry*, 50 Fed. 279, 282.

A "new process" is usually the result of a discovery, as distinguished from "machine" which is an invention. *Corning v. Burden*, 15 How. (U. S.) 252, 267, 14 L. ed. 683.

"Patentable process."—A process combining instrumentalities before known, but not employed together to accomplish a new and useful result. *Andrews v. Carman*, 1 Fed. Cas. No. 371, 13 Blatchf. 307.

"Process" or "methods" are terms which when used to represent the means of producing a beneficial result are in law synonymous with "art," provided the means are not effected by mechanism or mechanical combinations. *Piper v. Brown*, 19 Fed. Cas. No. 11,180, 4 Fish. Pat. Cas. 175, Holmes 20.

68. *Corning v. Burden*, 15 How. (U. S.) 252, 14 L. ed. 683.

69. *In re Weston*, 17 App. Cas. (D. C.) 431; *Risdon Iron, etc., Works v. Medart*, 158 U. S. 68, 15 S. Ct. 745, 39 L. ed. 899; *Royer v. Coupe*, 146 U. S. 524, 13 S. Ct. 166, 36 L. ed. 1073; *International Tooth-Crown Co. v. Gaylord*, 140 U. S. 55, 11 S. Ct. 716, 35 L. ed. 347; *Lawther v. Hamilton*, 124 U. S. 1, 8 S. Ct. 342, 31 L. ed. 325; *New Process Fermentation Co. v. Maus*, 122 U. S. 413, 7 S. Ct. 1304, 40 L. ed. 1103; *Downton v. Yeager Milling Co.*, 108 U. S. 466, 27 L. ed. 789; *Cochrane v. Deener*, 94 U. S. 780, 24 L. ed. 139; *American Wood Paper Co. v. Fiber Disintegrating Co.*, 23 Wall. (U. S.) 566, 23 L. ed. 31; *Mowry v. Whitney*, 14 Wall. (U. S.) 620, 20 L. ed. 860; *American Fibre-Chamois Co. v. Buckskin Fibre Co.*, 72 Fed. 508, 18 C. C. A. 662; *Wall v. Leck*,

66 Fed. 552, 13 C. C. A. 630; *Boyd v. Cherry*, 50 Fed. 279.

70. *Cochrane v. Deener*, 94 U. S. 780, 24 L. ed. 139. And see *supra*, II, A, 3.

A process, all the steps of which are old, may be new and patentable when, coöperating with each other, they produce a result that is new and useful. *German American Filter Co. v. Erdrich*, 98 Fed. 300.

Reversal of mode of operation may be patentable. Thus a process for pasteurizing beer in bottles by moving the bottles through heated water which is stationary is not anticipated by a patent for a process involving the moving of heated water around stationary bottles containing the liquor to be pasteurized. *In re Wagner*, 22 App. Cas. (D. C.) 267.

Process of rolling metal forgings is patentable. *Simonds Rolling-Mach. Co. v. Hathorn Mfg. Co.*, 90 Fed. 201.

Copperplate printing patentable. *Kneass v. Schuylkill Bank*, 14 Fed. Cas. No. 7,875, 1 Robb Pat. Cas. 303, 4 Wash. 9.

Transmitting speech by electricity is patentable. *Dolbear v. American Bell Tel. Co.*, 126 U. S. 1, 8 S. Ct. 778, 31 L. ed. 863.

Artificial honey is patentable. *In re Corbin*, 6 Fed. Cas. No. 3,224, *McArthur Pat. Cas.* 521.

Other patentable processes.—*New Process Fermentation Co. v. Maus*, 122 U. S. 413, 7 S. Ct. 1304, 30 L. ed. 1103; *Downton v. Yeager Milling Co.*, 108 U. S. 466, 3 S. Ct. 10, 27 L. ed. 789; *Cochrane v. Deener*, 94 U. S. 780, 24 L. ed. 139; *American Wood Paper Co. v. Fiber Disintegrating Co.*, 23 Wall. (U. S.) 566, 23 L. ed. 131; *Mitchell v. Tilghman*, 19 Wall. (U. S.) 287, 22 L. ed. 125; *Mowry v. Whitney*, 14 Wall. (U. S.) 434, 20 L. ed. 858; *Providence Rubber Co. v. Goodyear*, 9 Wall. (U. S.) 788, 19 L. ed. 566; *Corning v. Burden*, 15 How. (U. S.) 252, 14 L. ed. 683; *O'Reilly v. Morse*, 15 How. (U. S.) 62, 14 L. ed. 601; *American Fibre-Chamois Co. v. Buckskin Fibre Co.*, 72 Fed. 508, 18 C. C. A. 662; *Travers v. American Cordage Co.*, 64 Fed. 771; *Uhlman v. Arnholdt, etc., Brewing Co.*, 53 Fed. 485; *Union Paper-Bag Mach. Co. v. Waterbury*, 39 Fed. 389; *Eastern Paper-Bag Co. v. Standard Paper-Bag Co.*, 30 Fed. 63; *Buchanan v. Howland*, 4 Fed. Cas. No. 2,074, 5 Blatchf. 151, 2 Fish. Pat. Cas. 341; *Carnegie Steel Co. v. Cambria Iron Co.*, 99 Off. Gaz. 1866; *John R. Williams Co. v. Miller, etc., Mfg. Co.*, 97 Off. Gaz. 2308; *Thomas v. Electric Porcelain, etc., Co.*, 97 Off. Gaz. 1838; *Welsbach Light Co. v. Union Incandescent Light Co.*, 91 Off. Gaz. 2574; *Western Mineral Wool, etc., Co. v. Globe Mineral Wool Co.*, 77 Off. Gaz. 1127; *Imperial Chemical Mfg. Co. v. Stein*, 75 Off. Gaz. 1551; *Covert v. Travers Bros. Co.*, 75 Off.



it is not necessary that the thing produced shall be new, since a new process for accomplishing an old result is patentable.<sup>71</sup>

**2. MUST PRODUCE PHYSICAL RESULT.** It must be a method of effecting a physical result and not a mere plan or theory of conduct.<sup>72</sup> The physical result, however, need not be a permanent condition of the article or substance acted upon, but may be temporary, as in the case of transmitting speech by certain regulated undulations of the electric current in the telephone.<sup>73</sup>

**3. FUNCTION NOT PATENTABLE.** The mere function of a machine is not a patentable process, although a patentable process may be performed by machinery.<sup>74</sup>

**4. INDEPENDENT OF APPARATUS.** A patentable process is separate from and independent of any machine or apparatus used in performing it.<sup>75</sup> A process may be patentable irrespective of the particular form of the instrumentalities used.<sup>76</sup> It may be said in general that processes of manufacture which involve chemical or other similar elemental action are patentable, although mechanism may be necessary to the application or carrying out of such a process, while those which consist solely in the operation of a machine are not.<sup>77</sup> "Most processes which have been held to be patentable require the aid of mechanism in their

Gaz. 349; *Tannage Patent Co. v. Zahn*, 74 Off. Gaz. 143; *Hoke v. Brown*, Dec. Com. Pat. (1889) 470; *Neilson v. Harford*, 1 Web. Pat. Cas. 295.

The following processes have been held not to be patentable: An improvement in sewing machines, by which the soles and uppers of boots and shoes could be sewed together without any welt by a certain kind of stitches (*MacKay v. Jackman*, 12 Fed. 615, 20 Blatchf. 466); a process of washing shavings in breweries (*Brainard v. Cramme*, 12 Fed. 621, 20 Blatchf. 530); an improved method of treating seed by steam (*Gage v. Kellogg*, 23 Fed. 891); a process for crimping heel-stiffenings of boots and shoes (*Hatch v. Moffitt*, 15 Fed. 252).

71. *Tilghman v. Proctor*, 102 U. S. 707, 26 L. ed. 279; *Providence Rubber Co. v. Good-year*, 9 Wall. (U. S.) 788, 19 L. ed. 566. Article may be new and process old. *American Wood Paper Co. v. Fiber Disintegrating Co.*, 23 Wall. (U. S.) 566, 23 L. ed. 31.

72. *Manhattan Gen. Constr. Co. v. Helios-Upton Co.*, 135 Fed. 785; *U. S. Credit System Co. v. American Credit Indemnity Co.*, 53 Fed. 818; *Ex p. Dixon*, 7 Fed. Cas. No. 3,927; *Smith v. Downing*, 22 Fed. Cas. No. 13,036, 1 Fish. Pat. Cas. 64. And see *supra*, II, A, 3; III, B, 1.

73. *Dolbear v. American Bell Tel. Co.*, 126 U. S. 1, 8 S. Ct. 773, 31 L. ed. 363.

74. *In re Cunningham*, 21 App. Cas. (D. C.) 29; *In re Weston*, 17 App. Cas. (D. C.) 431, 94 Off. Gaz. 1786; *Westinghouse v. Boyden Power-Brake Co.*, 170 U. S. 537, 18 S. Ct. 707, 42 L. ed. 1136; *Rison Iron, etc., Works v. Medart*, 158 U. S. 68, 15 S. Ct. 745, 39 L. ed. 899; *Fuller v. Yentzer*, 94 U. S. 288, 24 L. ed. 103; *Burr v. Duryee*, 1 Wall. (U. S.) 531, 17 L. ed. 650, 660, 661; *Corning v. Burden*, 15 How. (U. S.) 252, 14 L. ed. 683; *Cleveland Foundry Co. v. Detroit Vapor Stove Co.*, 131 Fed. 740; *National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co.*, 99 Fed. 758; *American Strawboard Co. v. Elkhart Egg-Case Co.*, 84 Fed. 960; *Gindorff v. Deering*, 81 Fed. 952; *Chicopee Fold-*

*ing-Box Co. v. Rogers*, 32 Fed. 695; *Excelsior Needle Co. v. Union Needle Co.*, 32 Fed. 221, 23 Blatchf. 147; *Gage v. Kellogg*, 23 Fed. 891; *Albany Steam Trap Co. v. Felthousen*, 20 Fed. 633, 22 Blatchf. 169; *Hatch v. Moffitt*, 15 Fed. 252; *Goss v. Cameron*, 14 Fed. 576, 11 Biss. 389; *Brainard v. Cramme*, 12 Fed. 621, 20 Blatchf. 530; *MacKay v. Jackman*, 12 Fed. 615, 20 Blatchf. 466; *Matthews v. Shoneberger*, 4 Fed. 635, 18 Blatchf. 357; *Sickels v. Falls Co.*, 22 Fed. Cas. No. 12,834, 4 Blatchf. 508, 2 Fish. Pat. Cas. 202; *Wyeth v. Stone*, 30 Fed. Cas. No. 18,107, 2 Robb Pat. Cas. 23, 1 Story 673; *Carnegie Steel Co. v. Cambria Iron Co.*, 99 Off. Gaz. 1866; *Busch v. Jones*, 99 Off. Gaz. 229; *New v. Warren*, 22 Off. Gaz. 587. And see *infra*, II, B, 7.

75. *In re Weston*, 17 App. Cas. (D. C.) 431; *Rison Iron, etc., Works v. Medart*, 158 U. S. 68, 15 S. Ct. 745, 39 L. ed. 899; *Heald v. Rice*, 104 U. S. 737, 26 L. ed. 910; *James v. Campbell*, 104 U. S. 356, 26 L. ed. 786; *Tilghman v. Proctor*, 102 U. S. 707, 26 L. ed. 279; *Cochrane v. Deener*, 94 U. S. 780, 24 L. ed. 139; *Providence Rubber Co. v. Good-year*, 9 Wall. (U. S.) 788, 19 L. ed. 566; *Corning v. Burden*, 15 How. (U. S.) 252, 14 L. ed. 683; *Gindorff v. Deering*, 81 Fed. 952; *Wells Glass Co. v. Henderson*, 67 Fed. 930, 15 C. C. A. 84; *Burr v. Cowperthwait*, 4 Fed. Cas. No. 2,188, 4 Blatchf. 163; *Piper v. Brown*, 19 Fed. Cas. No. 11,180, 4 Fish. Pat. Cas. 175, *Holmes 20* [*reversed* on other grounds in 91 U. S. 37, 23 L. ed. 200]; *In re Creveling*, 117 Off. Gaz. 1167; *U. S. Repair, etc., Co. v. Assyrian Asphalt Co.*, 98 Off. Gaz. 582; *Vermont Farm Mach. Co. v. Gibson*, 56 Off. Gaz. 1566.

76. *Cochrane v. Deener*, 94 U. S. 780, 787, 24 L. ed. 139, in which it was said: "If one of the steps of a process be that a certain substance is to be reduced to a powder, it may not be at all material what instrument or machinery is used to effect that object, whether a hammer, a pestle and mortar, or a mill."

77. *Rison Iron, etc., Works v. Medart*, 158 U. S. 68, 15 S. Ct. 745, 39 L. ed. 899;



practical application, but where such mechanism is subsidiary to the chemical action, the fact that the patentee may be entitled to a patent upon his mechanism does not impair his right to a patent for the process; since he would lose the benefit of his real discovery, which might be applied in a dozen different ways, if he were not entitled to such patent.<sup>77</sup>

**5. CHEMICAL OR ELEMENTAL ACTION.** Arts or processes within the meaning of the term in patent law have been defined as those in which chemical or elemental action is called into play and such processes have always been regarded as patentable.<sup>79</sup>

**6. MECHANICAL PROCESSES.** It would seem, however, that mechanical processes involving simple manipulation may be patentable, even where there is no chemical or elemental action.<sup>80</sup> The mere fact that the use of machinery may be necessary in carrying out the process does not render it unpatentable.<sup>81</sup>

**7. KNOWLEDGE OF PRINCIPLES INVOLVED UNNECESSARY.** An art may be patentable, although the inventor himself does not know the philosophical or abstract principles involved in the practice of the art.<sup>82</sup> He must, however, know and describe the steps by which the result is accomplished so that those skilled in the art may practice the invention.<sup>83</sup>

**C. Machines.** A machine is a combination of mechanical elements adapted to perform a mechanical function.<sup>84</sup> It includes movable parts and differs from an article or implement in that it has a rule of action of its own. It differs from a process, in that a new process is usually the result of discovery, and a machine of invention.<sup>85</sup>

**D. Manufacture.** An article of manufacture is any article or implement produced by human agency and adapted to perform a mechanical function but having no rule of action of its own.<sup>86</sup>

**78.** *Risdon Iron, etc., Works v. Medart*, 158 U. S. 68, 72, 15 S. Ct. 745, 39 L. ed. 899.

**79.** *In re Weston*, 17 App. Cas. (D. C.) 431; *Risdon Iron, etc., Works v. Medart*, 158 U. S. 68, 15 S. Ct. 745, 39 L. ed. 899; *New Process Fermentation Co. v. Maus*, 122 U. S. 413, 7 S. Ct. 1304, 30 L. ed. 1103; *Tilghman v. Proctor*, 102 U. S. 707, 26 L. ed. 279; *Cochrane v. Deener*, 94 U. S. 780, 24 L. ed. 139; *Mowry v. Whitney*, 14 Wall. (U. S.) 620, 20 L. ed. 860; *American Fibre-Chamois Co. v. Buckskin-Fibre Co.*, 72 Fed. 508, 18 C. C. A. 662; *Piper v. Brown*, 19 Fed. Cas. No. 11,180, 4 Fish. Pat. Cas. 175, Holmes 20 [*reversed* on other grounds in 91 U. S. 37, 23 L. ed. 200].

**Process and apparatus.**—A process and an apparatus, while presumptively independent inventions when considered in the light of U. S. Rev. St. (1878) § 4886 [amended by U. S. Comp. St. (1901) p. 3382], providing that inventions or discoveries may be either arts, machines, or composition of matter, nevertheless may be so connected in their design and operation as to constitute unitary invention. *In re Fresch*, 27 App. Cas. (D. C.) 25.

**80.** *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 22 S. Ct. 698, 46 L. ed. 968; *Melvin v. Potter*, 91 Fed. 151; *Travers v. American Cordage Co.*, 64 Fed. 771; *Union Paper-Bag Mach. Co. v. Waterbury*, 39 Fed. 389; *Eastern Paper-Bag Co. v. Standard Paper-Bag Co.*, 30 Fed. 63; *Detroit Lubricator Mfg. Co. v. Renchard*, 9 Fed. 293; *Wilton v. Railroad Co.*, 30 Fed. Cas. No. 17,856. But see *Risdon Iron, etc., Works v. Medart*, 158 U. S. 68, 15 S. Ct. 745, 39 L. ed.

899; *Stokes Bros. Mfg. Co. v. Heller*, 96 Fed. 104; *American Strawboard Co. v. Elkhart Egg-Case Co.*, 84 Fed. 960; *Wells Glass Co. v. Henderson*, 67 Fed. 930, 15 C. C. A. 84.

**81.** *In re Weston*, 17 App. Cas. (D. C.) 431; *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 22 S. Ct. 698, 46 L. ed. 968. See *supra*, II, B, 4.

**82.** *Piper v. Brown*, 19 Fed. Cas. No. 11,180, 4 Fish. Pat. Cas. 175, Holmes 20 [*reversed* on other grounds in 91 U. S. 37, 23 L. ed. 200]; *Wilton v. Railroad Co.*, 30 Fed. Cas. No. 17,856. And see *infra*, V, B, 2.

**83.** See *infra*, V, B, 2, a.

**84.** *Corning v. Burden*, 15 How. (U. S.) 252, 14 L. ed. 683. A word which is said to include every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result. *Corning v. Burden*, 15 How. (U. S.) 252, 14 L. ed. 683; *Appleton Mfg. Co. v. Star Mfg. Co.*, 60 Fed. 411, 9 C. C. A. 42; *Piper v. Brown*, 19 Fed. Cas. No. 11,180, 4 Fish. Pat. Cas. 175, Holmes 20.

New combinations as well as new organizations of mechanism are included in the term. *Wintermute v. Redington*, 30 Fed. Cas. No. 17,896, 1 Fish. Pat. Cas. 239.

**85.** *Corning v. Burden*, 15 How. (U. S.) 252, 14 L. ed. 683.

**86.** *Wood v. Underhill*, 5 How. (U. S.) 1, 12 L. ed. 23; *Hotchkiss v. Greenwood*, 12 Fed. Cas. No. 6,718, 2 Robb Pat. Cas. 730, 4 McLean 456. As used in the patent law, it is a word of very comprehensive meaning, and embraces whatever is made by the art or industry of man, not being a machine, a com-



**E. Composition of Matter.** A composition of matter is a mechanical mixture or chemical combination of two or more substances,<sup>87</sup> and may be patentable.<sup>88</sup> The test of patentability is the same as in machines.<sup>89</sup>

**F. Improvement—1. IN GENERAL.** An improvement is an addition to, or change in, a known art, machine, manufacture, or composition of matter which produces a useful result,<sup>90</sup> and is patentable<sup>91</sup> if it amounts to invention.<sup>92</sup> The improvement may be upon the patentee's own invention.<sup>93</sup>

**2. SUPERIORITY UNNECESSARY.** In the sense of the patent law it is not necessary that the improved article be superior to the original in all respects.<sup>94</sup> It is sufficient that the thing including the improvement is useful and possesses some advantage over the original for some purposes.<sup>95</sup> The advantage may reside in

position of matter, or a design. *Johnson v. Johnston*, 60 Fed. 618.

Any tool or implement used by hand is patentable. *Coupe v. Weatherhead*, 16 Fed. 673.

A book having a novel construction is a patentable article, and the relative arrangement of printed matter and blank spaces may be considered an element of structure. *Thomson v. Citizens' Nat. Bank*, 53 Fed. 250, 3 C. C. A. 518; *Munson v. New York*, 3 Fed. 338, 5 Ban. & A. 486, 18 Blatchf. 237 [*reversed* in 124 U. S. 601, 8 S. Ct. 622, 31 L. ed. 586]; *Hawes v. Antisdell*, 11 Fed. Cas. No. 6,234, 2 Ban. & A. 10, 8 Off. Gaz. 685; *Hawes v. Cook*, 11 Fed. Cas. No. 6,236, 5 Off. Gaz. 493; *Hawes v. Washburne*, 11 Fed. Cas. No. 6,242, 5 Off. Gaz. 491.

A teaching chart with skitted leaves is patentable. *In re Snyder*, 10 App. Cas. (D. C.) 140.

87. *Holliday v. Schulze-Berge*, 78 Fed. 493; *Rogers v. Ennis*, 20 Fed. Cas. No. 12,010, 3 Ban. & A. 366, 15 Blatchf. 47, 14 Off. Gaz. 601; *Tarr v. Folsom*, 23 Fed. Cas. No. 13,756, 1 Ban. & A. 24, *Holmes* 312, 5 Off. Gaz. 92.

New proportions of old ingredients patentable.—*Francis v. Mellor*, 9 Fed. Cas. No. 5,039, 5 Fish. Pat. Cas. 153, 1 Off. Gaz. 48, 8 Phila. (Pa.) 157; *Stephens v. Felt*, 22 Fed. Cas. No. 13,368a; *Woodward v. Morrison*, 30 Fed. Cas. No. 18,003, 5 Fish. Pat. Cas. 357, *Holmes* 124, 2 Off. Gaz. 120.

New way or new form.—A composition is not patentable because made in a new way (*In re Maule*, 16 Fed. Cas. No. 9,308, *McArthur Pat. Cas.* 271); or in a new form (*Rumford Chemical Works v. New York Baking Powder Co.*, 125 Fed. 231).

Although process is old the product may be new. *Providence Rubber Co. v. Goodyear*, 9 Wall. (U. S.) 788, 19 L. ed. 566; *Badische Anilin, etc., Fabrik v. Kalle*, 94 Fed. 163.

A substance in nature is not patentable because new means are devised for obtaining it (*American Wood-Paper Co. v. Fibre Disintegrating Co.*, 1 Fed. Cas. No. 320, 6 Blatchf. 27, 3 Fish. Pat. Cas. 362 [*affirmed* in 23 Wall. (U. S.) 566, 23 L. ed. 31]; when separated from other materials with which it is found combined (*American Wood-Paper Co. v. Fibre Disintegrating Co.*, *supra*).

In England a composition first made commercially is patentable, although it was known as a chemical curiosity. *Frearson v. Loe*, 9 Ch. D. 48, 27 Wkly. Rep. 183; *Lewis*

*v. Davis*, 3 C. & P. 502, 14 E. C. L. 685; *Electric Tel. Co. v. Brett*, 10 C. B. 838, 15 Jur. 579, 20 L. J. C. P. 123, 70 E. C. L. 838; *Nickels v. Ross*, 8 C. B. 679, 65 E. C. L. 679; *Young v. Fernie*, 4 Giffard 577, 10 Jur. N. S. 926, 10 L. T. Rep. N. S. 861, 12 Wkly. Rep. 901, 66 Eng. Reprint 836; *Crane v. Price*, 12 L. J. C. P. 81, 4 M. & G. 580, 5 Scott N. R. 338, 43 E. C. L. 301; *Hornblower v. Boulton*, 8 T. R. 95, 3 Rev. Rep. 439.

88. *Cochrane v. Badische Anilin, etc., Fabrik*, 111 U. S. 293, 4 S. Ct. 455, 28 L. ed. 433; *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 486, 23 L. ed. 952.

89. *Arlington Mfg. Co. v. Celluloid Co.*, 97 Fed. 91, 38 C. C. A. 60; *Antisdell v. Chicago Hotel Cabinet Co.*, 89 Fed. 308, 32 C. C. A. 216.

Lack of identity is shown by results. *Matheson v. Campbell*, 77 Fed. 280.

90. *Seymour v. Osborne*, 11 Wall. (U. S.) 516, 20 L. ed. 33; *Thomson-Houston Electric Co. v. Ohio Brass Co.*, 130 Fed. 542; *Thomson-Houston Electric Co. v. Bullock Electric Co.*, 101 Fed. 587; *Fruit-Cleaning Co. v. Fresno Home-Packing Co.*, 94 Fed. 845; *Wales v. Waterbury Mfg. Co.*, 59 Fed. 285; *Bray v. Hartshorn*, 4 Fed. Cas. No. 1,820, 1 Cliff. 538; *Page v. Ferry*, 18 Fed. Cas. No. 10,662, 1 Fish. Pat. Cas. 293.

A change in an old machine may consist alone of a new and useful combination of the several parts of which it is composed, or it may consist of a material alteration or modification of one or more of the several devices which enter into its construction, or it may consist in adding new devices. *Bray v. Hartshorn*, 4 Fed. Cas. No. 1,820, 1 Cliff. 538.

91. *Phillips v. Page*, 24 How. (U. S.) 164, 16 L. ed. 639; *Wales v. Waterbury Mfg. Co.*, 59 Fed. 285; *Coupe v. Weatherhead*, 16 Fed. 673; *Bray v. Hartshorn*, 4 Fed. Cas. No. 1,820, 1 Cliff. 538; *Losh v. Hague*, Web. Pat. Cas. 200.

92. *Pelzer v. Dale Co.*, 106 Fed. 989, 46 C. C. A. 83.

93. *O'Reilly v. Morse*, 15 How. (U. S.) 62, 14 L. ed. 601; *Grimes v. Allen*, 102 Fed. 606, 42 C. C. A. 559.

94. *Blandy v. Griffith*, 3 Fed. Cas. No. 1,529, 3 Fish. Pat. Cas. 609. And see *infra*, III, D.

95. *Detroit Lubricator Mfg. Co. v. Renchard*, 9 Fed. 293; *Aiken v. Dolan*, 1 Fed. Cas. No. 110, 3 Fish. Pat. Cas. 197.



the ease or cheapness of manufacture or it may reside in the functions performed by it.<sup>96</sup>

**G. Designs**—1. **IN GENERAL.** A patentable design may consist of a new and ornamental shape given to an article of manufacture or of an ornamentation to be placed upon an article of old shape.<sup>97</sup> The design law was intended to encourage the decorative arts, and therefore deals with the appearance rather than the structure, uses, or functions of the article.<sup>98</sup> The design must be novel and must have called for an exercise of the inventive faculties as distinguished from ordinary skill.<sup>99</sup> The patentability of a design does not depend on its æsthetic value.

96. *Jones v. Wetherill*, 13 Fed. Cas. No. 7,508, McArthur Pat. Cas. 409.

97. U. S. Rev. St. (1878) § 4929 [U. S. Comp. St. (1901) p. 3398].

Combination of old elements producing new appearance is patentable. *Matthews, etc., Mfg. Co. v. American Lamp, etc., Co.*, 103 Fed. 634; *Untermeyer v. Freund*, 58 Fed. 205, 7 C. C. A. 183.

For designs held patentable see *Caldwell v. Powell*, 73 Fed. 488, 19 C. C. A. 592 [*reversing* 71 Fed. 970]; *Stewart v. Smith*, 58 Fed. 580, 7 C. C. A. 380; *Smith v. Stewart*, 55 Fed. 481; *New York Belting, etc., Co. v. New Jersey Car-Spring, etc., Co.*, 48 Fed. 556 [*reversed* on other grounds in 53 Fed. 810, 4 C. C. A. 21]; *Anderson v. Saint*, 46 Fed. 760; *Eclipse Mfg. Co. v. Adkins*, 44 Fed. 280; *Foster v. Crossin*, 44 Fed. 62; *Simpson v. Davis*, 12 Fed. 144, 20 Blatchf. 413; *Miller v. Smith*, 5 Fed. 359.

For unpatentable subject-matter see *Niedringhaus v. Commissioner of Patents*, 2 MacArthur (D. C.) 149; *Rowe v. Blodgett, etc., Co.*, 112 Fed. 61, 50 C. C. A. 120; *Eclipse Mfg. Co. v. Holland*, 62 Fed. 465 [*affirmed* in 79 Fed. 993, 25 C. C. A. 676]; *Foster v. Crossin*, 44 Fed. 62; *Post v. T. C. Richards Hardware Co.*, 26 Fed. 618 [*affirmed* in 131 U. S. 444, 9 S. Ct. 802, 33 L. ed. 218]; *Adams, etc., Mfg. Co. v. St. Louis Wire-Goods Co.*, 1 Fed. Cas. No. 72, 3 Ban. & A. 77.

**Movable parts.**—Design may include movable parts. *Chandler Adjustable Chair, etc., Co. v. Heywood Bros., etc., Co.*, 91 Fed. 163.

**Uniting old forms and parts.**—Whatever ingenuity is displayed in producing a new design which imparts to the eye a pleasing impression, even though it be the result of uniting old forms and parts, such production is patentable. *General Gaslight Co. v. Matchless Mfg. Co.*, 129 Fed. 137.

**In England designs are copyrighted and not patented.** St. 5 & 6 Vict. c. 100; *Holds-worth v. McCrea*, L. R. 2 H. L. 380, 36 L. J. Q. B. 297, 14 Wkly. Rep. 226; *Windover v. Smith*, 32 Beav. 200, 9 Jur. N. S. 397, 32 L. J. Ch. 561, 7 L. T. Rep. N. S. 776, 1 New Rep. 349, 11 Wkly. Rep. 323, 55 Eng. Reprint 78; *Daglish v. Jarvie*, 2 Hall & T. 437, 47 Eng. Reprint 1754, 14 Jur. 945, 20 L. J. Ch. 475, 2 Maen. & G. 231, 48 Eng. Ch. 178, 42 Eng. Reprint 89; *Pierce v. Worth*, 18 L. T. Rep. N. S. 710.

98. *In re Tournier*, 17 App. Cas. (D. C.) 481; *Miller v. Young*, 33 Ill. 354; *Gorham Mfg. Co. v. White*, 14 Wall. (U. S.) 511, 20 L. ed. 731; *West Disinfecting Co. v. Frank*,

146 Fed. 388 [*affirmed* in 149 Fed. 423, 79 C. C. A. 359]; *Bradley v. Eccles*, 126 Fed. 945, 61 C. C. A. 669; *Eaton v. Lewis*, 115 Fed. 635 [*affirmed* in 127 Fed. 1018, 61 C. C. A. 562]; *Bevin Bros. Mfg. Co. v. Starr Bros. Bell Co.*, 114 Fed. 362; *Rowe v. Blodgett, etc., Co.*, 103 Fed. 873 [*affirmed* in 112 Fed. 61, 50 C. C. A. 120]; *Pelouze Scale, etc., Co. v. American Cutlery Co.*, 102 Fed. 916, 43 C. C. A. 52; *Braddock Glass Co. v. Macbeth*, 64 Fed. 118, 12 C. C. A. 70; *Redway v. Ohio Stove Co.*, 38 Fed. 582; *Untermeyer v. Freund*, 37 Fed. 342; *Wood v. Dolby*, 7 Fed. 475, 19 Blatchf. 214; *Northrup v. Adams*, 18 Fed. Cas. No. 10,328, 2 Ban. & A. 567, 12 Off. Gaz. 430; *Perry v. Starrett*, 19 Fed. Cas. No. 11,012, 3 Ban. & A. 485, 14 Off. Gaz. 599.

99. *In re Freeman*, 23 App. Cas. (D. C.) 226; *Smith v. Whitman Saddle Co.*, 148 U. S. 674, 13 S. Ct. 768, 37 L. ed. 606; *General Gaslight Co. v. Matchless Mfg. Co.*, 129 Fed. 137; *Bevin Bros. Mfg. Co. v. Starr Bros. Bell Co.*, 114 Fed. 362; *Cary Mfg. Co. v. Neal*, 98 Fed. 617, 39 C. C. A. 189; *Soehner v. Favorite Stove, etc., Co.*, 84 Fed. 182, 28 C. C. A. 317; *Hammond v. Stockton Combined Harvester, etc., Works*, 70 Fed. 716, 17 C. C. A. 356; *Krick v. Jansen*, 61 Fed. 847, 10 C. C. A. 114; *Paine v. Snowden*, 46 Fed. 189; *Pratt v. Rosenfeld*, 3 Fed. 335, 18 Blatchf. 234; *Col-lender v. Griffith*, 6 Fed. Cas. No. 3,000, 11 Blatchf. 212, 3 Off. Gaz. 689; *Northrup v. Adams*, 18 Fed. Cas. No. 10,328, 2 Ban. & A. 567, 12 Off. Gaz. 430.

As much invention is required as in mechanical patent.—Design patents stand on as high a plane as utility patents and require as high a degree of exercise of the inventive or original faculty. *Perry v. Hoskins*, 111 Fed. 1002; *Myers v. Sternheim*, 97 Fed. 625, 38 C. C. A. 345; *Western Electric Mfg. Co. v. Odell*, 18 Fed. 321.

Double use of the same thing for different purposes is not invention. *Smith v. Whitman Saddle Co.*, 148 U. S. 674, 13 S. Ct. 768, 37 L. ed. 606; *Untermeyer v. Freund*, 58 Fed. 205, 7 C. C. A. 183; *Cahoone Barnet Mfg. Co. v. Rubber, etc., Harness Co.*, 45 Fed. 582; *New York Belting, etc., Co. v. New Jersey Car-Spring, etc., Co.*, 30 Fed. 785.

**Identity of designs.**—Designs are the same when an ordinary observer giving ordinary attention would mistake one for the other. *Smith v. Whitman Saddle Co.*, 148 U. S. 674, 13 S. Ct. 768, 37 L. ed. 606; *Gorham Mfg. Co. v. White*, 14 Wall. (U. S.) 511, 20 L. ed. 731; *Jennings v. Kibbe*, 10 Fed. 669, 20 Blatchf.



The design act, as construed by the courts, intends that the patentability of a design shall be determined by its appeal to the eyes of the ordinary man, and not to the eyes of a jury of artists.<sup>1</sup> The same rules as to construction and validity apply as in the case of mechanical inventions.<sup>2</sup>

2. **TERM.** Design patents are granted for three years and six months, for seven years, or for fourteen years, as the applicant may in his application elect.<sup>3</sup>

### III. PATENTABILITY.<sup>4</sup>

**A. In General.** The subject-matter of patents must not only come within the statutory classes, but must be new<sup>5</sup> and useful.<sup>6</sup> It must further be of such a character as to have called for an exercise of the inventive or creative faculties of the mind, as distinguished from the mere exercise of the knowledge and judgment expected of those skilled in the particular art.<sup>7</sup> It must not have been abandoned by the inventor,<sup>8</sup> nor have become public property by forfeiture under statutory provisions.<sup>9</sup>

**B. Novelty**<sup>10</sup>—1. **IN GENERAL.** The subject-matter of patents must be new.<sup>11</sup>

353. The test of identity is the sameness of appearance to the eye of the ordinary observer. *Smith v. Whitman Saddle Co.*, 146 U. S. 674, 13 S. Ct. 768, 37 L. ed. 606.

Utility is to be considered in determining invention. *Smith v. Whitman Saddle Co.*, 148 U. S. 674, 13 S. Ct. 768, 37 L. ed. 606; *Lehnbeuter v. Holthaus*, 105 U. S. 94, 26 L. ed. 939.

Where the peculiarities of an applicant's design do not rise to the dignity of invention, the design is not patentable, although the peculiarities are such as to prevent the design from being regarded in the trade as a substitute for a design already patented. *In re Schraubstadter*, 26 App. Cas. (D. C.) 331.

1. *In re Schraubstadter*, 26 App. Cas. (D. C.) 331. Compare *Williams Calk Co. v. Kemmerer*, 145 Fed. 928, 76 C. C. A. 466 [affirming 136 Fed. 210].

2. *Miller v. Smith*, 5 Fed. 359; U. S. Rev. St. (1878) § 4933 [U. S. Comp. St. (1901) p. 3399].

3. U. S. Rev. St. (1878) § 4931 [U. S. Comp. St. (1901) p. 3399].

4. Conclusiveness and effect of decision in patent office as to patentability of invention see *infra*, V, C, 15.

5. See *infra*, III, B, 1.

6. See *infra*, III, D, 1.

7. See *infra*, III, E, 1.

8. U. S. Rev. St. (1878) § 4886. And see *supra*, II, G.

9. *Sewall v. Jones*, 91 U. S. 171, 23 L. ed. 275; *Brooks v. Jenkins*, 4 Fed. Cas. No. 1,953, Fish. Pat. Rep. 41, 3 McLean 432; *Dawson v. Follen*, 7 Fed. Cas. No. 3,670, 1 Robb Pat. Cas. 9, 2 Wash. 311. And see *infra*, II, F.

10. Application to new use as involving invention see *infra*, III, E, 13.

Conclusiveness and effect of decisions of patent office see *infra*, V, C, 15.

11. U. S. Rev. St. (1878) § 4886; *In re Moesser*, 27 App. Cas. (D. C.) 307; *Richards v. Chase Elevator Co.*, 159 U. S. 477, 16 S. Ct. 53, 40 L. ed. 225; *Dunbar v. Meyers*, 94 U. S. 187, 24 L. ed. 34; *Smyth Mfg. Co. v. Sheridan*, 149 Fed. 208, 79 C. C. A. 166;

*Sellers v. Cofrode*, 35 Fed. 131; *Celluloid Mfg. Co. v. Tower*, 26 Fed. 451 [affirmed in 136 U. S. 633, 10 S. Ct. 1066, 34 L. ed. 551]; *Gardner v. Herz*, 12 Fed. 491, 20 Blatchf. 538 [affirmed in 118 U. S. 180, 6 S. Ct. 1027, 30 L. ed. 158]; *Bean v. Smallwood*, 2 Fed. Cas. No. 1,173, 2 Robb Pat. Cas. 133, 2 Story 408; *Brooks v. Jenkins*, 4 Fed. Cas. No. 1,953, Fish. Pat. Rep. 41, 3 McLean 432; *Conover v. Roach*, 6 Fed. Cas. No. 3,125, 4 Fish. Pat. Cas. 12; *Evans v. Eaton*, 8 Fed. Cas. No. 4,559, Pet. C. C. 322, 1 Robb Pat. Cas. 68; *In re Henry*, 11 Fed. Cas. No. 6,371, McArthur Pat. Cas. 467; *Jones v. Sewall*, 13 Fed. Cas. No. 7,495, 3 Cliff. 563, 6 Fish. Pat. Cas. 343, 3 Off. Gaz. 630 [reversed on other grounds in 91 U. S. 171, 23 L. ed. 275]; *McCormick v. Seymour*, 15 Fed. Cas. No. 8,726, 2 Blatchf. 240; *Parker v. Stiles*, 18 Fed. Cas. No. 10,749, Fish. Pat. Rep. 319, 5 McLean 44; *Roberts v. Ward*, 20 Fed. Cas. No. 11,918, 4 McLean 565, 2 Robb Pat. Cas. 746; *Seligman v. Day*, 21 Fed. Cas. No. 12,643, 2 Ban. & A. 467, 14 Blatchf. 72; *Stanley v. Whipple*, 22 Fed. Cas. No. 13,286, 2 McLean 35, 2 Robb Pat. Cas. 1; *Thompson v. Haight*, 23 Fed. Cas. No. 13,957; *Winans v. New York, etc., R. Co.*, 30 Fed. Cas. No. 17,863, 1 Fish. Pat. Cas. 213 [affirmed in 21 How. 88, 16 L. ed. 68]; *Ex p. Manceaux*, L. R. 6 Ch. 272, 18 Wkly. Rep. 1184; *Stocker v. Warn*, 1 C. B. 148, 9 Jur. 136, 50 E. C. L. 148; *Ralston v. Smith*, 20 C. B. N. S. 28, 11 H. L. Cas. 223, 35 L. J. C. P. 49, 13 L. T. Rep. N. S. 1, 11 Eng. Reprint 1318; *Harwood v. Great Northern R. Co.*, 11 H. L. Cas. 654, 35 L. J. Q. B. 27, 12 L. T. Rep. N. S. 771, 14 Wkly. Rep. 1, 11 Eng. Reprint 1488; *Hill v. Thompson*, Holt N. P. 636, 3 E. C. L. 249, 2 Meriv. 622, 17 Rev. Rep. 156, 36 Eng. Reprint 239, 2 Moore C. P. 424, 8 Taunt. 375, 20 Rev. Rep. 488, 4 E. C. L. 190; *White v. Toms*, 37 L. J. Ch. 204, 17 L. T. Rep. N. S. 348. And see *Butch v. Boyer*, 8 Phila. (Pa.) 57.

Novelty either in result or mode of operation is necessary. *Batten v. Clayton*, 2 Fed. Cas. No. 1,105.



This is equally the case whether the invention claimed consists of an entire machine or improvement of a machine, or a combination of several mechanical powers.<sup>12</sup> Patent rights of this kind are given only to inventors or discoverers of some new and useful art, machine, manufacture, or composition of matter, or some new and useful improvement thereof.<sup>13</sup> And to be new the thing must not have been known to any one before.<sup>14</sup>

**2. PRIOR KNOWLEDGE IN THIS COUNTRY.** It must be new not merely to the patentee but to all people in the United States.<sup>15</sup>

**3. EXTENT OF PRIOR KNOWLEDGE.** To negative novelty the prior knowledge must have been of the complete operative invention and must not have been mere theory or speculation as to what might be done.<sup>16</sup> Prior knowledge by a single person, however, is sufficient.<sup>17</sup>

**4. DATE OF KNOWLEDGE.** The question of novelty is to be determined by the knowledge possessed by people in the United States at the time that the patentee makes the invention,<sup>18</sup> and not at the time that he secures his patent or files his application.<sup>19</sup>

**5. PRIOR KNOWLEDGE OR USE ABROAD.** By the express provision of the federal

Making and selling a part of an old and known manufacture as a new article of trade is not patentable. *Seligman v. Day*, 21 Fed. Cas. No. 12,643, 2 Ban. & A. 467, 14 Blatchf. 72.

An article is not new merely because made by a new process. *Cochrane v. Badische Anilin, etc., Fabrik*, 111 U. S. 293, 4 S. Ct. 455, 28 L. ed. 433; *American Wood Paper Co. v. Fiber Disintegrating Co.*, 23 Wall. (U. S.) 566, 23 L. ed. 31.

**Evidence of novelty.**—In all cases the great commercial success of a patented device, and the fact that it supplants or supersedes other devices of the same kind used for the same purpose, are evidence of patentable invention, novelty, and utility of no mean order or low degree, and such facts are in many cases persuasive evidence of a most valuable conception. *Heywood Bros., etc., Co. v. Syracuse Rapid Transit R. Co.*, 152 Fed. 453. Although the fact that a device has supplanted prior devices in the trade may turn the scale in favor of the existence of invention, where that question is in doubt, yet such fact has no weight where the want of patentable novelty is already reasonably clear. Utility is not novelty. *In re Garrett*, 27 App. Cas. (D. C.) 19.

12. *Brooks v. Jenkins*, 4 Fed. Cas. No. 1,953, Fish. Pat. Rep. 41, 3 McLean 422.

13. *Dunbar v. Meyers*, 94 U. S. 187, 24 L. ed. 34.

14. U. S. Rev. St. (1878) § 4886. And see *infra*, III, D.

15. *Stitt v. Eastern R. Co.*, 22 Fed. 649; *Miller v. Foree*, 9 Fed. 603 [*affirmed* in 116 U. S. 22, 6 S. Ct. 204, 29 L. ed. 552]; *Larabee v. Cortlan*, 14 Fed. Cas. No. 8,084, 3 Fish. Pat. Cas. 5, Taney 180. And see *infra*, III, C, 1, d.

16. *Gordon v. Warder*, 150 U. S. 47, 14 S. Ct. 32, 37 L. ed. 992; *Ransom v. New York*, 20 Fed. Cas. No. 11,573, 1 Fish. Pat. Cas. 252; *Sickles v. Borden*, 22 Fed. Cas. No. 12,832, 3 Blatchf. 535. And see *infra*, III, C, 1, b.

Suggestion of result not means will not an-

ticipate. *Graham v. Gammon*, 10 Fed. Cas. No. 5,668, 3 Ban. & A. 7, 7 Biss. 490.

Mere suggestion not sufficient. *Diamond Match Co. v. Schenck*, 71 Fed. 521 [*affirmed* in 77 Fed. 208, 23 C. C. A. 122].

That invention must be operative see *Bowers v. San Francisco Bridge Co.*, 91 Fed. 381; *Gormully, etc., Mfg. Co. v. Stanley Cycle Mfg. Co.*, 90 Fed. 279.

17. See *infra*, III, C, 1, d.

18. *Bowers v. Von Schmidt*, 63 Fed. 572; *Wilcox v. Bookwalter*, 31 Fed. 224; *Consolidated Bunting Apparatus Co. v. Woerle*, 29 Fed. 449; *Yale Lock Mfg. Co. v. Norwich Nat. Bank*, 6 Fed. 377, 19 Blatchf. 123; *Comstock v. Sandusky Seat Co.*, 6 Fed. Cas. No. 3,082, 3 Ban. & A. 188, 13 Off. Gaz. 230; *Dixon v. Moyer*, 7 Fed. Cas. No. 3,931, 1 Robb Pat. Cas. 324, 4 Wash. 68; *National Spring Co. v. Union Car Spring Mfg. Co.*, 17 Fed. Cas. No. 10,051, 1 Ban. & A. 240, 12 Blatchf. 80, 6 Off. Gaz. 224; U. S., etc., *Salamander Felting Co. v. Haven*, 28 Fed. Cas. No. 16,788, 2 Ban. & A. 164, 9 Off. Gaz. 253.

Patentee may show date of invention on the question of anticipation. *Anderson v. Collins*, 122 Fed. 451, 58 C. C. A. 669; *Bannerman v. Sanford*, 85 Fed. 448; *American Sulphite Pulp Co. v. Howland Falls Pulp Co.*, 80 Fed. 395, 25 C. C. A. 500; *Von Schmidt v. Bowers*, 80 Fed. 121, 25 C. C. A. 323; *Parker v. Hulme*, 18 Fed. Cas. No. 10,740, 1 Fish. Pat. Cas. 44.

19. *Elizabeth v. American Nicholson Pavement Co.*, 97 U. S. 126, 24 L. ed. 1000; *McWilliams Mfg. Co. v. Blundell*, 11 Fed. 419; *Bartholomew v. Sawyer*, 2 Fed. Cas. No. 1,070, 4 Blatchf. 347, 1 Fish. Pat. Cas. 516; *Brodie v. Ophir Silver Min. Co.*, 4 Fed. Cas. No. 1,919, 4 Fish. Pat. Cas. 137, 5 Sawy. 608; *Howe v. Morton*, 12 Fed. Cas. No. 6,769, 1 Fish. Pat. Cas. 586; *Judson v. Cope*, 14 Fed. Cas. No. 7,565, 1 Bond 327, 1 Fish. Pat. Cas. 615; *Nichols v. Pearce*, 18 Fed. Cas. No. 10,246, 7 Blatchf. 5; *Treadwell v. Bladen*, 24 Fed. Cas. No. 14,154, 1 Robb Pat. Cas. 531, 4 Wash. 703; *White v. Allen*,



statutes relating to patents and devices known and used in foreign countries, but not patented there nor described in a printed publication, such inventions or devices are patentable in the United States by a person without notice thereof.<sup>20</sup> If, however, he has notice thereof he cannot obtain a patent even though the invention or discovery had not been patented or described in any printed publication abroad.<sup>21</sup> Prior to the enactment of the statute under consideration, a patent could not be allowed to an inventor unless he showed that he was the original inventor in relation to every part of the world.<sup>22</sup>

**6. PUBLICATION OR PATENT ABROAD.** By the express provisions of such statutes, however, an invention or discovery cannot be patented in the United States, where it has hitherto been patented or described in a printed publication abroad.<sup>23</sup>

**7. NOVELTY OF MEANS.** Patentable novelty may reside in the particular means used for accomplishing an old result.<sup>24</sup>

**8. NOVELTY OF FUNCTION OR RESULT.**<sup>25</sup> Novelty may also reside in the use of old means in a new way or in a new relation where it performs new functions and produces a new result.<sup>26</sup> It is not negated by the existence of the same thing

29 Fed. Cas. No. 17,535, 2 Cliff. 224, 2 Fish. Pat. Cas. 440.

20. U. S. Rev. St. (1878) § 4923 [U. S. Comp. St. (1901) p. 3396]; Hurlbut v. Schillinger, 130 U. S. 456, 9 S. Ct. 584, 32 L. ed. 1011; O'Reilly v. Morse, 15 How. (U. S.) 62, 14 L. ed. 601; American Sulphite Pulp Co. v. Howland Falls Pulp Co., 70 Fed. 986 [reversed on other grounds in 80 Fed. 395, 25 C. C. A. 500]; Doyle v. Spaulding, 19 Fed. 744; Worswick Mfg. Co. v. Steiger, 17 Fed. 250; Cornely v. Marckwald, 17 Fed. 83, 21 Blatchf. 367; Bartholomew v. Sawyer, 2 Fed. Cas. No. 1,070, 4 Blatchf. 347, 1 Fish. Pat. Cas. 516; Coleman v. Liesor, 6 Fed. Cas. No. 2,984; Hays v. Sulsor, 11 Fed. Cas. No. 6,271, 1 Bond 279, 1 Fish. Pat. Cas. 532; Judson v. Cope, 14 Fed. Cas. No. 7,565, 1 Bond 327, 1 Fish. Pat. Cas. 615; Roemer v. Logowitz, 20 Fed. Cas. No. 11,996; Swift v. Whisen, 23 Fed. Cas. No. 13,700, 2 Bond 115, 3 Fish. Pat. Cas. 343. And see *infra*, III, F, 2; IV, A, 9. *Contra*, Brooks v. Bicknell, 4 Fed. Cas. No. 1,944, 3 McLean 250, 2 Robb Pat. Cas. 118.

In Canada prior public use abroad is a bar. Vannorman v. Leonard, 2 U. C. Q. B. 72.

21. Forbush v. Cook, 9 Fed. Cas. No. 4,931, 2 Fish. Pat. Cas. 668.

22. Dawson v. Follen, 7 Fed. Cas. No. 3,670, 1 Robb Pat. Cas. 9, 2 Wash. 311.

23. U. S. Rev. St. (1878) § 4923 [U. S. Comp. St. (1901) p. 3396]; *In re* Schaeffer, 2 App. Cas. (D. C.) 1.

That foreign publication must clearly disclose invention see Dececo Co. v. George E. Gilchrist Co., 125 Fed. 293, 60 C. C. A. 207; New Process Fermentation Co. v. Koch, 21 Fed. 580; Jones v. Sewall, 13 Fed. Cas. No. 7,495, 3 Cliff. 563, 6 Fish. Pat. Cas. 343, 3 Off. Gaz. 630 [reversed on other grounds in 91 U. S. 171, 23 L. ed. 275]; Judson v. Cope, 14 Fed. Cas. No. 7,565, 1 Bond 327, 1 Fish. Pat. Cas. 615.

Descriptions in foreign publications as clear as the patent will anticipate.—Woven-Wire Mattress Co. v. Whittlesey, 30 Fed. Cas. No. 18,058, 8 Biss. 23.

24. Cochrane v. Badische Anilin, etc., Fabrik, 111 U. S. 293, 4 S. Ct. 455, 28 L. ed. 433;

American Wood Paper Co. v. Fiber Disintegrating Co., 23 Wall. (U. S.) 566, 23 L. ed. 31; Anderson v. Collins, 122 Fed. 451, 58 C. C. A. 669; Deere v. Rock Island Plow Co., 84 Fed. 171, 28 C. C. A. 308; Gottfried v. Bartholomae, 10 Fed. Cas. No. 5,632, 3 Ban. & A. 308, 8 Biss. 219, 13 Off. Gaz. 1128; Wilton v. Railroad Co., 30 Fed. Cas. No. 17,856. And see *supra*, II, A, 5.

Novelty of operation may be invention. Cimiotti Unhairing Co. v. American Unhairing Mach. Co., 115 Fed. 498, 53 C. C. A. 230.

Reversal of operation may be invention. Diamond Stone Sawing Mach. Co. v. Brown, 130 Fed. 896 [affirmed in 131 Fed. 910, 70 C. C. A. 248]; Eames v. Cook, 8 Fed. Cas. No. 4,239, 2 Fish. Pat. Cas. 146; *In re* Hebbard, 11 Fed. Cas. No. 6,314, McArthur Pat. Cas. 543; Howe v. Abbott, 12 Fed. Cas. No. 6,766, 2 Robb Pat. Cas. 99, 2 Story 190.

For cases showing want of novelty see Computing Scale Co. v. Automatic Scale Co., 26 App. Cas. (D. C.) 238 [affirmed in 204 U. S. 609, 27 S. Ct. 307, 51 L. ed. 645]; *In re* Weber, 26 App. Cas. (D. C.) 29.

25. Application to new use as involving invention see *infra*, III, E, 13.

26. Krementz v. S. Cottle Co., 148 U. S. 556, 13 S. Ct. 719, 37 L. ed. 558; Topliff v. Topliff, 145 U. S. 156, 12 S. Ct. 825, 36 L. ed. 658; Webster Loom Co. v. Higgins, 105 U. S. 580, 26 L. ed. 1177; Irwin v. Hasselman, 97 Fed. 964, 38 C. C. A. 587; American Automaton Weighing Mach. Co. v. Blauvelt, 50 Fed. 213; Clark Patent Steam, etc., Regulator Co. v. Copeland, 5 Fed. Cas. No. 2,866, 2 Fish. Pat. Cas. 221; *Ex p.* Jacobs, 13 Fed. Cas. No. 7,158; Poillon v. Schmidt, 19 Fed. Cas. No. 11,241, 6 Blatchf. 299, 3 Fish. Pat. Cas. 476, 37 How. Pr. (N. Y.) 77; Wilton v. Railroad Co., 30 Fed. Cas. No. 17,856. And see *infra*, III, E, 13.

Novelty of result indicates invention. Dodge v. Porter, 98 Fed. 624; Wood v. Packer, 17 Fed. 650.

Substitution of equivalents.—If a patentee shows a new result to be attained, and means which are new and novel for attaining that result, and the device indicated is operative,



used for another purpose where the new use is one which would not occur to one using the original thing.<sup>27</sup>

**9. NOVELTY OF FORM.** Changes of shape or form to produce new functions and results may be patentable;<sup>28</sup> but patentable novelty includes more than mere changes from prior inventions since the changes must amount to invention;<sup>29</sup> mere novelty of form is insufficient.<sup>30</sup>

**10. NOVELTY IN COMBINATION.**<sup>31</sup> Novelty may reside in the arrangement or combination of old elements whereby an advantageous result is accomplished.<sup>32</sup>

his patent is good, even if in subsequently applying it he varies the means employed by substituting equivalents. *Hillard v. Fisher Book Typewriter Co.*, 151 Fed. 34 [*affirmed* in 159 Fed. 439].

Where the question of novelty is in doubt, the fact that a new combination and arrangement of known elements produces a new and useful result, displacing other devices employed for a like purpose, is sufficient to turn the scale in favor of invention. *In re Thomson*, 26 App. Cas. (D. C.) 419.

A change in prior devices, in order to be patentable, must be made by transferring an old device to use in an entirely different and unrelated art. *In re Thurston*, 26 App. Cas. (D. C.) 315.

The fact that a new device or construction may have displaced others by reason of its manifest superiority is material only when the question of patentable novelty is otherwise a matter of doubt. *Millett v. Allen*, 27 App. Cas. (D. C.) 70.

**27.** *Clough v. Gilbert, etc.*, Mfg. Co., 106 U. S. 166, 1 S. Ct. 188, 27 L. ed. 134.

**28.** *Winans v. Denmead*, 15 How. (U. S.) 330, 14 L. ed. 717; *Cahoon v. Ring*, 4 Fed. Cas. No. 2,292, 1 Cliff. 592, 1 Fish. Pat. Cas. 397; *Davis v. Palmer*, 7 Fed. Cas. No. 3,645, 2 Brock. 298, 1 Robb Pat. Cas. 518; *Union Paper Collar Co. v. White*, 24 Fed. Cas. No. 14,396, 2 Ban. & A. 60.

**29.** *Lettelier v. Mann*, 91 Fed. 909. And see *infra*, III, E, 1.

**30.** *O'Reilly v. Morse*, 15 How. (U. S.) 62, 14 L. ed. 601; *Dodge Mfg. Co. v. Ohio Valley Pulley Works*, 101 Fed. 584; *Lovell v. Johnson*, 82 Fed. 206; *Swift v. Whisen*, 23 Fed. Cas. No. 13,700, 2 Bond 115, 3 Fish. Pat. Cas. 343; *Wilson Packing Co. v. Clapp*, 30 Fed. Cas. No. 17,851, 4 Ban. & A. 355, 8 Biss. 545, 8 Reporter 262 [*affirmed* in 105 U. S. 566, 26 L. ed. 1172]. And see *infra*, III, E, 9.

Changes of size, form, or proportion not patentable. *Syracuse Chilled Plow Co. v. Robinson*, 35 Fed. 502 [*affirmed* in 145 U. S. 655, 12 S. Ct. 988, 36 L. ed. 856]; *West v. Rae*, 33 Fed. 45; *Ex p. Chatfield*, 5 Fed. Cas. No. 2,631a; *Evans v. Eaton*, 8 Fed. Cas. No. 4,559, Pet. C. C. 322, 1 Robb Pat. Cas. 68; *Evans v. Robinson*, 8 Fed. Cas. No. 4,571, Brunn. Col. Cas. 400.

Changing the form of a die is not invention. *Butler v. Steckel*, 137 U. S. 21, 11 S. Ct. 25, 34 L. ed. 582 [*affirming* 27 Fed. 219]; *Smith v. American Bridge Co.*, 22 Fed. Cas. No. 13,002, 3 Ban. & A. 565, 8 Biss. 312.

Making grate to fit fire pot is not patentable. *Howard v. Detroit Stove Works*, 150 U. S. 164, 14 S. Ct. 68, 37 L. ed. 1039.

**31.** Combination of parts of prior invention as showing prior knowledge or use see *infra*, III, C, 4, 1.

Combination or aggregation as involving invention see *infra*, III, E, 20, 21.

**32.** *Fenton Metallic Mfg. Co. v. Office Specialty Mfg. Co.*, 12 App. Cas. (D. C.) 201 [*reversed* on other grounds in 174 U. S. 492, 19 S. Ct. 641, 43 L. ed. 1058]; *A. R. Milner Seating Co. v. Yesbera*, 133 Fed. 916, 67 C. C. A. 210; *Eck v. Kutz*, 132 Fed. 758; *Thomson-Houston Electric Co. v. Ohio Brass Co.*, 129 Fed. 378; *Stilwell-Bierce, etc., Co. v. Eufula Cotton Oil Co.*, 117 Fed. 410, 54 C. C. A. 584; *Ide v. Trorlicht, etc., Carpet Co.*, 115 Fed. 137, 53 C. C. A. 341; *National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co.*, 106 Fed. 693, 45 C. C. A. 544; *Schroeder v. Brammer*, 98 Fed. 880; *Michigan Stove Co. v. Fuller-Warren Co.*, 81 Fed. 376; *U. S. Printing Co. v. American Playing-Card Co.*, 70 Fed. 50; *Welling v. Crane*, 14 Fed. 571; *Densmore v. Schofield*, 7 Fed. Cas. No. 3,809, 4 Fish. Pat. Cas. 143; *Gottfried v. Phillip Best Brewing Co.*, 10 Fed. Cas. No. 5,633, 5 Ban. & A. 4, 17 Off. Gaz. 675; *Gray v. James*, 10 Fed. Cas. No. 5,718, Pet. C. C. 476, 1 Robb Pat. Cas. 140; *Sloat v. Spring*, 22 Fed. Cas. No. 12,948a. And see *infra*, III, E, 20, a.

**New result necessary.**—Unless the combination of well-known elements accomplishes some new result, the mere multiplicity of elements does not make it patentable. So long as each element performs some old and well-known function, the result is not a patentable invention, but an aggregation of elements. *In re Hill*, 26 App. Cas. (D. C.) 318.

**Substitution of element performing similar result.**—The substitution for an old element, in a combination, of an element performing a similar function, but constructed in a different way, does not render the combination itself patentable where there is no resultant change in the operation. In such a case, although the substituted element may be superior, the invention lies in the element, and not in the combination. *In re Hawley*, 26 App. Cas. (D. C.) 324.

**Determination as to novelty.**—Where the elements of a combination sought to be patented are well known, and, if not known in the combination described, are known in analogous combinations, the court is at liberty to determine whether there is any inven-



**C. Anticipation**<sup>83</sup>—1. IN GENERAL—**a. Introductory Statement.** A patentee's claim to an invention is anticipated when it appears that another made the invention before the date when the patentee made it.<sup>84</sup> Such anticipation may consist of prior patents or publications.<sup>85</sup> To authorize the allowance of a patent there must be a substantial difference in principle from prior inventions.<sup>86</sup> If the prior invention relied on to defeat a subsequent patent existed and was used, it is of no consequence whether it was patented or not,<sup>87</sup> and abandonment of prior invention does not prevent anticipation.<sup>88</sup> Nevertheless mere surmises of earlier students of the same subject do not anticipate.<sup>89</sup>

**b. Full Disclosure Necessary.** Nothing is an anticipation which is not a full and complete disclosure of the invention to the public such as will enable those skilled in the art to make and use it.<sup>40</sup> A disclosure which is insufficient to support a patent cannot be relied upon as an anticipation.<sup>41</sup> To amount to anticipation, however, it is not necessary that the ordinary laborer or mechanic could understand the disclosure.<sup>42</sup>

**c. Identity.**<sup>43</sup> To amount to anticipation there must be identity in substance and not merely identity in form.<sup>44</sup> The two things must accomplish the same

tion in using them in the exact combination claimed. *In re Hill*, 26 App. Cas. (D. C.) 318.

**Claim to combination is an admission that elements are old.** Overweight Counterbalance Elevator Co. v. Improved Order of Red Men's Hall Assoc., 94 Fed. 155, 36 C. C. A. 125.

**Novelty of design, how determined.**—The novelty of a design is to be determined by the comparative appearance of the designs to the eyes of average observers, and not to the eyes of experts. *In re Schraubstadter*, 26 App. Cas. (D. C.) 331.

**33. Original inventors and priority between inventors see *infra*, IV, A.**

**34. Chittenden v. Mallory**, 41 Fed. 215.

**Anticipation must be by another and not by patentee.** *Eck v. Kutz*, 132 Fed. 758.

**A process patent can only be anticipated by a similar process.**—It is not anticipated by mechanism which might, with slight alterations, have been adapted to carry out that process, unless at least such use of it would have occurred to one whose duty it was to make practical use of the mechanism described. *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 22 S. Ct. 698, 48 L. ed. 968 [*reversing* 96 Fed. 850 (*reversing* 89 Fed. 721)].

**Several patents.**—May be anticipation by several patents each showing parts. *Voightman v. Weis*, etc., *Cornice Co.*, 133 Fed. 298.

**35. Byerly v. Cleveland Linseed Oil Works**, 31 Fed. 73.

**Publication without use will bar.** *Brooks v. Bicknell*, 4 Fed. Cas. No. 1,944, 3 McLean 250, 2 Robb Pat. Cas. 118; *Brooks v. Jenkins*, 4 Fed. Cas. No. 1,953, 1 Fish. Pat. Rep. 41, 3 McLean 432; *Ex p. Seeley*, 21 Fed. Cas. No. 12,627; *Smith v. Higgins*, 22 Fed. Cas. No. 13,058.

**36. Smith v. Pearce**, 22 Fed. Cas. No. 13,089, 2 McLean 176, 2 Robb Pat. Cas. 13.

**37. Colt v. Massachusetts Arms Co.**, 6 Fed. Cas. No. 3,030, 1 Fish. Pat. Cas. 108; *Rich v. Lippincott*, 20 Fed. Cas. No. 11,758, 2 Fish. Pat. Cas. 1; *Whipple v. Baldwin Mfg. Co.*, 29 Fed. Cas. No. 17,514, 4 Fish. Pat. Cas. 29.

**38. Merrimac Mattress Mfg. Co. v. Feldman**, 133 Fed. 64.

**39. American Graphophone Co. v. Leeds**, 87 Fed. 873.

**40. Crown Cork, etc., Co. v. Ideal Stopper Co.**, 123 Fed. 666 [*affirmed* in 131 Fed. 244, 65 C. C. A. 436]; *U. S. Peg-Wood, etc., Co. v. B. F. Sturtevant Co.*, 122 Fed. 470 [*affirmed* in 125 Fed. 378, 60 C. C. A. 244]; *McNeely v. Williames*, 96 Fed. 978, 37 C. C. A. 641; *Acme Flexible Clasp Co. v. Cary Mfg. Co.*, 96 Fed. 344, 99 Fed. 500; *Shannon v. Bruner*, 33 Fed. 289 [*affirmed* in 149 U. S. 767, 13 S. Ct. 1043, 37 L. ed. 930]; *Nathan v. New York El. R. Co.*, 2 Fed. 225; *Atlantic Giant Powder Co. v. Parker*, 2 Fed. Cas. No. 625, 4 Ban. & A. 292, 16 Blatchf. 281, 16 Off. Gaz. 495; *Cahill v. Brown*, 4 Fed. Cas. No. 2,291, 3 Ban. & A. 580, 15 Off. Gaz. 697; *Jenkins v. Walker*, 13 Fed. Cas. No. 7,275, 5 Fish. Pat. Cas. 347, *Holmes* 120, 1 Off. Gaz. 359; *Neilson v. Betts*, L. R. 5 H. L. 1, 40 L. J. Ch. 317, 19 Wkly. Rep. 1121; *Hill v. Evans*, 4 De G. F. & J. 288, 8 Jur. N. S. 525, 31 L. J. Ch. 457, 6 L. T. Rep. N. S. 90, 65 Eng. Ch. 223, 45 Eng. Reprint 1195; *Betts v. Menzies*, 10 H. L. Cas. 117, 9 Jur. N. S. 29, 31 L. J. Q. B. 233, 7 L. T. Rep. N. S. 110, 11 Wkly. Rep. 1, 11 Eng. Reprint 970; *Otto v. Linford*, 46 L. T. Rep. N. S. 35; *Betts v. De Vitre*, 11 L. T. Rep. N. S. 445; *General Engineering Co. v. Dominion Cotton Mills Co.*, 6 Can. Exch. 309.

**41. Badische Anilin, etc., Fabrik v. Kalle**, 94 Fed. 163.

**42. Anglo-American Brush Electric Light Corp. v. King**, [1892] A. C. 367; *Pickard v. Prescott*, [1892] A. C. 263; *Betts v. Neilson*, L. R. 3 Ch. 429, 37 L. J. Ch. 321, 18 L. T. Rep. N. S. 165, 16 Wkly. Rep. 524.

**43. Conclusiveness and effect of decision of patent office as to identity of invention in reissue proceedings see *infra*, VIII, G.**

**Identity of invention as showing right of patentee to reissue see *infra*, VIII, C.**

**44. Matter of Merrill**, 1 McArthur (D. C.) 301; *Fryer v. Mutual L. Ins. Co.*, 30 Fed. 787; *Crandal v. Walters*, 9 Fed. 659, 20



purpose by substantially the same means operating in substantially the same way.<sup>45</sup>

Blatchf. 97; *Adams v. Edwards*, 1 Fed. Cas. No. 53, 1 Fish. Pat. Cas. 1.

Similarity of appearance is not proof of identity. *Carr v. Rice*, 5 Fed. Cas. No. 2,440, 1 Fish. Pat. Cas. 198.

Identity of form is not necessary. *In re Bedford*, 14 App. Cas. (D. C.) 376.

Identity is not a matter of words of description but of things. *Poupard v. Fardell*, 18 Wkly. Rep. 127.

**45. Decisions in which facts were held to show identity.**—*In re Hodges*, 28 App. Cas. (D. C.) 525; *In re McNeil*, 28 App. Cas. (D. C.) 461; *In re Hoey*, 28 App. Cas. (D. C.) 416; *In re Welch*, 28 App. Cas. (D. C.) 362; *Johnston v. Woodbury*, 109 Fed. 567, 48 C. C. A. 550; *Root v. Third-Ave. R. Co.*, 43 Fed. 73; *Berryman v. Ainsworth Boiler, etc.*, *Covering Co.*, 40 Fed. 879; *Norton v. Cary*, 39 Fed. 544; *Wight Fire-Proofing Co. v. Chicago Fire-Proof Co.*, 35 Fed. 582; *Sox v. Taylor Iron Works*, 30 Fed. 835 [affirmed in 149 U. S. 785, 13 S. Ct. 1051, 37 L. ed. 964]; *Dodds v. Stoddard*, 17 Fed. 645; *Matteson v. Caine*, 17 Fed. 525, 8 Sawy. 498; *Crandall v. Richardson*, 8 Fed. 808; *Blackman v. Hibbler*, 3 Fed. Cas. No. 1,471, 4 Ban. & A. 641, 17 Blatchf. 333, 17 Off. Gaz. 107; *Gould v. Ballard*, 10 Fed. Cas. No. 5,635, 3 Ban. & A. 324, 13 Off. Gaz. 1081; *Richardson v. Lockwood*, 20 Fed. Cas. No. 11,787, 6 Fish. Pat. Cas. 454, 4 Off. Gaz. 398.

Decisions in which the facts were held to show lack of identity.—*In re Weiss*, 21 App. Cas. (D. C.) 214; *In re Marsden*, 14 App. Cas. (D. C.) 223; *In re Green*, 20 D. C. 237; *Thayer v. Wold*, 142 Fed. 776 [affirmed in 148 Fed. 227, 78 C. C. A. 350]; *Greene v. United Shoe Mach. Co.*, 132 Fed. 973, 66 C. C. A. 43; *Diamond State Iron Co. v. Goldie*, 84 Fed. 972, 28 C. C. A. 589; *Chase v. Fillebrown*, 58 Fed. 374; *Jonathan Mills Mfg. Co. v. Whitehouse*, 56 Fed. 589; *Edison Electric Light Co. v. Westinghouse*, 55 Fed. 490 [reversed on other grounds in 63 Fed. 588, 11 C. C. A. 342]; *Winchester Repeating Arm Co. v. American Buckle, etc., Co.*, 54 Fed. 703; *Sawyer Spindle Co. v. W. G. & A. R. Morrison Co.*, 54 Fed. 693; *Ricker v. Crocker-Wheeler Motor Co.*, 54 Fed. 519; *Roberts v. H. P. Nail Co.*, 53 Fed. 916; *Tibbe, etc., Mfg. Co. v. Heineken*, 43 Fed. 75; *Brush Electric Co. v. Julien Electric Co.*, 41 Fed. 679; *Norton v. Cary*, 39 Fed. 544; *O'Brien Bros. Mfg. Co. v. Peoria Plow Co.*, 34 Fed. 786; *Enterprise Mfg. Co. v. Sargent*, 34 Fed. 134; *Hammerschlag Mfg. Co. v. Bancroft*, 32 Fed. 585; *Starling v. St. Paul Plow Works*, 32 Fed. 290; *Cincinnati Ice-Mach. Co. v. Foss-Schneider Brewing Co.*, 31 Fed. 469; *Adams, etc., Mfg. Co. v. Rathbone*, 26 Fed. 262; *Hicks v. Otto*, 19 Fed. 749; *Bruce v. Marder*, 10 Fed. 750, 20 Blatchf. 355; *Robinson v. Sutter*, 8 Fed. 828, 10 Biss. 100 [reversed on other grounds in 119 U. S. 530, 7 S. Ct. 376, 30 L. ed. 492]; *Watkins v. Cincinnati*, 8 Fed. 325; *Hobbs v. King*, 8 Fed. 91; *Zinn v. Weiss*, 7 Fed. 914; *Pennington v.*

*King*, 7 Fed. 462; *Ex p. Barstow*, 2 Fed. Cas. No. 1,063; *Blake v. Rawson*, 3 Fed. Cas. No. 1,499, 6 Fish. Pat. Cas. 74, *Holmes* 200, 3 Off. Gaz. 122; *Bullock Printing Press Co. v. Jones*, 4 Fed. Cas. No. 2,132, 3 Ban. & A. 195, 13 Off. Gaz. 124; *Cooke v. New York Cent., etc., R. Co.*, 6 Fed. Cas. No. 3,176, 4 Ban. & A. 398, 16 Off. Gaz. 856; *Decker v. Grote*, 7 Fed. Cas. No. 3,726, 10 Blatchf. 331, 6 Fish. Pat. Cas. 143, 3 Off. Gaz. 65; *Gibbs v. Johnson*, 10 Fed. Cas. No. 5,384; *Ex p. Hayden*, 11 Fed. Cas. No. 6,256; *In re Hebbard*, 11 Fed. Cas. No. 6,314, 1 McArthur Pat. Cas. 543; *Ex p. Leach*, 15 Fed. Cas. No. 8,155; *Locomotive Engine Safety Truck Co. v. Erie R. Co.*, 15 Fed. Cas. No. 8,452, 10 Blatchf. 292, 6 Fish. Pat. Cas. 187, 3 Off. Gaz. 93; *Masury v. Tiemann*, 16 Fed. Cas. No. 9,271, 8 Blatchf. 426, 4 Fish. Pat. Cas. 524; *Platt v. U. S. Patent Button, etc., Mfg. Co.*, 19 Fed. Cas. No. 11,222, 9 Blatchf. 342, 5 Fish. Pat. Cas. 265, 1 Off. Gaz. 524; *Reeves v. Keystone Bridge Co.*, 20 Fed. Cas. No. 11,660, 5 Fish. Pat. Cas. 456, 1 Off. Gaz. 466; *Schilling v. Gunther*, 21 Fed. Cas. No. 12,458, 17 Blatchf. 66, 14 Off. Gaz. 713; *In re Smith*, 22 Fed. Cas. No. 12,982, 1 McArthur Pat. Cas. 255; *Tilghman v. Morse*, 23 Fed. Cas. No. 14,044, 9 Blatchf. 421, 5 Fish. Pat. Cas. 323, 1 Off. Gaz. 574; *Yale, etc., Mfg. Co. v. North*, 30 Fed. Cas. No. 18,123, 5 Blatchf. 455, 3 Fish. Pat. Cas. 279.

Lack of identity in woven fabrics see *Hoyle v. Kerr*, 58 Fed. 395, 7 C. C. A. 269.

Lack of identity in materials see *Tibbe, etc., Mfg. Co. v. Lamparter*, 51 Fed. 763; *Shuter v. Davis*, 16 Fed. 564; *Simons v. Blackinton*, 22 Fed. Cas. No. 12,866, 3 Ban. & A. 481.

Lack of identity in process see *Simonds Rolling Mach. Co. v. Hathorn Mfg. Co.*, 93 Fed. 958, 36 C. C. A. 24.

Substantial identity of materials see *Giles v. Heysinger*, 150 U. S. 627, 14 S. Ct. 211, 37 L. ed. 1204.

Difference in operation see *Keystone Mfg. Co. v. Adams*, 151 U. S. 139, 14 S. Ct. 295, 38 L. ed. 103; *Hubbell v. U. S.*, 20 Ct. Cl. 354; *Adams v. Joliet Mfg. Co.*, 1 Fed. Cas. No. 56, 3 Ban. & A. 1, 12 Off. Gaz. 93; *Barnes v. Straus*, 2 Fed. Cas. No. 1,022, 9 Blatchf. 553, 5 Fish. Pat. Cas. 531, 2 Off. Gaz. 62; *Miller v. Androscoggin Pulp Co.*, 17 Fed. Cas. No. 9,559, 5 Fish. Pat. Cas. 340, *Holmes* 142, 1 Off. Gaz. 409; *Potter v. Muller*, 19 Fed. Cas. No. 11,334, 2 Fish. Pat. Cas. 465; *Pike v. Providence, etc., R. Co.*, 20 Fed. Cas. No. 11,163, 1 Ban. & A. 560, *Holmes* 445, 6 Off. Gaz. 575; *Putnam v. Hickey*, 20 Fed. Cas. No. 11,480, 3 Biss. 157, 5 Fish. Pat. Cas. 334, 2 Off. Gaz. 225; *Sanford v. Messer*, 21 Fed. Cas. No. 12,314, 5 Fish. Pat. Cas. 411, *Holmes* 149, 2 Off. Gaz. 470; *Watson v. Cunningham*, 29 Fed. Cas. No. 17,280, 4 Fish. Pat. Cas. 528.

Difference in result see *Robbins v. Columbus Watch Co.*, 50 Fed. 545; *Stuart v. Thorman*, 37 Fed. 90; *Putnam v. Weatherbee*, 20 Fed. Cas. No. 11,485, 2 Ban. & A. 78, 8 Off.



Resemblance without identity is insufficient.<sup>46</sup> But identity need extend no further than to matter claimed.<sup>47</sup> And mere superiority of the invention for which a patent is sought does not prevent anticipation.<sup>48</sup> What would infringe the claims of a patent will anticipate it if prior in date.<sup>49</sup>

**d. General Knowledge of Public Unnecessary.** It is not necessary that the anticipating invention be known generally or that it is a matter of common knowledge,<sup>50</sup> but it is sufficient that some members of the public in this country knew of the invention.<sup>51</sup> Knowledge by a single member of the public is sufficient.<sup>52</sup>

Gaz. 320; *Putnam v. Yerrington*, 20 Fed. Cas. No. 11,486, 2 Ban. & A. 237, 9 Off. Gaz. 689; *Rice v. Heald*, 20 Fed. Cas. No. 11,752 [reversed on other grounds in 104 U. S. 737, 26 L. ed. 910]; *Willimantic Linen Co. v. Clark Thread Co.*, 30 Fed. Cas. No. 17,763, 4 Ban. & A. 133.

**Lack of identity in the structure of books** see *Hawes v. Cook*, 11 Fed. Cas. No. 6,236, 5 Off. Gaz. 493; *Hawes v. Gage*, 11 Fed. Cas. No. 6,237, 5 Off. Gaz. 494; *Hawes v. Washburne*, 11 Fed. Cas. No. 6,242, 5 Off. Gaz. 491.

**Designs.**—Identity of designs is identity of appearance so that one would be mistaken for the other. *Gorham Mfg. Co. v. White*, 14 Wall. (U. S.) 511, 20 L. ed. 731; *Sagendorph v. Hughes*, 95 Fed. 478; *Frank v. Hess*, 84 Fed. 170; *Braddock Glass Co. v. Macbeth*, 64 Fed. 118, 12 C. C. A. 70; *Britton v. White Mfg. Co.*, 61 Fed. 93. Ability to distinguish one design from another will not avoid anticipation. *In re Freeman*, 23 App. Cas. (D. C.) 226.

**Changes and additions.**—An old device will not be considered sufficient to defeat a patent, when its construction is such that radical changes and additions would be required before it could be made to perform the work of the patented device satisfactorily. *Western Electric Co. v. Home Tel. Co.*, 85 Fed. 649; *Consolidated Bunting Apparatus Co. v. Woerle*, 29 Fed. 449; *Livingston v. Jones*, 15 Fed. Cas. No. 8,413, 1 Fish. Pat. Cas. 521. There is no anticipation where modification is necessary to produce the desired result. *Fenton Metallic Mfg. Co. v. Office Specialty Mfg. Co.*, 12 App. Cas. (D. C.) 201; *Ryan v. Newark Spring Mattress Co.*, 96 Fed. 100.

**Identity of structure** is not necessary but the same result should be produced by substantially the same means and operation. *In re Marshutz*, 13 App. Cas. (D. C.) 228.

**Reversal of operation** will not avoid anticipation. *Bryant Electric Co. v. Electric Protection Co.*, 110 Fed. 215.

**Mere suggestions** as to what may be done but not how to do it will not anticipate. *Consolidated Brake-Shoe Co. v. Detroit Steel, etc., Co.*, 59 Fed. 902.

**Devices may be the same**, although not designed for same use. *Codman v. Amia*, 70 Fed. 710 [affirmed in 74 Fed. 634, 20 C. C. A. 566]; *Wright, etc., Wire-Cloth Co. v. Clinton*, 67 Fed. 790, 14 C. C. A. 646.

**Inefficient substitutes.**—A patent for a successful machine is not void for anticipation, because a prior machine intended for a different purpose may possibly be capable

of use as an inefficient substitute for the later machine. *United Shirt, etc., Co. v. Beattie*, 149 Fed. 736, 79 C. C. A. 442 [affirmed 138 Fed. 136].

**46.** *Wilson v. Coon*, 6 Fed. 611, 18 Blatchf. 532; *Parker v. Stiles*, 18 Fed. Cas. No. 10,749, 1 Fish. Pat. Rep. 319, 5 McLean 44.

**47.** Patent covers only what is claimed. *McClain v. Ortmayer*, 141 U. S. 419, 12 S. Ct. 76, 35 L. ed. 800; *Roemer v. Newmann*, 132 U. S. 103, 10 S. Ct. 12, 33 L. ed. 277; *Burns v. Meyer*, 100 U. S. 671, 25 L. ed. 738; *Merrell v. Yeomans*, C. D. 1877, 279; *Keystone v. Phoenix*, C. D. 1877, 384; *Sutter v. Robinson*, C. D. 1885, 155; *Lehigh Valley v. Mellon*, C. D. 1881, 485.

**48.** *Daniels v. Restein*, 131 Fed. 469 [affirmed in 146 Fed. 74, 76 C. C. A. 536]; *Waterman v. Thomson*, 29 Fed. Cas. No. 17,260, 2 Fish. Pat. Cas. 461.

**49.** *Miller v. Eagle Mfg. Co.*, 151 U. S. 186, 14 S. Ct. 310, 38 L. ed. 121; *Knapp v. Morss*, 150 U. S. 221, 14 S. Ct. 81, 37 L. ed. 1059; *Grant v. Walter*, 148 U. S. 547, 13 S. Ct. 699, 37 L. ed. 552; *Peters v. Active Mfg. Co.*, 129 U. S. 530, 9 S. Ct. 389, 32 L. ed. 738; *Electric Smelting, etc., Co. v. Pittsburg Reduction Co.*, 125 Fed. 926, 60 C. C. A. 636; *Eames v. Worcester Polytechnic Inst.*, 123 Fed. 67, 60 C. C. A. 37; *National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co.*, 99 Fed. 758; *Electric Accumulator Co. v. Julien Electric Co.*, 38 Fed. 117; *Peters v. Active Mfg. Co.*, 21 Fed. 319.

**What would not infringe cannot anticipate.** *Stainthorpe v. Elkinton*, 22 Fed. Cas. No. 13,278, 1 Fish. Pat. Cas. 349.

**Omission which would be supplied by mechanism** does not prevent anticipation. *Woodman v. Stimpson*, 30 Fed. Cas. No. 17,979, 3 Fish. Pat. Cas. 98.

**50.** *Bedford v. Hunt*, 3 Fed. Cas. No. 1,217, 1 Mason 302, 1 Robb Pat. Cas. 148.

**Disuse of prior device** does not avoid anticipation. *Packard v. Gilbert*, 18 Fed. Cas. No. 10,651.

**Use concealed from public view** will anticipate. *Spring v. Packard*, 22 Fed. Cas. No. 13,260, 1 Ban. & A. 531, 7 Off. Gaz. 341.

**51.** *Daniel v. Restein*, 131 Fed. 469 [affirmed in 146 Fed. 74, 76 C. C. A. 536]; *Evans v. Hettick*, 8 Fed. Cas. No. 4,562, 1 Robb Pat. Cas. 166, 3 Wash. 408 [affirmed in 7 Wheat. 453, 5 L. ed. 496].

**52.** *Egbert v. Lippmann*, 104 U. S. 333, 26 L. ed. 755; *McClurg v. Kingsland*, 1 How. (U. S.) 202, 11 L. ed. 102; *Boston Elastic Fabrics Co. v. East Hampton Rubber Thread Co.*, 3 Fed. Cas. No. 1,675, 2 Ban. & A. 268.



**e. Patentee's Knowledge of Anticipation Unnecessary.** It is not of consequence that the patentee made the invention by his own efforts and thought and in ignorance of the prior invention by another, since the fact of prior invention is what controls.<sup>53</sup>

**2. PRIOR PATENTS — a. In General.** A patent disclosing the invention granted in this country or abroad before the claimant's date of invention is a bar to the grant of a patent to him for that invention.<sup>54</sup> A prior patent alleged to anticipate must be taken in the meaning disclosed upon its face, and extrinsic evidence is not admissible to reconstruct it, as by showing that a word having a sensible meaning in the context was erroneously used for another word.<sup>55</sup> It cannot properly have implied into it, from necessity, more than it fairly shows, to make it represent an operative structure. What is required and not so shown is left for later inventors.<sup>56</sup> An impracticable prior device, not capable of performing the functions of a subsequent patented device that is practicable and useful, is not an anticipation.<sup>57</sup> Furthermore in order that a prior patent may operate to defeat a subsequent patent, the two must be for the same invention.<sup>58</sup>

**b. Foreign Patents.** A foreign patent in order to invalidate an American patent must antedate the invention patented,<sup>59</sup> not merely the application for letters patent,<sup>60</sup> or the issuance of the patent by the United States.<sup>61</sup> A foreign patent exists as a patent only as of the date when the invention was published or made accessible to the public.<sup>62</sup> An invention is not "patented" in England within the meaning of the act of congress until the enrolment or sealing of the complete specifications.<sup>63</sup> The enrolled specification takes effect only from the date of its enrolment,

9 Off. Gaz. 745; *Packard v. Gilbert*, 18 Fed. Cas. No. 10,651; *Reed v. Cutter*, 20 Fed. Cas. No. 11,645, 2 Robb Pat. Cas. 81, 1 Story 590; *Rich v. Lippincott*, 20 Fed. Cas. No. 11,758, 2 Fish. Pat. Cas. 1; *Stephens v. Felt*, 22 Fed. Cas. No. 13,368, 2 Blatchf. 37, Fish. Pat. Rep. 144. And see *supra*, III, B, 3.

53. See *infra*, III, E, 4.

Ignorance of patentee no defense. *Patterson v. Gas Light, etc., Co.*, 3 App. Cas. 239, 47 L. J. Ch. 402, 38 L. T. Rep. N. S. 303, 26 Wkly. Rep. 482; *In re Honiball*, 9 Moore P. C. 378, 14 Eng. Reprint 340.

54. U. S. Rev. St. (1878) §§ 4886, 4923 [U. S. Comp. St. (1901) p. 3396]; *Kelleher v. Darling*, 14 Fed. Cas. No. 7,653, 3 Ban. & A. 438, 4 Cliff. 424, 14 Off. Gaz. 673; *Muntz v. Foster*, 2 Web. Pat. Cas. 96.

It is a good defense to an action for infringement that the patented device was anticipated by a prior patent to the same patentee. *Barnes Automatic Sprinkler Co. v. Walforth Mfg. Co.*, 60 Fed. 605, 9 C. C. A. 154.

55. *Badische Anilin, etc., Fabrik v. Kalle*, 94 Fed. 163.

56. *Wirt v. Farrelly*, 84 Fed. 891.

57. *Bowers v. San Francisco Bridge Co.*, 91 Fed. 381; *Harwood v. Mill River Woolen Mfg. Co.*, 11 Fed. Cas. No. 6,187, 3 Fish. Pat. Cas. 526; *Hitchcock v. Tremaine*, 12 Fed. Cas. No. 6,538, 8 Blatchf. 440, 4 Fish. Pat. Cas. 508.

**Slight modifications to perform function of later patent.**—A patent is not anticipated by prior patents for devices which might by slight modifications have been made to perform the functions of that of the later patent, where it does not appear that the patentees had in mind their use or adaptation to

accomplish such result. *Gunn v. Bridgeport Brass Co.*, 148 Fed. 239 [reversed in 152 Fed. 434, 81 C. C. A. 576, where patent was declared void].

58. See *infra*, V, C, 8.

59. *Elizabeth v. American Nicholson Pavement Co.*, 97 U. S. 126, 24 L. ed. 1000; *Cochrane v. Deener*, 94 U. S. 780, 24 L. ed. 139; *Columbus Chain Co. v. Standard Chain Co.*, 148 Fed. 622, 78 C. C. A. 394; *Howe v. Morton*, 12 Fed. Cas. No. 6,769, 1 Fish. Pat. Cas. 586.

The words "previously patented in a foreign country" must be taken to mean "patented according to the laws and usages of such foreign country." *Atlas Glass Co. v. Simonds Mfg. Co.*, 102 Fed. 643, 647, 42 C. C. A. 554.

60. *Howe v. Morton*, 12 Fed. Cas. No. 6,769, 1 Fish. Pat. Cas. 586; *White v. Allen*, 29 Fed. Cas. No. 17,535, 2 Cliff. 224, 2 Fish. Pat. Cas. 440, holding that where a foreign patent, granted before the application of the American patentee, is relied upon to destroy the novelty of the American patent, the patentee may prove that his invention was made prior to the granting of the foreign patent.

61. *Elizabeth v. American Nicholson Pavement Co.*, 97 U. S. 126, 24 L. ed. 1000.

In other words an invention reduced to practice in the United States prior to the granting of an English patent will be sustained as against such patent. *National Spring Co. v. Union Car Spring Mfg. Co.*, 17 Fed. Cas. No. 10,051, 1 Ban. & A. 240, 12 Blatchf. 80, 6 Off. Gaz. 224.

62. *De Florez v. Reynolds*, 17 Off. Gaz. 503.

63. *Rousseau v. Brown*, 21 App. Cas. (D. C.) 73; *Ireson v. Pierce*, 39 Fed. 795;



and not from the date of the filing of the provisional specification.<sup>64</sup> The instrument known under the German law as "Gebrauchsmuster" is not one the filing of which charges any one with notice of its contents or which has the effect of a foreign patent as an anticipation of a subsequent United States patent.<sup>65</sup>

**c. Paper Patents.** It is well settled that mere paper patents may negative otherwise patentable novelty, provided they sufficiently disclose the principles of the alleged invention, or provided the alleged objections can be obviated by mere mechanical skill.<sup>66</sup> But anticipatory matter which has never gone into practical use is to be narrowly construed.<sup>67</sup>

**d. Secret Patents.** The expression "patented," as used in a statute,<sup>68</sup> providing that, in an action for infringement, defendant may prove that the patentee's invention had been patented prior to his supposed invention, means only invention laid open to the public and protected to the inventors.<sup>69</sup> There are, however, in some foreign countries, patents which may, for public and special reasons, be kept secret. Therefore defendant must show whether the alleged anticipating patent was a public or a private grant.<sup>70</sup>

**e. Sufficiency of Description.** A prior patent to invalidate a subsequent patent must describe the invention in such full, clear, and exact terms as to enable one skilled in the art to construct and use it without the necessity of making experiments.<sup>71</sup> The sufficiency of the description in the prior patent must be

*Electrical Accumulator Co. v. Julien Electric Co.*, 38 Fed. 117; *Railway Register Mfg. Co. v. Broadway, etc.*, R. Co., 26 Fed. 522 [affirmed in 149 U. S. 783, 13 S. Ct. 1051, 37 L. ed. 958]; *Howe v. Morton*, 12 Fed. Cas. No. 6,769, 1 Fish. Pat. Cas. 586; *Willimantic Linen Co. v. Clark Thread Co.*, 30 Fed. Cas. No. 17,763, 4 Ban. & A. 133; *American Bell Tel. Co. v. Cushman*, 65 Off. Gaz. 135.

<sup>64</sup> *Howe v. Morton*, 12 Fed. Cas. No. 6,769, 1 Fish. Pat. Cas. 586.

An English provisional specification is not an anticipation until it has been printed, the invention described in it not being patented until the completed specification is filed. *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 486, 23 L. ed. 952; *Parsons v. Colgate*, 15 Fed. 600, 21 Blatchf. 171; *Coburn v. Schroeder*, 11 Fed. 425, 20 Blatchf. 392.

<sup>65</sup> *Steiner v. Schwarz*, 148 Fed. 863.

<sup>66</sup> *Pickering v. McCullough*, 104 U. S. 310, 26 L. ed. 749; *Universal Winding Co. v. Willimantic Linen Co.*, 80 Off. Gaz. 1273; *Miller v. Meriden Bronze Co.*, 79 Off. Gaz. 1520.

Where more than mechanical skill is required a paper patent will not anticipate. *Thomson-Houston Electric Co. v. Winchester Ave. R. Co.*, 71 Fed. 192.

<sup>67</sup> *Simonds Rolling-Mach. Co. v. Hathorn Mfg. Co.*, 90 Fed. 201.

However a patentee cannot be denied invention because of a prior patent for a device which never came into use, unless the idea upon which his patent is predicated is so clearly set forth or suggested in the alleged anticipating patent that a mechanic with such patent before him could by the exercise of mere mechanical skill so modify proportions or change the mode of operation as to overcome the difficulties which excluded the prior device from commercial utility. *Ideal Stopper Co. v. Crown Cork, etc., Co.*, 131 Fed. 244, 65 C. C. A. 436 [affirming 123 Fed. 666].

<sup>68</sup> U. S. Rev. St. (1878) § 4920, par. 3.

<sup>69</sup> *Schoerken v. Swift, etc., Co.*, 7 Fed. 469, 19 Blatchf. 209; *Brooks v. Norcross*, 4 Fed. Cas. No. 1,957, 2 Fish. Pat. Cas. 661.

<sup>70</sup> *Brooks v. Norcross*, 4 Fed. Cas. No. 1,957, 2 Fish. Pat. Cas. 661. But, as against an objection that it did not appear from the copy of a foreign patent, introduced to show prior invention, whether it was an open or a secret one, it has been held that, since only public records are provable by copy certified merely, and as the authorities of a foreign government would not have a patent in a condition to be certified if it was secret, the fact that it is certified shows it to be public. *Schoerken v. Swift, etc., Co.*, 7 Fed. 469, 19 Blatchf. 209.

<sup>71</sup> *Matter of McCloskey*, 3 MacArthur (D. C.) 14; *Pettibone v. Pennsylvania Steel Co.*, 133 Fed. 730 [reversed on other grounds in 141 Fed. 95]; *Springfield Furnace Co. v. Miller Down-Draft Furnace Co.*, 96 Fed. 418; *Carnegie Steel Co. v. Cambria Iron Co.*, 89 Fed. 721; *Hanifen v. E. H. Godschalk Co.*, 84 Fed. 649, 28 C. C. A. 507 [reversing 78 Fed. 811]; *Consolidated Brake-Shoe Co. v. Detroit Steel, etc., Co.*, 59 Fed. 902; *U. S. Bung Mfg. Co. v. Independent Bung, etc., Co.*, 31 Fed. 76, 24 Blatchf. 406; *Nathan v. New York El. R. Co.*, 2 Fed. 225; *Atlantic Giant-Powder Co. v. Parker*, 2 Fed. Cas. No. 625, 4 Ban. & A. 292, 16 Blatchf. 231, 16 Off. Gaz. 87; *Goff v. Stafford*, 10 Fed. Cas. No. 5,504, 3 Ban. & A. 610, 14 Off. Gaz. 748; *Jenkins v. Walker*, 13 Fed. Cas. No. 7,275, 5 Fish. Pat. Cas. 347, *Holmes* 120, 1 Off. Gaz. 359; *Woodman v. Stimpson*, 30 Fed. Cas. No. 17,979, 3 Fish. Pat. Cas. 98 [reversed on other grounds in 10 Wall. 117, 19 L. ed. 866]; *Betts v. Menzies*, 10 H. L. Cas. 117, 9 Jur. N. S. 29, 31 L. J. Q. B. 233, 7 L. T. Rep. N. S. 110, 11 Wkly. Rep. 1, 11 Eng. Reprint 970.



tested by the knowledge of persons skilled in the art as it existed at the date of such patent.<sup>72</sup>

**f. Failure to Claim Immaterial.** It is immaterial whether the prior patent includes a claim to the subject-matter so long as it discloses it with such clearness as to enable one skilled in the art to make and use it.<sup>73</sup> The failure of the patentee to include the device among the claims of his own invention implies either that he abandoned it to the public or that he regarded it as well known.<sup>74</sup> The patent is evidence of the state of the art at the time the drawings and specifications upon which it was afterward granted were made, and it is the state of the art and not the patent which constitutes anticipation.<sup>75</sup>

**3. PRIOR PUBLICATION — a. In General.** A prior publication is a printed book, newspaper, or document of public character disclosing the invention intended and actually employed for the purpose of conveying information to the public.<sup>76</sup> The invention must be intended for the public and actually published.<sup>77</sup>

**b. Sufficiency of Publication.** Publication in a book of general circulation is sufficient.<sup>78</sup> But mere business catalogues or circulars intended for particular persons engaged in the trade are not publications within the meaning of the law.<sup>79</sup> Otherwise, however, as to trade magazines found in libraries.<sup>80</sup> A published drawing without description is a publication of the invention if the disclosure therein is sufficient to enable one skilled in the art to make and use it.<sup>81</sup> A provisional specification published in England amounts to publication.<sup>82</sup> A book containing the minutes of a company,<sup>83</sup> or an application for a patent,<sup>84</sup> is not a publi-

**Insufficient descriptions.**—A patent so obscure in its terminology that two conflicting theories as to its meaning may be deduced therefrom and supported by equally plausible arguments is too indefinite to operate as an anticipation. *Cimiotti Unhairing Co. v. Comstock Unhairing Co.*, 115 Fed. 524. So mere prophetic suggestions in a patent as to the possibilities of an invention, when no one has ever tested the truth of the suggestions, do not anticipate a subsequent patent for the invention suggested. *Westinghouse Air-Brake Co. v. Great Northern R. Co.*, 88 Fed. 258, 81 C. C. A. 525.

**Mechanism.**—Where a patent is for mechanism by which a particular result is produced, a prior patent, in order to anticipate it, must contain more than a mere statement that the result may be accomplished. It must contain a description of the mechanism by which it is accomplished. *Graham v. Gammon*, 10 Fed. Cas. No. 5,668, 3 Ban. & A. 7, 7 Biss. 490.

72. *Bowers v. San Francisco Bridge Co.*, 91 Fed. 381.

73. *In re Millett*, 18 App. Cas. (D. C.) 186; *Saunders v. Allen*, 60 Fed. 610, 9 C. C. A. 157. *Compare* *Battin v. Taggart*, 17 How. (U. S.) 74, 15 L. ed. 37; *Vermont Farm Mach. Co. v. Marble*, 19 Fed. 307; *Graham v. McCormick*, 11 Fed. 859, 10 Biss. 39, all holding that an inventor is not barred from obtaining a patent because his invention is described, although not claimed, in a prior patent to himself.

74. *In re Millett*, 18 App. Cas. (D. C.) 186; *Mahn v. Harwood*, 112 U. S. 354, 5 S. Ct. 174, 6 S. Ct. 451, 28 L. ed. 665; *Miller v. Bridgeport Brass Co.*, 104 U. S. 350, 26 L. ed. 783.

75. *In re Millett*, 18 App. Cas. (D. C.) 186.

76. *Britton v. White Mfg. Co.*, 61 Fed. 93.

77. *Reeves v. Keystone Bridge Co.*, 20 Fed. Cas. No. 11,660, 5 Fish. Pat. Cas. 456, 1 Off. Gaz. 466, 9 Phila. (Pa.) 368.

78. *Lang v. Gisborne*, 31 Beav. 133, 8 Jur. N. S. 736, 31 L. J. Ch. 769, 6 L. T. Rep. N. S. 771, 10 Wkly. Rep. 368, 54 Eng. Reprint 1088; *Stead v. Williams*, 8 Jur. 930, 13 L. J. C. P. 218, 7 M. & G. 818, 8 Scott N. R. 440, 49 E. C. L. 818.

79. *Seymour v. Osborne*, 11 Wall. (U. S.) 516, 20 L. ed. 33; *Britton v. White Mfg. Co.*, 61 Fed. 93; *New Process Fermentation Co. v. Koch*, 21 Fed. 580; *Judson v. Cope*, 14 Fed. Cas. No. 7,565, 1 Bond 327, 1 Fish. Pat. Cas. 615; *Reeves v. Keystone Bridge Co.*, 20 Fed. Cas. No. 11,660, 5 Fish. Pat. Cas. 456, 1 Off. Gaz. 466, 9 Phila. (Pa.) 368; *Parsons v. Colgate*, 24 Off. Gaz. 203; *Atterbury's Appeal*, 9 Off. Gaz. 640.

80. *Truman v. Carvill Mfg. Co.*, 87 Fed. 470.

81. *In re Millett*, 18 App. Cas. (D. C.) 186; *Wright v. Yuengling*, 155 U. S. 47, 15 S. Ct. 1, 39 L. ed. 64; *Britton v. White Mfg. Co.*, 61 Fed. 93; *Webb v. Quintard*, 29 Fed. Cas. No. 17,324, 9 Blatchf. 352, 5 Fish. Pat. Cas. 276, 1 Off. Gaz. 525. But see *Judson v. Cope*, 14 Fed. Cas. No. 7,565, 1 Bond 327, 1 Fish. Pat. Cas. 615; *Reeves v. Keystone Bridge Co.*, 20 Fed. Cas. No. 11,660, 5 Fish. Pat. Cas. 456, 1 Off. Gaz. 466, 9 Phila. (Pa.) 368.

82. *Cohn v. U. S. Corset Co.*, 6 Fed. Cas. 2,969, 1 Ban. & A. 340, 12 Blatchf. 225, 6 Off. Gaz. 259 [affirmed in 93 U. S. 366, 23 L. ed. 907].

83. *Pennock v. Dialogue*, 19 Fed. Cas. No. 10,941, 1 Robb Pat. Cas. 466, 4 Wash. 538 [affirmed in 2 Pet. 1, 7 L. ed. 327].

84. *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 18 Fed.



cation. So a single copy of a book published in a foreign country not entered in the list of books contained in a library is not a publication.<sup>85</sup> Copies of foreign patents in the patent office or public libraries accessible to all amount to sufficient publication.<sup>86</sup>

**c. Sufficiency of Description.** The publication must describe the invention so fully as to enable one skilled in the art to which it belongs or pertains to construct or use it.<sup>87</sup>

**4. PRIOR KNOWLEDGE AND USE — a. Sufficiency of Knowledge.** Anticipating knowledge must be of the complete operative invention such as will enable those skilled in the art without further instructions to make and use it.<sup>88</sup>

**b. Mental Idea Insufficient.** Anticipating knowledge includes not the mere mental conception that the thing can be done,<sup>89</sup> and of the means for doing it, but the certainty of information derived from a practical demonstration.<sup>90</sup> Mere theories are insufficient.<sup>91</sup>

**c. Necessity For Perfected Invention.** To constitute an anticipation the invention must have been in a form adapted and intended for immediate practical use.<sup>92</sup> An inoperative device will not anticipate.<sup>93</sup>

Cas. No. 10,337, 1 Ban. & A. 177, 6 Off. Gaz. 34, 10 Phila. (Pa.) 227.

85. Plimpton v. Spiller, 6 Ch. D. 412, 47 L. J. Ch. 211, 37 L. T. Rep. N. S. 56, 26 Wkly. Rep. 285.

86. Harris v. Rothwell, 35 Ch. D. 416, 56 L. J. Ch. 459, 56 L. T. Rep. N. S. 552, 35 Wkly. Rep. 581; Plimpton v. Spiller, 6 Ch. D. 412, 47 L. J. Ch. 211, 37 L. T. Rep. N. S. 56, 26 Wkly. Rep. 285; British Tanning Co. v. Groth, 60 L. J. Ch. 235, 64 L. T. Rep. N. S. 21.

87. Driven Well Cases, 122 U. S. 40, 7 S. Ct. 1073, 30 L. ed. 1064; Seymour v. Osborne, 11 Wall. (U. S.) 516, 20 L. ed. 33; Electric Smelting, etc., Co. v. Pittsburg Reduction Co., 125 Fed. 926, 60 C. C. A. 636; Western Electric Co. v. Millheim Electric Tel. Co., 88 Fed. 505; Am Ende v. Seabury, 36 Fed. 593 [affirmed in 152 U. S. 561, 14 S. Ct. 683, 38 L. ed. 553]; Hood v. Boston Car-Spring Co., 21 Fed. 67; Nathan v. New York El. R. Co., 2 Fed. 225; Coleman v. Liesor, 6 Fed. Cas. No. 2,984; Colgate v. Gold, etc., Tel. Co., 6 Fed. Cas. No. 2,991, 4 Ban. & A. 415, 16 Blatchf. 503, 16 Off. Gaz. 583; Hays v. Sulsor, 11 Fed. Cas. No. 6,271, 1 Bond 279, 1 Fish. Pat. Cas. 532; McMillin v. Barclay, 16 Fed. Cas. No. 8,902, 5 Fish. Pat. Cas. 189, 4 Brewst. (Pa.) 275; Parker v. Stiles, 18 Fed. Cas. No. 10,749, 1 Fish. Pat. Rep. 319, 5 McLean 44; Roberts v. Dickey, 20 Fed. Cas. No. 11,899, 4 Fish. Pat. Cas. 532, 1 Off. Gaz. 4, 4 Brewst. (Pa.) 260.

88. Seabury v. Am Ende, 152 U. S. 561, 14 S. Ct. 683, 38 L. ed. 553; Driven Well Cases, 122 U. S. 40, 7 S. Ct. 1073, 30 L. ed. 1064; Seymour v. Osborne, 11 Wall. (U. S.) 516, 20 L. ed. 33; Hood v. Boston Car-Spring Co., 21 Fed. 67; Coleman v. Liesor, 6 Fed. Cas. No. 2,984; Hays v. Sulsor, 11 Fed. Cas. No. 6,271, 1 Bond 279, 1 Fish. Pat. Cas. 532; Parker v. Stiles, 18 Fed. Cas. No. 10,749, 1 Fish. Pat. Rep. 319, 5 McLean 44; Roberts v. Dickey, 20 Fed. Cas. No. 11,899, 4 Fish. Pat. Cas. 532, 1 Off. Gaz. 4, 4 Brewst. (Pa.) 260. And see *supra*, III, C, 1, b.

89. Cobb v. Goebel, 23 App. Cas. (D. C.) 75.

90. Howe v. Underwood, 12 Fed. Cas. No. 6,775, 1 Fish. Pat. Cas. 160; Sayles v. Chicago, etc., R. Co., 21 Fed. Cas. No. 12,415, 3 Biss. 52, 4 Fish. Pat. Cas. 584. And see *infra*, III, C, 4, d; IV, A, 4.

91. National Co. v. Belcher, 71 Fed. 876, 18 C. C. A. 375; Cox v. Griggs, 6 Fed. Cas. No. 3,302, 1 Biss. 362, 2 Fish. Pat. Cas. 174; Judson v. Bradford, 14 Fed. Cas. No. 7,564, 3 Ban. & A. 539, 16 Off. Gaz. 171; Parkhurst v. Kinsman, 18 Fed. Cas. No. 10,757, 1 Blatchf. 488, Fish. Pat. Rep. 161, 8 N. Y. Leg. Obs. 146; Poppenhusen v. New York Gutta Percha Comb Co., 19 Fed. Cas. No. 11,283, 2 Fish. Pat. Cas. 62; Stephens v. Felt, 22 Fed. Cas. No. 13,368a; Teese v. Phelps, 23 Fed. Cas. No. 13,819, McAllister 48; Union Sugar Refinery v. Matthiesson, 24 Fed. Cas. No. 14,399, 3 Cliff. 639, 2 Fish. Pat. Cas. 600. And see *supra*, II, A, 3.

92. Lindemeyr v. Hoffman, 18 App. Cas. (D. C.) 1; Coffin v. Ogden, 18 Wall. (U. S.) 120, 21 L. ed. 821; Buser v. Novelty Tufting Mach. Co., 151 Fed. 478, 81 C. C. A. 16; Allis v. Buckstaff, 13 Fed. 879; Putnam v. Hollender, 6 Fed. 882, 19 Blatchf. 48; *Ex p.* Henry, L. R. 8 Ch. 167, 42 L. J. Ch. 363, 21 Wkly. Rep. 233; Murray v. Clayton, L. R. 7 Ch. 570, 20 Wkly. Rep. 649; Lewis v. Marling, 10 B. & C. 22, 21 E. C. L. 20, 4 C. & P. 52, 19 E. C. L. 403, 8 L. J. K. B. O. S. 46, 5 M. & R. 66; Pneumatic Tire Co. v. East London Rubber Co., 75 L. T. Rep. N. S. 488.

Mere laboratory experiments will not anticipate. Electric Smelting, etc., Co. v. Pittsburg Reduction Co., 125 Fed. 926, 60 C. C. A. 636.

93. Timolat v. Philadelphia Pneumatic Tool Co., 131 Fed. 257; Hale, etc., Mfg. Co. v. Oneonta, etc., R. Co., 129 Fed. 598; Farmers' Mfg. Co. v. Spruks Mfg. Co., 127 Fed. 691, 62 C. C. A. 447; Kirchberger v. American Acetylene Burner Co., 124 Fed. 764 [affirmed in 128 Fed. 599, 64 C. C. A. 107]; Cimiotti Unhairing Co. v. American Unhairing Mach. Co., 115 Fed. 498, 53 C. C. A. 230.



d. **Necessity For Demonstration of Success.** Ordinarily the invention must have been tested and found satisfactory,<sup>94</sup> although some devices are so simple that no test is necessary to demonstrate their success.<sup>95</sup> And mere mechanical defects which would be cured by the ordinary mechanic will not prevent anticipation.<sup>96</sup>

e. **Abandoned or Unsuccessful Experiments.** Mere unsuccessful and abandoned experiments do not constitute anticipating knowledge or use.<sup>97</sup> To justify

94. *Dashiell v. Tasker*, 21 App. Cas. (D. C.) 64; *Parker v. Hulme*, 18 Fed. Cas. No. 10,740, 1 Fish. Pat. Cas. 44; *Fefel v. Stocker*, 94 Off. Gaz. 433; *Kelly v. Fynn*, 92 Off. Gaz. 1237. And see *supra*, III, C, 4, b; *infra*, IV, A, 5.

Process must have been actually performed. *Piper v. Brown*, 19 Fed. Cas. No. 11,180, 4 Fish. Pat. Cas. 175, *Holmes* 20 [*reversed* on other grounds in 91 U. S. 37, 23 L. ed. 200]; *Croskey v. Atterbury*, 76 Off. Gaz. 163.

Commercial use is not necessary.—*Wyman v. Donnelly*, 21 App. Cas. (D. C.) 81.

95. *Lindemeyr v. Hoffman*, 18 App. Cas. (D. C.) 1; *Mason v. Hepburn*, 13 App. Cas. (D. C.) 86; *Coffin v. Ogden*, 5 Fed. Cas. No. 2,950, 7 Blatchf. 61, 3 Fish. Pat. Cas. 640 [*affirmed* in 18 Wall. 120, 21 L. ed. 821]; *Parker v. Ferguson*, 18 Fed. Cas. No. 10,733, 1 Blatchf. 407, Fish. Pat. Rep. 260. And see *infra*, IV, A, 5, a.

96. *Brush v. Condit*, 132 U. S. 39, 10 S. Ct. 1, 33 L. ed. 251; *Merrimac Mattress Mfg. Co. v. Feldman*, 133 Fed. 64; *Patent Button Co. v. Scovill Mfg. Co.*, 92 Fed. 151; *Aiken v. Dolan*, 1 Fed. Cas. No. 110, 3 Fish. Pat. Cas. 197; *Pitts v. Wemple*, 19 Fed. Cas. No. 11,194, 1 Biss. 87, 5 Fish. Pat. Cas. 10; *Jenner v. Dickinson*, 117 Off. Gaz. 600; *Gallagher v. Hien*, 115 Off. Gaz. 1330; *Bechman v. Wood*, 89 Off. Gaz. 2459; *Hein v. Buhaup*, 81 Off. Gaz. 2088; *Bromley Bros. Carpet Factory v. Stewart*, 61 Off. Gaz. 1481.

97. *Dashiell v. Tasker*, 21 App. Cas. (D. C.) 64; *Tripler v. Linde*, 21 App. Cas. (D. C.) 32; *Traver v. Brown*, 14 App. Cas. (D. C.) 34; *Glidden v. Noble*, 5 App. Cas. (D. C.) 480; *Keystone Mfg. Co. v. Adams*, 151 U. S. 139, 14 S. Ct. 295, 38 L. ed. 103; *Whiteley v. Swayne*, 7 Wall. (U. S.) 685, 19 L. ed. 199; *United Shoe Mach. Co. v. Greenman*, 153 Fed. 283, 82 C. C. A. 581 [*affirming* 145 Fed. 538]; *Arrott v. Standard Sanitary Mfg. Co.*, 131 Fed. 457 [*affirmed* in 135 Fed. 750, 68 C. C. A. 388]; *General Electric Co. v. Wise*, 119 Fed. 922; *R. Thomas, etc., Co. v. Electric Porcelain, etc., Co.*, 111 Fed. 923; *Westinghouse Electric, etc., Co. v. Beacon Lamp Co.*, 95 Fed. 462; *Standard Cartridge Co. v. Peters Cartridge Co.*, 77 Fed. 630, 23 C. C. A. 367; *Gamewell Fire-Alarm Tel. Co. v. Municipal Signal Co.*, 61 Fed. 948, 10 C. C. A. 184; *American Bell Tel. Co. v. American Cushman Tel. Co.*, 35 Fed. 734, 1 L. R. A. 60; *International Tooth-Crown Co. v. Richmond*, 30 Fed. 775; *Hutchinson v. Everett*, 26 Fed. 531; *Hoyt v. Slocum*, 26 Fed. 329; *American Bell Tel. Co. v. People's Tel. Co.*, 25 Fed. 725 [*affirmed* in 126 U. S. 1, 8 S. Ct. 778, 31 L. ed. 863]; *Fay v. Allen*, 24 Fed. 804; *Phillips v. Carroll*, 23 Fed. 249;

*Whittlesey v. Ames*, 13 Fed. 893, 9 Biss. 225; *Albright v. Celluloid Harness Trimming Co.*, 1 Fed. Cas. No. 147, 2 Ban & A. 629, 12 Off. Gaz. 227; *Allen v. Hunter*, 1 Fed. Cas. No. 225, 6 McLean 303; *Aultman v. Holley*, 2 Fed. Cas. No. 656, 11 Blatchf. 317, 6 Fish. Pat. Cas. 534, 5 Off. Gaz. 3; *Blake v. Rawson*, 3 Fed. Cas. No. 1,499, 6 Fish. Pat. Cas. 74, *Holmes* 200, 3 Off. Gaz. 122; *Cahoon v. Ring*, 4 Fed. Cas. No. 2,292, 1 Cliff. 592, 1 Fish. Pat. Cas. 379; *Gallahue v. Butterfield*, 9 Fed. Cas. No. 5,198, 10 Blatchf. 232, 6 Fish. Pat. Cas. 203, 2 Off. Gaz. 645; *Gottfried v. Phillip Best Brewing Co.*, 10 Fed. Cas. No. 5,633, 5 Ban. & A. 4, 17 Off. Gaz. 675; *Hayden v. Suffolk Mfg. Co.*, 11 Fed. Cas. No. 6,261, 4 Fish. Pat. Cas. 86; *Hitchcock v. Shoninger Melodeon Co.*, 12 Fed. Cas. No. 6,537; *Hitchcock v. Tremaine*, 12 Fed. Cas. No. 6,538, 8 Blatchf. 440, 4 Fish. Pat. Cas. 508; *Howe v. Underwood*, 12 Fed. Cas. No. 6,775, 1 Fish. Pat. Cas. 160; *La Baw v. Hawkins*, 14 Fed. Cas. No. 7,960, 1 Ban. & A. 428, 6 Off. Gaz. 724; *Latta v. Shawk*, 14 Fed. Cas. No. 8,116, 1 Bond 259, 1 Fish. Pat. Cas. 465; *McCormick v. Howard*, 15 Fed. Cas. No. 8,719, *McArthur Pat. Cas.* 238; *Many v. Jagger*, 16 Fed. Cas. No. 9,055, 1 Blatchf. 372, Fish. Pat. Rep. 222; *Many v. Sizer*, 16 Fed. Cas. No. 9,056, 1 Fish. Pat. Cas. 17; *Murphy v. Eastham*, 17 Fed. Cas. No. 9,949, 5 Fish. Pat. Cas. 306, *Holmes* 113, 2 Off. Gaz. 61; *Parham v. American Button-hole, etc., Mach. Co.*, 18 Fed. Cas. No. 10,713, 4 Fish. Pat. Cas. 468; *Ransom v. New York*, 20 Fed. Cas. No. 11,573, 1 Fish. Pat. Cas. 252; *Roberts v. Dickey*, 20 Fed. Cas. No. 11,899, 4 Fish. Pat. Cas. 532, 1 Off. Gaz. 4, 4 Brewst. (Pa.) 260; *Singer v. Walmsley*, 22 Fed. Cas. No. 12,900, 1 Fish. Pat. Cas. 558; *Sloat v. Spring*, 22 Fed. Cas. No. 12,948a; *Smith v. Fay*, 22 Fed. Cas. No. 13,045, 6 Fish. Pat. Cas. 446; *Smith v. Glendale Elastic Fabrics Co.*, 22 Fed. Cas. No. 13,050, 1 Ban. & A. 58, *Holmes* 340, 5 Off. Gaz. 429 [*affirmed* in 100 U. S. 110]; *Swift v. Whisen*, 23 Fed. Cas. No. 13,700, 2 Bond 115, 3 Fish. Pat. Cas. 343; *Union Paper Bag Co. v. Pultz, etc., Co.*, 24 Fed. Cas. No. 14,392, 3 Ban. & A. 403, 15 Blatchf. 160, 15 Off. Gaz. 423; *United Nickel Co. v. Anthes*, 24 Fed. Cas. No. 14,406, 5 Fish. Pat. Cas. 517, *Holmes* 155, 1 Off. Gaz. 578; *Washburn v. Gould*, 29 Fed. Cas. No. 17,214, 2 Robb Pat. Cas. 206, 3 Story 122; *Wayne v. Holmes*, 29 Fed. Cas. No. 17,303, 1 Bond 27, 2 Fish. Pat. Cas. 20; *White v. Allen*, 29 Fed. Cas. No. 17,535, 2 Cliff. 224, 2 Fish. Pat. Cas. 440; *Winans v. Danforth*, 30 Fed. Cas. No. 17,859; *Winans v. New York, etc., R. Co.*, 30 Fed. Cas. No. 17,864, 4 Fish. Pat. Cas. 1; *Woodman v.*



a court in overthrowing a patent granted for what appears to be a new and useful invention or improvement, on the ground that the device has been anticipated by another and earlier invention, the court should be well satisfied by clear and credible testimony that the alleged earlier invention actually existed; that it was a perfected device, capable of practical use, and that it was embodied in distinct form, and carried into operation as a complete thing, and was not merely an unperfected or abandoned experiment.<sup>98</sup>

**f. Models and Unpublished Drawings.** Models or unpublished drawings or descriptions, however completely they may disclose the invention, do not anticipate.<sup>99</sup> Illustrative drawings of conceived ideas do not constitute an invention, and unless they are followed up by a seasonable observance of the requirements of the patent laws they can have no effect upon a subsequently granted patent to another.<sup>1</sup>

**g. Accidental Production of Invention.** Prior, accidental production of the same thing does not amount to anticipation, where the operator does not recognize or understand the means by which the accidental result is accomplished,<sup>2</sup> and no knowledge of them or of the method of employment is derived from it by any one.<sup>3</sup> "A chance operation of a principle, unrecognized by any one at the time, and from which no information of its existence, and no knowledge of a method of its employment, is derived by any one, if proved to have occurred, will not be sufficient to defeat the claim of him who first discovers the principle, and, by

Stimpson, 30 Fed. Cas. No. 17,979, 3 Fish. Pat. Cas. 98.

Combinations of similar elements which could not be successfully used to produce the effect produced by the patented machine do not anticipate the patent. *Turrill v. Illinois Cent. R. Co.*, 24 Fed. Cas. No. 14,270, 3 Biss 66, 3 Fish. Pat. Cas. 330.

A single experimental use of an apparatus, afterward destroyed, in such way as to involve the practice of a certain process, does not prevent a subsequent original inventor or discoverer of the same process from having a valid patent therefor. *Piper v. Brown*, 19 Fed. Cas. No. 11,180, 4 Fish. Pat. Cas. 175, Holmes 20.

Mere failure to use invention will not prevent anticipation. *McNish v. Everson*, 2 Fed. 899; *Sayles v. Chicago, etc., R. Co.*, 21 Fed. Cas. No. 12,414, 1 Biss. 468, 2 Fish. Pat. Cas. 523; *Shoup v. Henrici*, 22 Fed. Cas. No. 12,814, 2 Ban. & A. 249; *Waterman v. Thomson*, 29 Fed. Cas. No. 17,260, 2 Fish. Pat. Cas. 461.

Where a patent has been granted for improvements which, after a full and fair trial, resulted in unsuccessful experiments, and have been finally abandoned, if any other person takes up the subject of the improvements and is successful he is entitled to the merit of them as an original inventor. *Whitely v. Swayne*, 7 Wall. (U. S.) 685, 19 L. ed. 199.

98. *Gottfried v. Phillip Best Brewing Co.*, 10 Fed. Cas. No. 5,633, 5 Ban. & A. 4, 17 Off. Gaz. 675.

99. *Mason v. Hepburn*, 13 App. Cas. (D. C.) 86; *Dolbear v. American Tel. Co.*, 126 U. S. 1, 8 S. Ct. 778, 31 L. ed. 863; *American Writing Mach. Co. v. Wagner Typewriter Co.*, 151 Fed. 576, 81 C. C. A. 120 [affirming 138 Fed. 108]; *Standard Cartridge Co. v. Peters Cartridge Co.*, 77

Fed. 630, 23 C. C. A. 367 [affirming 69 Fed. 608]; *Uhlmann v. Bartholomæ, etc.*, *Brewing Co.*, 41 Fed. 132; *Pennsylvania Diamond Drill Co. v. Simpson*, 29 Fed. 288; *Detroit Lubricator Mfg. Co. v. Renchard*, 9 Fed. 293; *Judson v. Cope*, 2 Fed. Cas. No. 7,565, 1 Bond 327, 1 Fish. Pat. Cas. 615; *Cahoon v. Ring*, 4 Fed. Cas. No. 2,292, 1 Cliff. 592, 1 Fish. Pat. Cas. 397; *Ellithorp v. Robertson*, 8 Fed. Cas. No. 4,408, 4 Blatchf. 307, 2 Fish. Pat. Cas. 83; *Reeves v. Keystone Bridge Co.*, 20 Fed. Cas. No. 11,660, 5 Fish. Pat. Cas. 456, 1 Off. Gaz. 466; *Hunter v. Stikeman*, 85 Off. Gaz. 610; *McCormick v. Cleal*, 83 Off. Gaz. 1514; *Croskey v. Atterbury*, 76 Off. Gaz. 163; *Porter v. Loudon*, 73 Off. Gaz. 1551; *New Process Fermentation Co. v. Koch*, 29 Off. Gaz. 535; *In re Atterbury*, 9 Off. Gaz. 640.

1. *Detroit Lubricator Mfg. Co. v. Renchard*, 9 Fed. 293; *Reeves v. Keystone Bridge Co.*, 20 Fed. Cas. No. 11,660, 5 Fish. Pat. Cas. 456, 1 Off. Gaz. 466.

2. *Tilghman v. Proctor*, 102 U. S. 707, 26 L. ed. 279; *Chisholm v. Johnson*, 106 Fed. 191; *German-American Filter Co. v. Erdrich*, 98 Fed. 300; *Tannage Patent Co. v. Donallan*, 93 Fed. 811; *Wickelman v. A. B. Dick*, 88 Fed. 264, 31 C. C. A. 530; *Taylor Burner Co. v. Diamond*, 72 Fed. 182; *Pittsburg Reduction Co. v. Cowles Electric Smelting, etc., Co.*, 55 Fed. 301; *Boyd v. Cherry*, 50 Fed. 279; *Andrews v. Carman*, 1 Fed. Cas. No. 371, 2 Ban. & A. 277, 13 Blatchf. 307, 9 Off. Gaz. 1011; *Colgate v. Western Union Tel. Co.*, 6 Fed. Cas. No. 2,995, 4 Ban. & A. 36, 15 Blatchf. 365, 14 Off. Gaz. 943; *Pelton v. Waters*, 19 Fed. Cas. No. 10, 913, 1 Ban. & A. 599, 7 Off. Gaz. 425; *Ransom v. New York*, 20 Fed. Cas. No. 11,573, 1 Fish. Pat. Cas. 252.

3. *Wickelman v. A. B. Dick Co.*, 88 Fed. 264, 31 C. C. A. 530.



putting it to practical and intelligent use, first makes it available to man."<sup>4</sup> It has been held, however, that to constitute anticipation of a later patent it is enough that such a construction had been in well-established use, whether it originated in design or by accident;<sup>5</sup> and an invention will not be deemed accidental because all the advantages thereof were not understood<sup>6</sup> or because the new form of result had not been before contemplated.<sup>7</sup> While as already shown an accidental and unnoted use does not amount to an anticipation, the mere discovery in an old combination of a new property however beneficial is not patentable.<sup>8</sup>

**h. Lost Art.** An invention which was never made public and which has been forgotten will not anticipate.<sup>9</sup> But an invention merely concealed by the inventor is not a lost art.<sup>10</sup>

**i. Combination of Old Elements.**<sup>11</sup> The fact that the various elements of a combination are old will not anticipate a claim to the combination.<sup>12</sup> To anticipate a combination it must be shown that the same or equivalent elements have been combined in substantially the same way to produce substantially the same result.<sup>13</sup>

4. *Andrews v. Carman*, 1 Fed. Cas. No. 371, 2 Ban. & A. 277, 13 Blatchf. 307, 323, 9 Off. Gaz. 1011 [quoted in *Wickelman v. A. B. Dick Co.*, 88 Fed. 264, 31 C. C. A. 530].

5. *National Harrow Co. v. Quick*, 74 Fed. 236, 20 C. C. A. 410.

6. *Merrimac Mattress Co. v. Feldman*, 133 Fed. 64; *Soehner v. Favorite Stove, etc., Co.*, 84 Fed. 182, 28 C. C. A. 317; *Woodbury Patent Planing Mach. Co. v. Keith*, 30 Fed. Cas. No. 17,970, 4 Ban. & A. 100 [affirmed in 101 U. S. 479, 25 L. ed. 939].

7. *Ansonia Brass, etc., Co. v. Electrical Supply Co.*, 144 U. S. 11, 12 S. Ct. 601, 36 L. ed. 327 [affirming 32 Fed. 81, 35 Fed. 68].

8. *National Meter Co. v. Neptune Meter Co.*, 122 Fed. 82 [affirmed in 129 Fed. 124, 63 C. C. A. 626].

9. *Gaylor v. Wilder*, 10 How. (U. S.) 477, 13 L. ed. 504; *Hall v. Bird*, 11 Fed. Cas. No. 5,926, 6 Blatchf. 438, 3 Fish. Pat. Cas. 595; *Taylor v. Wood*, 23 Fed. Cas. No. 13,808, 1 Ban. & A. 270, 12 Blatchf. 110, 8 Off. Gaz. 90.

10. *Mason v. Hepburn*, 13 App. Cas. (D. C.) 86.

11. Combination or aggregation as involving invention see *infra*, III, E, 20, 21.

New combinations as showing novelty of device see *supra*, III, B, 10.

12. *Allen v. Grimes*, 89 Fed. 869; *Western Electric Co. v. Millheim Electric Tel. Co.*, 88 Fed. 505; *Railway Register Mfg. Co. v. North Hudson County R. Co.*, 26 Fed. 411; *Yale Lock Mfg. Co. v. Norwich Nat. Bank*, 6 Fed. 377, 19 Blatchf. 123; *Blake v. Stafford*, 3 Fed. Cas. No. 1,504, 6 Blatchf. 195, 3 Fish. Pat. Cas. 294; *Booth v. Parks*, 3 Fed. Cas. No. 1,648, 1 Ban. & A. 225, 1 Flipp. 381 [affirmed in 102 U. S. 96, 26 L. ed. 54]; *In re Boughton*, 3 Fed. Cas. No. 1,696, *McArthur Pat. Cas.* 278; *Carr v. Rice*, 5 Fed. Cas. No. 2,440, 1 Fish. Pat. Cas. 198; *Child v. Boston etc., Iron Works*, 5 Fed. Cas. No. 2,675, 6 Fish. Pat. Cas. 606, *Holmes* 303, 5 Off. Gaz. 61; *Christman v. Rumsey*, 5 Fed. Cas. No. 2,704, 4 Ban. & A. 506, 17 Blatchf. 148, 17 Off. Gaz. 903; *Crosby v. Lopouraille*, 6

Fed. Cas. No. 3,424, *Taney* 374; *Emigh v. Chicago, etc., R. Co.*, 8 Fed. Cas. No. 4,448, 1 Biss. 400, 2 Fish. Pat. Cas. 387; *Evans v. Eaton*, 8 Fed. Cas. No. 4,559, 1 Robb Pat. Cas. 68; *Forbush v. Cook*, 9 Fed. Cas. No. 4,931, 2 Fish. Pat. Cas. 668; *Forsyth v. Clapp*, 9 Fed. Cas. No. 4,949, 6 Fish. Pat. Cas. 528, *Holmes* 528, 4 Off. Gaz. 527; *Hailes v. Van Wormer*, 11 Fed. Cas. No. 5,904, 7 Blatchf. 443 [affirmed in 20 Wall. 353, 22 L. ed. 241]; *In re Halsey*, 11 Fed. Cas. No. 5,963, *McArthur Pat. Cas.* 459; *Kelleher v. Darling*, 14 Fed. Cas. No. 7,653, 3 Ban. & A. 438, 4 Cliff. 424, 14 Off. Gaz. 673; *Kerosene Lamp Heater Co. v. Littell*, 14 Fed. Cas. No. 7,724, 3 Ban. & A. 312, 13 Off. Gaz. 1009; *Munson v. Gilbert, etc., Mfg. Co.*, 17 Fed. Cas. No. 9,934, 3 Ban. & A. 595, 18 Off. Gaz. 194; *Pennock v. Dialogue*, 19 Fed. Cas. No. 10,941, 1 Robb Pat. Cas. 466, 2 Wash. 538 [affirmed in 2 Pet. 1, 7 L. ed. 327]; *Sands v. Wardwell*, 21 Fed. Cas. No. 12,306, 3 Cliff. 277; *Tatham v. LeRoy*, 23 Fed. Cas. No. 13,761; *In re Wagner*, 28 Fed. Cas. No. 17,038, *McArthur Pat. Cas.* 510; *Willimantic Linen Co. v. Clark Thread Co.*, 30 Fed. Cas. No. 17,763, 4 Ban. & A. 133; *Winans v. Schenectady, etc., R. Co.*, 30 Fed. Cas. No. 17,865, 2 Blatchf. 279. And see *infra*, III, E, 20, b.

A combination of all the elements but one will not anticipate. *Rice v. Heald*, 20 Fed. Cas. No. 11,752 [reversed on other grounds in 104 U. S. 737, 26 L. ed. 910]; *Watson v. Cunningham*, 29 Fed. Cas. No. 17,280, 4 Fish. Pat. Cas. 528.

13. *Hubbell v. U. S.*, 179 U. S. 86, 21 S. Ct. 28, 45 L. ed. 100; *Parks v. Booth*, 102 U. S. 96, 26 L. ed. 54; *Stilwell-Bierce, etc., Co. v. Eufaula Cotton Oil Co.*, 117 Fed. 410, 54 C. C. A. 584; *Brill v. Third Ave. R. Co.*, 103 Fed. 289; *Gormully, etc., Mfg. Co. v. Stanley Cycle Mfg. Co.*, 90 Fed. 279; *Packard v. Lacing-Stud Co.*, 70 Fed. 66, 16 C. C. A. 639; *American Automaton Weighing Mach. Co. v. Blauvelt*, 50 Fed. 213; *Ross v. Montana Union R. Co.*, 45 Fed. 424; *Bell v. U. S. Stamping Co.*, 19 Fed. 312; *Worswick Mfg.*



j. **Non-Analogous Use.** The fact that the same thing in form is old in a non-analogous art where it is used to perform different functions will not constitute an anticipation or negative novelty.<sup>14</sup>

k. **Evidence**—(i) *PRESUMPTIONS AND BURDEN OF PROOF.* A patent is *prima facie* evidence that the patentee was the original and first inventor of the device patented,<sup>15</sup> and whoever controverts or denies his claim in this respect has the burden of proof upon him to establish the contrary.<sup>16</sup> This presumption of originality, in the absence of the application for the patent, extends back only to the date of the patent,<sup>17</sup> and in no case does it extend further back than to the time of the filing of the original application.<sup>18</sup> Where defendant has shown knowledge and use of the invention prior to the patent, the burden of proving a still prior invention is thrown on plaintiff.<sup>19</sup>

(ii) *ADMISSIBILITY*—(A) *In General.* To overcome the *prima facie* pre-

Co. v. Steiger, 17 Fed. 250; Clark Patent Steam, etc., Regulator Co. v. Copeland, 5 Fed. Cas. No. 2,866, 2 Fish. Pat. Cas. 221; Gottfried v. Phillip Best Brewing Co., 10 Fed. Cas. No. 5,633, 5 Ban. & A. 4, 17 Off. Gaz. 675; Johnson v. Root, 13 Fed. Cas. No. 7,410, 2 Cliff. 637; Latta v. Shawk, 14 Fed. Cas. No. 8,116, 1 Bond 259, 1 Fish. Pat. Cas. 465; Turrill v. Illinois Cent. R. Co., 24 Fed. Cas. No. 14,270, 3 Biss. 66, 3 Fish. Pat. Cas. 330; Watson v. Cunningham, 29 Fed. Cas. No. 17,280, 4 Fish. Pat. Cas. 528.

14. *In re Weiss*, 21 App. Cas. (D. C.) 214; National Meter Co. v. Neptune Meter Co., 122 Fed. 75 [reversed on other grounds in 127 Fed. 563]; Durfee v. Bawo, 118 Fed. 853; Moore v. Schaw, 118 Fed. 602; Daylight Prism Co. v. Marcus Prism Co., 110 Fed. 980; National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co., 106 Fed. 693, 45 C. C. A. 544. And see *supra*, III, B, 8; *infra*, III, E, 15.

**Illustration.**—Panel of ceiling not anticipated by bottom of bird cage or a tea-tray. Kinnear, etc., Co. v. Capital Sheet-Metal Co., 81 Fed. 491.

15. Donoughe v. Hubbard, 27 Fed. 742; Green v. French, 11 Fed. 591; Rogers v. Beecher, 3 Fed. 639; Brodie v. Ophir Silver Min. Co., 4 Fed. Cas. No. 1,919, 4 Fish. Pat. Cas. 137, 5 Sawy. 608; Crouch v. Speer, 6 Fed. Cas. No. 3,438, 1 Ban. & A. 145, 6 Off. Gaz. 187; Doherty v. Haynes, 7 Fed. Cas. No. 3,963, 1 Ban. & A. 289, 4 Cliff. 291; Goodyear v. Day, 10 Fed. Cas. No. 5,566; Hoffheins v. Brandt, 12 Fed. Cas. No. 6,575, 3 Fish. Pat. Cas. 218; Johnson v. Root, 13 Fed. Cas. No. 7,410, 2 Cliff. 637; Knight v. Baltimore, etc., R. Co., 14 Fed. Cas. No. 7,882, 3 Fish. Pat. Cas. 1, Taney 106; Konold v. Klein, 14 Fed. Cas. No. 7,925, 3 Ban. & A. 226, 5 Reporter 427; McMillin v. Barclay, 16 Fed. Cas. No. 8,002, 5 Fish. Pat. Cas. 189, 4 Brewst. (Pa.) 275; Poppenhusen v. New York Gutta Percha Comb Co., 19 Fed. Cas. No. 11,283, 2 Fish. Pat. Cas. 62; Putnam v. Yerrington, 20 Fed. Cas. No. 11,486, 2 Ban. & A. 237, 9 Off. Gaz. 689; Rice v. Heald, 20 Fed. Cas. No. 11,752; Rollhaus v. McPherson, 20 Fed. Cas. No. 12,026; Sands v. Wardwell, 21 Fed. Cas. No. 12,306, 3 Cliff. 277; Serrell v. Collins, 21 Fed. Cas. No. 12,672, 1 Fish. Pat. Cas. 289; Sloat v. Spring, 22 Fed. Cas.

No. 12,948a; Union Sugar Refinery v. Matthiesson, 24 Fed. Cas. No. 14,399, 3 Cliff. 639, 2 Fish. Pat. Cas. 600; Washburn v. Gould, 29 Fed. Cas. No. 17,214, 2 Robb Pat. Cas. 206, 3 Story 122.

The extension of a patent resisted on the ground of want of novelty strengthens the presumption that the patentee was the original inventor. Cook v. Ernest, 6 Fed. Cas. No. 3,155, 5 Fish. Pat. Cas. 396, 2 Off. Gaz. 89, 1 Woods 195.

16. Roberts v. Pittsburgh Wire Co., 69 Fed. 624 [affirmed in 71 Fed. 706, 18 C. C. A. 302]; Roberts v. H. P. Nail Co., 53 Fed. 916; Cohansy Glass Mfg. Co. v. Wharton, 28 Fed. 189; Thayer v. Spaulding, 27 Fed. 66; Duffy v. Reynolds, 24 Fed. 855; Albany Steam Trap Co. v. Felthousen, 20 Fed. 633, 22 Blatchf. 169; Green v. French, 11 Fed. 591; Shirley v. Sanderson, 8 Fed. 905; Brodie v. Ophir Silver Min. Co., 4 Fed. Cas. No. 1,919, 4 Fish. Pat. Cas. 137, 5 Sawy. 608; Crouch v. Speer, 6 Fed. Cas. No. 3,438, 1 Ban. & A. 145, 6 Off. Gaz. 187; Fisk v. Church, 9 Fed. Cas. No. 4,826, 5 Fish. Pat. Cas. 540, 1 Off. Gaz. 634; Hayden v. Suffolk Mfg. Co., 11 Fed. Cas. No. 6,261, 4 Fish. Pat. Cas. 86 [affirmed in 3 Wall. 315, 18 L. ed. 76]; Hoffheins v. Brandt, 12 Fed. Cas. No. 6,575, 3 Fish. Pat. Cas. 218; Howes v. Nute, 12 Fed. Cas. No. 6,790, 4 Cliff. 173, 4 Fish. Pat. Cas. 263; Taylor v. Wood, 23 Fed. Cas. No. 13,808, 1 Ban. & A. 270, 12 Blatchf. 110, 8 Off. Gaz. 90; Wayne v. Holmes, 29 Fed. Cas. No. 17,303, 1 Bond 27, 2 Fish. Pat. Cas. 20.

17. Union Sugar Refinery v. Matthiesson, 24 Fed. Cas. No. 14,399, 3 Cliff. 639, 2 Fish. Pat. Cas. 600; Wing v. Richardson, 30 Fed. Cas. No. 17,869, 2 Cliff. 449, 2 Fish. Pat. Cas. 535.

18. Johnson v. Root, 13 Fed. Cas. No. 7,410, 2 Cliff. 637; White v. Allen, 29 Fed. Cas. No. 17,535, 2 Cliff. 224, 2 Fish. Pat. Cas. 440; Wing v. Richardson, 30 Fed. Cas. No. 17,869, 2 Cliff. 449, 2 Fish. Pat. Cas. 535.

19. Webster Loom Co. v. Higgins, 29 Fed. Cas. No. 17,342, 4 Ban. & A. 88, 15 Blatchf. 446, 16 Off. Gaz. 675. In other words, when the patentee desires to show that his invention was of a date prior to his original application he takes the burden upon himself, and must prove by competent and sufficient evi-



sumption of the validity of a patent, evidence is admissible to prove that the device was previously made and reduced to practice by another in this country;<sup>20</sup> that it had been previously known to, and used by, others here before it was invented by the patentee;<sup>21</sup> or that it had been patented or described in some printed publication prior to the supposed invention by the patentee.<sup>22</sup> Evidence of an acknowledgment that the patentee was the original inventor is also admissible.<sup>23</sup> In rebuttal of evidence to show anticipation, it is competent, as bearing on the state of the art, to introduce the testimony of persons whose business and experience were adapted to bring to them a knowledge of all improvements therein to the effect that no such improvement as that covered by the patent in suit had previously come to their knowledge.<sup>24</sup> In determining whether one invention anticipates another, evidence may be, and in a difficult case ought to be, heard concerning the construction and actual operation of the devices respectively.<sup>25</sup> So too the jury may take into consideration the fact that the prior invention was known to persons who experimented to produce the subsequent invention but failed to do so.<sup>26</sup>

(B) *Application For Patent.* Mere applications for patents cannot be considered on the question of novelty. To make the things described in them available, there must be evidence that such things were actually constructed in working form.<sup>27</sup> Rejected specifications and drawings may be received in evi-

dence that he made the invention at the period suggested, and that he reduced the same to practice in the form of an operative machine. *Johnson v. Root*, 13 Fed. Cas. No. 7,409, 2 Cliff. 108, 2 Fish. Pat. Cas. 291; *Jones v. Sewall*, 13 Fed. Cas. No. 7,495, 3 Cliff. 563, 6 Fish. Pat. Cas. 343, 3 Off. Gaz. 630 [reversed on other grounds in 91 U. S. 171, 23 L. ed. 275]; *Wing v. Richardson*, 30 Fed. Cas. No. 17,869, 2 Cliff. 449, 2 Fish. Pat. Cas. 535.

20. Direct evidence of reduction to practice and use necessary.—The reduction to practice and use of inventions claimed to be prior to the patent in suit, so as to invalidate such patent, must be shown by direct evidence of the construction and use of the machine or device. *Howes v. McNeal*, 4 Fed. 151, 17 Blatchf. 396. Nothing from the patent office can be admitted in evidence of earlier dates than the patent. All such evidence would be hearsay and secondary. *Howes v. McNeal*, *supra*.

File wrappers of patents alleged to anticipate are not competent as evidence to show the reduction to practice and use of the inventions therein claimed at a date prior to the invention of the patent in suit. *Howes v. McNeal*, 4 Fed. 151, 17 Blatchf. 396.

21. Evidence of prior use in a foreign country is inadmissible where such prior use is not shown in a patent or printed publication. *Hurlbut v. Schilling*, 130 U. S. 456, 9 S. Ct. 584, 32 L. ed. 1011.

22. The court must first construe the patent offered in evidence, and if by its true construction it has a tendency to support the issue for which it is offered, it is admissible, but if it has no such tendency, it must be excluded. *Cahoon v. Ring*, 4 Fed. Cas. No. 2,292, 1 Cliff. 592, 1 Fish. Pat. Cas. 397.

A certified copy of a patent afterward surrendered and canceled may be given in evidence to show that a device subsequently pat-

ented is not original. *Delano v. Scott*, 7 Fed. Cas. No. 3,753, Gilp. 489, 1 Robb Pat. Cas. 700.

A certificate of the commissioner of patents of a copy or translation of a French volume in the patent office is inadmissible to prove the existence of an invention prior to the patent in suit, such evidence being merely hearsay. The production of the book itself or a duly sworn and proved translation is the only way its contents can be shown. *Gaylord v. Case*, 5 Ohio Dec. (Reprint) 413, 5 Am. L. Rec. 494.

A drawing exhibited in a mere trade circular, unaccompanied by any evidence that it was ever actually published, or intended for general use, or accessible to the public, is not admissible as a printed publication for the purpose of showing an anticipation. *Britton v. White Mfg. Co.*, 61 Fed. 93. But drawings exhibited for the purpose of showing anticipation of a design patent are not rendered irrelevant by the fact that they are unaccompanied by a written description. This objection merely affects their weight as evidence and not their admissibility. *Britton v. White Mfg. Co.*, *supra*.

23. *Evans v. Eaton*, 8 Fed. Cas. No. 4,559, Pet. C. C. 322, 1 Robb Pat. Cas. 68.

24. *Hitchcock v. Shoninger Melodeon Co.*, 12 Fed. Cas. No. 6,537.

25. *Thomson-Houston Electric Co. v. Western Electric Co.*, 72 Fed. 530, 19 C. C. A. 1.

Evidence of impracticability of prior invention.—Evidence is admissible to show that the device set forth in the prior patent is inoperative, impracticable, and worthless. *Harwood v. Mill River Woolen Mfg. Co.*, 11 Fed. Cas. No. 6,187, 3 Fish. Pat. Cas. 526.

26. *Many v. Jagger*, 16 Fed. Cas. No. 9,055, 1 Blatchf. 372, Fish. Pat. Rep. 222.

27. *Barker v. Stowe*, 2 Fed. Cas. No. 994, 3 Ban. & A. 337, 15 Blatchf. 49, 14 Off. Gaz. 559.



dence, however, after the invention is perfected, to ascertain the date of the invention, the design of the inventor, and the principal intended functions and mode of operation.<sup>28</sup> And it has been held that the defense of prior invention by, and patent to, a third person may be met by producing the application of, and the patent to, such third person, with his accompanying or contemporaneous declarations.<sup>29</sup>

(iii) *WEIGHT AND SUFFICIENCY.* In order to defeat a patent on the ground of want of novelty, the proof of prior use or knowledge must be clear and convincing,<sup>30</sup> and sufficient to establish the fact beyond a reasonable doubt.<sup>31</sup> Anticipation may be established by testimony entirely from recollection of the existence and use of a prior device, when the witnesses are numerous, disinterested, and unimpeached,<sup>32</sup> but not where such testimony is indefinite and contradictory.<sup>33</sup> The bare recollection of one witness in regard to the peculiar construction of a piece of machinery, especially if the structure is one of complex character, is not ordinarily sufficient evidence to defeat a patent;<sup>34</sup> but it may be sufficient where the invention sought to be anticipated is of simple character.<sup>35</sup> Much less testi-

A rejected application for a patent is not evidence that the thing described was ever used (*Herring v. Nelson*, 12 Fed. Cas. No. 6,424, 3 Ban. & A. 55, 14 Blatchf. 293 [*reversed* on other grounds in 107 U. S. 640, 2 S. Ct. 819, 27 L. ed. 601]; *Howes v. McNeal*, 12 Fed. Cas. No. 6,789, 3 Ban. & A. 376, 15 Blatchf. 103, 15 Off. Gaz. 608); nor is such a description a patent or a publication (*Herring v. Nelson*, *supra*; *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 18 Fed. Cas. No. 10,337, 1 Ban. & A. 177, 6 Off. Gaz. 34, 10 Phila. (Pa.) 227).

28. *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 18 Fed. Cas. No. 10,337, 1 Ban. & A. 177, 6 Off. Gaz. 34, 10 Phila. (Pa.) 227.

29. *Hitchcock v. Shoninger Melodeon Co.*, 12 Fed. Cas. No. 6,537.

30. *Washburn, etc., Mfg. Co. v. Beat 'Em All Barbed-Wire Co.*, 143 U. S. 275, 12 S. Ct. 443, 36 L. ed. 154 [*reversing* 33 Fed. 261]; *Electrical Accumulator Co. v. Julien Electric Co.*, 38 Fed. 117; *Donoughe v. Hubbard*, 27 Fed. 742; *Thayer v. Spaulding*, 27 Fed. 66 (strong and convincing if not absolutely conclusive proof); *Zane v. Peck*, 9 Fed. 101; *Woven-Wire Mattress Co. v. Wire-Web Bed Co.*, 8 Fed. 87; *Rogers v. Beecher*, 3 Fed. 639; *Magic Ruffle Co. v. Douglass*, 16 Fed. Cas. No. 8,948, 2 Fish. Pat. Cas. 330; *Taylor v. Wood*, 23 Fed. Cas. No. 13,808, 1 Ban. & A. 270, 12 Blatchf. 110, 8 Off. Gaz. 90.

31. *Washburn, etc., Mfg. Co. v. Beat 'Em All Barbed-Wire Co.*, 143 U. S. 275, 12 S. Ct. 443, 36 L. ed. 154 [*reversing* 33 Fed. 261]; *Coffin v. Ogden*, 18 Wall. (U. S.) 120, 21 L. ed. 821; *Binns v. Zucker, etc., Chemical Co.*, 70 Fed. 711; *Electrical Accumulator Co. v. Julien Electric Co.*, 38 Fed. 117; *Cohansey Glass Mfg. Co. v. Wharton*, 28 Fed. 189; *Wetherell v. Keith*, 27 Fed. 364; *Duffy v. Reynolds*, 24 Fed. 855; *Doubleday v. Beatty*, 11 Fed. 729; *Shirley v. Sanderson*, 8 Fed. 905; *Washburn, etc., Mfg. Co. v. Haish*, 4 Fed. 900, 10 Biss. 65; *Campbell v. James*, 4 Fed. Cas. No. 2,361, 4 Ban. & A. 456, 17 Blatchf. 42, 18 Off. Gaz. 979, 8 Re-

porter 455; *Hawes v. Antisdel*, 11 Fed. Cas. No. 6,234, 2 Ban. & A. 10, 8 Off. Gaz. 685; *Konold v. Klein*, 14 Fed. Cas. No. 7,925, 3 Ban. & A. 226, 5 Reporter 427; *Treadwell v. Bladen*, 24 Fed. Cas. No. 14,154, 1 Robb Pat. Cas. 531, 4 Wash. 703, holding that proof of an article which might have been made by a machine similar to that for which plaintiff afterward obtained a patent is not sufficient to invalidate the patent.

Evidence held sufficient to show prior knowledge and use.—*Simmond v. Morrison*, 44 Fed. 757; *Gibson v. Scribner*, 22 Fed. 840; *Doubleday v. Beatty*, 11 Fed. 729; *Parker v. Ferguson*, 18 Fed. Cas. No. 10,733, 1 Blatchf. 407, Fish. Pat. Rep. 260.

Evidence held insufficient to show prior knowledge or use.—*Lalancé, etc., Mfg. Co. v. Haberman Mfg. Co.*, 55 Fed. 292, 5 C. C. A. 111 [*affirming* 53 Fed. 375]; *Edison Electric Light Co. v. Beacon Vacuum Pump, etc., Co.*, 54 Fed. 678; *Smith v. Davis*, 34 Fed. 783; *Wetherell v. Keith*, 27 Fed. 364; *Yale Lock Mfg. Co. v. Berkshire Nat. Bank*, 26 Fed. 104.

Where the proof of prior knowledge or use is contradictory, mere preponderance is not sufficient to invalidate the patent. The preponderance must be such as to remove all reasonable doubt. *Hawes v. Antisdel*, 11 Fed. Cas. No. 6,234, 2 Ban. & A. 10, 8 Off. Gaz. 685.

32. *American Roll-Paper Co. v. Weston*, 59 Fed. 147, 8 C. C. A. 56.

33. *Untermeyer v. Freund*, 58 Fed. 205, 7 C. C. A. 183; *Shirley v. Sanderson*, 8 Fed. 905; *Hawes v. Antisdel*, 11 Fed. Cas. No. 6,234, 2 Ban. & A. 10, 8 Off. Gaz. 685.

34. *Mack v. Spencer Optical Mfg. Co.*, 52 Fed. 819; *Electrical Accumulator Co. v. Julien Electric Co.*, 38 Fed. 117; *Smith v. Davis*, 34 Fed. 783; *Woven-Wire Mattress Co. v. Wire-Web Bed Co.*, 8 Fed. 87; *Blake v. Eagle Works Mfg. Co.*, 3 Fed. Cas. No. 1,494, 3 Biss. 77, 4 Fish. Pat. Cas. 591; *Blake v. Rawson*, 3 Fed. Cas. No. 1,499, 6 Fish. Pat. Cas. 74, Holmes 200, 3 Off. Gaz. 122.

35. *Lee v. Upson, etc., Co.*, 43 Fed. 670; *Riley v. Daniels*, 20 Fed. Cas. No. 11,837.



mony is sufficient to prove that a very simple invention had been anticipated than is necessary to prove the anticipation of a complex machine.<sup>36</sup>

**D. Utility**<sup>37</sup>—1. **IN GENERAL.** To warrant the allowance of a patent it must be capable of some beneficial use, in contradistinction to what is pernicious, frivolous, or worthless.<sup>38</sup> An invention will be deemed useful when it will operate to perform the functions and secure the result intended, and its use is not contrary to public health or morals.<sup>39</sup> While utility is essential, any utility, however slight, will be sufficient.<sup>40</sup> It is not essential that the invention should be the best

36. *National Casket Co., v. Stoltz*, 157 Fed. 392; *Lee v. Upson, etc., Co.*, 43 Fed. 670; *Riley v. Daniels*, 20 Fed. Cas. No. 11,837.

37. **Conclusiveness and effect of decision of patent office** see *infra*, V, C, 15.

38. *Dickinson v. Hall*, 14 Pick. (Mass.) 217, 25 Am. Dec. 390; *Adams v. Loft*, 1 Fed. Cas. No. 61, 4 Ban. & A. 495, 8 Reporter 612; *Bedford v. Hunt*, 3 Fed. Cas. No. 1,217, 1 Mason 302, 1 Robb Pat. Cas. 148; *Cook v. Ernest*, 6 Fed. Cas. No. 3,155, 5 Fish. Pat. Cas. 396, 1 Woods 195, 2 Off. Gaz. 89; *Cox v. Griggs*, 6 Fed. Cas. No. 3,302, 1 Biss. 362, 2 Fish. Pat. Cas. 174; *Hoffheins v. Brandt*, 12 Fed. Cas. No. 6,575, 3 Fish. Pat. Cas. 218; *Jones v. Wetherill*, 13 Fed. Cas. No. 7,508, *McArthur Pat. Cas.* 409; *Kneass v. Schuylkill Bank*, 14 Fed. Cas. No. 7,875, 1 Robb Pat. Cas. 303, 4 Wash. 9; *Lowell v. Lewis*, 15 Fed. Cas. No. 8,568, 1 Mason 182, 1 Robb Pat. Cas. 131; *Page v. Ferry*, 18 Fed. Cas. No. 10,662, 1 Fish. Pat. Cas. 298; *Parker v. Stiles*, 18 Fed. Cas. No. 10,749, Fish. Pat. Rep. 319, 5 McLean 44; *Roemer v. Logowitz*, 20 Fed. Cas. No. 11,996; *In re Smith*, 22 Fed. Cas. No. 12,982, *McArthur Pat. Cas.* 255; *Thompson v. Haight*, 23 Fed. Cas. No. 13,957; *Westlake v. Carter*, 29 Fed. Cas. No. 17,451, 6 Fish. Pat. Cas. 519, 4 Off. Gaz. 636; *Whitney v. Emmett*, 29 Fed. Cas. No. 17,585, *Baldw.* 303, 1 Robb Pat. Cas. 567; *Wintermute v. Redington*, 30 Fed. Cas. No. 17,896, 1 Fish. Pat. Cas. 239; *Crompton v. Belknap Mills*, 30 Fed. Cas. No. 18,285, 3 Fish. Pat. Cas. 536.

39. Must have practical utility. *Smith v. Nichols*, 21 Wall. (U. S.) 112, 22 L. ed. 566.

**Designs.**—In designs utility relates to ornamental appearance. *Smith v. Whitman Saddle Co.*, 148 U. S. 674, 13 S. Ct. 768, 37 L. ed. 606; *Westinghouse Electric, etc., Co. v. Triumph Electric Co.*, 97 Fed. 99, 38 C. C. A. 65; *Rowe v. Blodgett, etc., Co.*, 98 Off. Gaz. 1286. And see *Simpson v. Davis*, 12 Fed. 144, 20 Blatchf. 413.

An inoperative device is not useful. *Thomson-Houston Electric Co. v. Lorain Steel Co.*, 103 Fed. 641; *Tarrant v. Duluth Lumber Co.*, 30 Fed. 830; *Brown v. Whittemore*, 4 Fed. Cas. No. 2,033, 5 Fish. Pat. Cas. 524, 2 Off. Gaz. 248; *In re Cushman*, 6 Fed. Cas. No. 3,513, *McArthur Pat. Cas.* 569.

Artificial honey is useful and not a fraud. *In re Corbin*, 6 Fed. Cas. No. 3,224, *McArthur Pat. Cas.* 521.

Devices for amusement are useful and patentable. *Boynton Co. v. Morris Chute Co.*, 82 Fed. 440.

Spotting tobacco leaves to deceive users is not a useful invention and the patent is void. *Rickard v. Du Bon*, 103 Fed. 868, 43 C. C. A. 360.

**Devices used for gambling.**—Where a patented device can be used only for gambling purposes, the patent is void for want of utility (*Schultze v. Holtz*, 82 Fed. 448); and the same has been held to be the case in regard to a device which has been used only for gambling purposes, although it is possible that a useful application may be found for it (*Reliance Novelty Co. v. Dworzek*, 80 Fed. 902; *National Automatic Device Co. v. Lloyd*, 40 Fed. 89, 5 L. R. A. 784). But see *Fuller v. Berger*, 120 Fed. 274, 56 C. C. A. 588, 65 L. R. A. 381, holding that a patent for a bogus coin detector for coin-operated vending machines, which is adapted to be used with any coin-operated machine, is not void for lack of utility because it was assigned by the inventor to a manufacturer of gambling machines and has been used solely in connection with such machines.

**Useful by itself.**—It need not be necessarily useful by itself. *Wheeler v. Clipper Mower, etc., Co.*, 29 Fed. Cas. No. 17,493, 10 Blatchf. 181, 6 Fish. Pat. Cas. 1, 2 Off. Gaz. 442.

In England utility does not mean either abstract utility or comparative or competitive utility, or commercial utility. *Welsbach Incandescent Gas Light Co. v. New Incandescent Gas Lighting Co.*, [1900] 1 Ch. 843, 69 L. J. Ch. 343, 82 L. T. Rep. N. S. 293, 48 Wkly. Rep. 362 (*Buckley, J.*); *Hardcastle, 1 Bing. N. Cas.* 182, 3 L. J. C. P. 311, 4 Moore & S. 720, 27 E. C. L. 597.

40. *Dowagiac Mfg. Co. v. Superior Drill Co.*, 115 Fed. 886, 53 C. C. A. 36; *Gibbs v. Hoefner*, 19 Fed. 323; *Chandler v. Ladd*, 5 Fed. Cas. No. 2,593, *McArthur Pat. Cas.* 493; *Conover v. Roach*, 6 Fed. Cas. No. 3,125, 4 Fish. Pat. Cas. 12; *Crouch v. Speer*, 6 Fed. Cas. No. 3,438, 1 Ban. & A. 145, 6 Off. Gaz. 187; *Doherty v. Haynes*, 7 Fed. Cas. No. 3,963, 1 Ban. & A. 289, 4 Cliff. 291, 6 Off. Gaz. 118; *Johnson v. Root*, 13 Fed. Cas. No. 7,411, 1 Fish. Pat. Cas. 351; *Tilghman v. Werk*, 23 Fed. Cas. No. 14,046, 1 Bond 511, 2 Fish. Pat. Cas. 229; *Vance v. Campbell*, 28 Fed. Cas. No. 16,837, 1 Fish. Pat. Cas. 483.

**Limitation of rule.**—The rule that when an invention is useful for some purpose the degree of usefulness is not a subject for consideration is applicable only when the validity of a patent already issued is attacked



of its kind or incapable of improvement,<sup>41</sup> or that it should accomplish all that the inventor claimed for it;<sup>42</sup> and it is of no consequence whether the utility of an invention be general or limited to a few cases.<sup>43</sup> Every patent as to utility depends on the state of the art at the time of the claim made or patent issued;<sup>44</sup> and if the invention was useful when the patent was granted, the patent is valid, and the fact that it has become useless since by the discovery of some other method which dispenses with it gives no right to others to use it.<sup>45</sup>

**2. EVIDENCE OF UTILITY.** Extensive use is evidence of utility;<sup>46</sup> and where an invention involves reflection and experiments to bring it to practical maturity, its evident utility, indicated by its prompt displacement of other devices and extensive use, strongly attest its patentable merit.<sup>47</sup> While the issuance of a patent is not conclusive evidence on the question of utility,<sup>48</sup> it is *prima facie* evidence thereof.<sup>49</sup> The presumptions of the law are in favor of a patent<sup>50</sup> and the burden is on defendant to show that it is not useful in any degree.<sup>51</sup> An infringement of an invention amounts to an admission of utility<sup>52</sup> because use implies utility. It

in a court of law; but when the question is as to the issuance of a patent the rule is that prescribed by the statute (Acts (1836), § 7), namely, that "the Commissioner shall deem it to be sufficiently useful and important." *In re Cushman*, 6 Fed. Cas. No. 3,513, McArthur Pat. Cas. 569.

41. *Lamb Knit Goods Co. v. Lamb Glove, etc., Co.*, 120 Fed. 267, 56 C. C. A. 547; *Crown Cork, etc., Co. v. Aluminum Stopper Co.*, 108 Fed. 845, 48 C. C. A. 72; *Westinghouse v. Boyden Power Brake Co.*, 66 Fed. 997; *Bedford v. Hunt*, 3 Fed. Cas. No. 1,217, 1 Mason 302, 1 Robb Pat. Cas. 148; *Blake v. Smith*, 3 Fed. Cas. No. 1,502; *Carr v. Rice*, 5 Fed. Cas. No. 2,440, 1 Fish. Pat. Cas. 198; *Chandler v. Ladd*, 5 Fed. Cas. No. 2,593, McArthur Pat. Cas. 493; *Many v. Jagger*, 16 Fed. Cas. No. 9,055, 1 Blatchf. 372, 1 Fish. Pat. Rep. 222; *Mix v. Perkins*, 17 Fed. Cas. No. 9,677; *Parkhurst v. Kinsman*, 18 Fed. Cas. No. 10,757, 1 Blatchf. 488, 1 Fish. Pat. Rep. 161; *Wheeler v. Clipper Mower, etc., Co.*, 29 Fed. Cas. No. 17,493, 10 Blatchf. 181, 6 Fish. Pat. Cas. 1, 2 Off. Gaz. 442; *Wilbur v. Beecher*, 29 Fed. Cas. No. 17,634, 2 Blatchf. 132, 1 Fish. Pat. Rep. 401.

42. *Eames v. Cook*, 8 Fed. Cas. No. 4,239, 2 Fish. Pat. Cas. 146.

43. *Bedford v. Hunt*, 3 Fed. Cas. No. 1,217, 1 Mason 302, 1 Robb Pat. Cas. 148.

The word "useful" as used in the statutes does not prescribe general utility as the test of the sufficiency of an invention to support a patent. It is used merely in contradistinction to what is frivolous or mischievous to the public. *Wintermute v. Redington*, 30 Fed. Cas. No. 17,896, 1 Fish. Pat. Cas. 239.

44. *U. S., etc., Salamander Felting Co. v. Haven*, 28 Fed. Cas. No. 16,788, 2 Ban. & A. 164, 9 Off. Gaz. 253; *Wheeler v. Clipper Mower, etc., Co.*, 29 Fed. Cas. No. 17,493, 10 Blatchf. 181, 6 Fish. Pat. Cas. 1, 2 Off. Gaz. 442.

45. *Poppenhusen v. New York Gutta Percha Comb Co.*, 19 Fed. Cas. No. 11,283, 2 Fish. Pat. Cas. 62.

46. *Adams v. Edwards*, 1 Fed. Cas. No. 53, 1 Fish. Pat. Cas. 1; *Schaum v. Baker*, 21

Fed. Cas. No. 12,440. And see *In re Thurston*, 26 App. Cas. (D. C.) 315.

Increased salableness shows utility. *Newbury v. Fowler*, 28 Fed. 454.

47. *Lorillard v. McDowell*, 15 Fed. Cas. No. 8,510, 2 Ban. & A. 531, 11 Off. Gaz. 640, 13 Phila. (Pa.) 461.

48. *Bierce v. Stocking*, 11 Gray (Mass.) 174.

49. *Corvallis Fruit Co. v. Curran*, 8 Fed. 150, 7 Sawy. 270; *Miller, etc., Mfg. Co. v. Du Brul*, 17 Fed. Cas. No. 9,597, 2 Ban. & A. 618, 12 Off. Gaz. 351; *Potter v. Holland*, 19 Fed. Cas. No. 11,330, 4 Blatchf. 238, 1 Fish. Pat. Cas. 382; *Rice v. Heald*, 20 Fed. Cas. No. 11,752 [reversed on other grounds in 104 U. S. 737, 26 L. ed. 910]; *Rollhaus v. McPherson*, 20 Fed. Cas. No. 12,026.

50. *Kirk v. Du Bois*, 33 Fed. 252; *Geier v. Goettinger*, 10 Fed. Cas. No. 5,299, 1 Ban. & A. 553, 7 Off. Gaz. 563.

51. *Kirk v. Du Bois*, 33 Fed. 252; *Parker v. Stiles*, 18 Fed. Cas. No. 10,749, 5 McLean 44, Fish. Pat. Rep. 319; *Vance v. Campbell*, 28 Fed. Cas. No. 16,837, 1 Fish. Pat. Cas. 483.

52. *International Tooth Crown Co. v. Hanks' Dental Assoc.*, 111 Fed. 916 [affirmed in 122 Fed. 74, 58 C. C. A. 180]; *Goss Printing-Press Co. v. Scott*, 108 Fed. 253, 47 C. C. A. 302; *Niles Tool Works v. Betts Mach. Co.*, 27 Fed. 301; *Hancock Inspirator Co. v. Jenks*, 21 Fed. 911; *Foye v. Nichols*, 13 Fed. 125, 8 Sawy. 201; *Tyler v. Crane*, 7 Fed. 775; *Coleman v. Liesor*, 5 Fed. Cas. No. 2,984; *Hays v. Sulsor*, 11 Fed. Cas. No. 6,271, 1 Bond 279, 1 Fish. Pat. Cas. 532; *Simpson v. Mad River R. Co.*, 22 Fed. Cas. No. 12,885, 6 McLean 603; *Smith v. Glendale Elastic Fabrics Co.*, 22 Fed. Cas. No. 13,050, 1 Ban. & A. 58, Holmes 340, 5 Off. Gaz. 429; *Smith v. Prior*, 22 Fed. Cas. No. 13,095, 4 Fish. Pat. Cas. 469, 2 Sawy. 461, 4 Off. Gaz. 633; *Turrill v. Illinois Cent. R. Co.*, 24 Fed. Cas. No. 14,270, 3 Biss. 66, 3 Fish. Pat. Cas. 330; *Vance v. Campbell*, 28 Fed. Cas. No. 16,837, 1 Fish. Pat. Cas. 483; *Whitney v. Mowry*, 29 Fed. Cas. No. 17,594, 4 Fish. Pat. Cas. 207 [reversed on other grounds in 14 Wall. 620, 20 L. ed. 860].



is fair to presume that the person using an invention would not do so if he thought it of no utility,<sup>53</sup> and he is estopped to deny that it possesses utility.<sup>54</sup>

**E. Invention**—1. **NECESSITY.** The subject-matter of patents must be of such a character as to have called for an exercise of the inventive or creative faculties of the mind<sup>55</sup> as distinguished from the mere exercise of the knowledge and judgment expected of those skilled in the particular art,<sup>56</sup> although the right to a patent does not depend upon the quantity of thought, ingenuity, skill, labor, or experiment which was bestowed upon the production.<sup>57</sup>

2. **NATURE.** While attempts have been made to define invention,<sup>58</sup> the courts and text writers have found it impossible to so define it as to furnish a test for determining whether a particular act or discovery called for an exercise of the inventive faculties.<sup>59</sup> It is a matter resting in judgment and therefore no fixed rule for its determination is possible. Certain controlling principles are, however, settled and assist in reaching the proper conclusion in particular cases. Thus it is declared that an act of invention is primarily mental and involves the conception or mental construction of a means not previously known for accomplishing a useful result.<sup>60</sup> It is not the mere adaptation of old means by common reasoning,

The fact that the patented article has superseded all others before in use, and that the party charged with infringing has adopted it in the place of those before made and sold by him, constitutes strong evidence of usefulness. *Smith v. Prior*, 22 Fed. Cas. No. 13,095, 4 Fish. Pat. Cas. 469, 2 Sawy. 461, 4 Off. Gaz. 633.

53. *Coleman v. Liesor*, 6 Fed. Cas. No. 2,984.

54. *Coleman v. Liesor*, 6 Fed. Cas. No. 2,984; *Hays v. Sulsor*, 11 Fed. Cas. No. 6,271, 1 Bond 279, 1 Fish. Pat. Cas. 532; *Vance v. Campbell*, 28 Fed. Cas. No. 16,837, 1 Fish. Pat. Cas. 483.

55. *In re Schraubstadter*, 26 App. Cas. (D. C.) 331; *Yale Lock Mfg. Co. v. Greenleaf*, 117 U. S. 554, 6 S. Ct. 846, 29 L. ed. 952; *Thompson v. Boisselier*, 114 U. S. 1, 5 S. Ct. 1042, 29 L. ed. 76; *Enterprise Mfg. Co. v. Sargent*, 28 Fed. 185; *Patterson v. Gaslight, etc., Co.*, 2 Ch. D. 812, 45 L. J. Ch. 843, 35 L. T. Rep. N. S. 11; *Pirrie v. York St. Flax Spinning Co.*, [1894] 1 Ir. 417; *Nicoll v. Swears*, 69 L. T. Rep. N. S. 110; *Kemp v. Chown*, 7 Can. Exch. 306; *Yates v. Great Western R. Co.*, 2 Ont. App. 226; *Waterous v. Bishop*, 20 U. C. C. P. 29.

If there is an invention to any extent it is sufficient. *Teese v. Phelps*, 23 Fed. Cas. No. 13,819, McAllister 48.

56. *Pearce v. Mulford*, 102 U. S. 112, 26 L. ed. 93; *Muller v. Ellison*, 27 Fed. 456; *Arnold v. Pettee*, 1 Fed. Cas. No. 561b.

New result indicates invention. *Cannington v. Nuttall*, L. R. 5 H. L. 205, 40 L. J. Ch. 739; *Curtis v. Platt*, L. R. 1 H. L. 337, 35 L. J. Ch. 852; *Proctor v. Bennis*, 36 Ch. D. 740, 57 L. J. Ch. 11, 57 L. T. Rep. N. S. 662, 36 Wkly. Rep. 456; *Thompson v. Moore*, L. R. 23 Ir. 599.

57. *Washburn, etc., Mfg. Co. v. Haish*, 4 Fed. 900, 10 Biss. 65; *Hoe v. Cottrell*, 1 Fed. 597, 17 Blatchf. 546; *Carr v. Rice*, 5 Fed. Cas. No. 2,440, 1 Fish. Pat. Cas. 198; *Clark Patent Steam, etc., Co. v. Copeland*, 5 Fed. Cas. No. 2,866, 2 Fish. Pat. Cas. 221; *Jones*

*v. Sewall*, 13 Fed. Cas. No. 7,495, 3 Cliff. 563, 6 Fish. Pat. Cas. 343, 3 Off. Gaz. 630 [reversed on other grounds in 91 U. S. 171, 23 L. ed. 275]; *Magic Ruffle Co. v. Douglas*, 16 Fed. Cas. No. 8,948, 2 Fish. Pat. Cas. 330; *Middleton Tool Co. v. Judd*, 17 Fed. Cas. No. 9,536, 3 Fish. Pat. Cas. 141; *Potter v. Holland*, 19 Fed. Cas. No. 11,330, 4 Blatchf. 238, 1 Fish. Pat. Cas. 382.

58. Invention is that intuitive faculty of the mind put forth in the search of new results or new methods creating what had not before existed or bringing to light what had been hidden from visions. *Hollister v. Benedict, etc., Mfg. Co.*, 113 U. S. 59, 5 S. Ct. 717, 28 L. ed. 901. The finding out, the contriving, the creating of something which did not exist, and was not known before, and which can be made useful and advantageous in the pursuits of life or which can add to the enjoyment of mankind. *Leidersdorf v. Flint*, 15 Fed. Cas. No. 8,219, 8 Biss. 327, 6 Reporter 739.

59. *McClain v. Ortmyer*, 141 U. S. 419, 12 S. Ct. 76, 35 L. ed. 800; *Hanifen v. Armistage*, 117 Fed. 845.

Judicial minds may reach different conclusions in simple cases. *Bear v. Waldrige*, 100 Fed. 465, 40 C. C. A. 496.

60. *Eck v. Kutz*, 132 Fed. 758; *Davis v. Fredericks*, 99 Fed. 69, 21 Blatchf. 556; *Adams v. Edwards*, 1 Fed. Cas. No. 53, 1 Fish. Pat. Cas. 1; *Conover v. Roach*, 6 Fed. Cas. No. 3,125, 4 Fish. Pat. Cas. 12; *Ransom v. New York*, 20 Fed. Cas. No. 11,573, 1 Fish. Pat. Cas. 252. And see *infra*, IV, A, 10.

To constitute invention there must be a definite idea of the complete operative means.—Must leave no essential for subsequent conception. *Wheaton v. Kendall*, 85 Fed. 666.

Mental doubt.—A patentable invention is a mental result. The machine process or product is but its material reflex and embodiment. *Smith v. Nichols*, 21 Wall. (U. S.) 118, 22 L. ed. 566.

The date of invention is the date of the mental conception. *Colt v. Massachusetts Arms Co.*, 6 Fed. Cas. No. 3,030, 1 Fish. Pat.



but is the construction of new means through an exercise of the creative faculties of the mind.<sup>61</sup>

**3. INVENTION AND DISCOVERY SYNONYMOUS.** There is no distinction in patent law between invention and discovery.<sup>62</sup> The discovery of a new substance or element of nature or a new principle or force is not patentable, but the invention or discovery of a new means for making them practically useful may be.<sup>63</sup>

**4. PRIOR ART CONSIDERED.** In determining whether there was invention in a particular case everything previously known in the art through patents, publications, or use must be taken into consideration,<sup>64</sup> since the patentee is in law presumed to have known of everything in the prior art.<sup>65</sup>

**5. NOVELTY AND SUPERIORITY NOT INVENTION.** A party has not necessarily made an invention merely because he has done what no one had done before. Mere novelty and utility are not enough to sustain a patent, since there must also be invention.<sup>66</sup> He must do something which the ordinary person skilled in the art

Cas. 108. See also U. S. Rev. St. (1878) § 4920.

61. *Matter of Gould*, 1 MacArthur (D. C.) 410; *Knapp v. Morss*, 150 U. S. 221, 14 S. Ct. 81, 37 L. ed. 1059; *Dunbar v. Meyers*, 94 U. S. 187, 24 L. ed. 34; *Cleveland Faucet Co. v. Vulcan Brass Co.*, 72 Fed. 505; *Muller v. Ellison*, 27 Fed. 456; *Woodman v. Stimpson*, 30 Fed. Cas. No. 17,979, 3 Fish. Pat. Cas. 98 [*reversed* on other grounds in 10 Wall. 117, 19 L. ed. 866].

**Result.**—Invention may reside more in the result than in the changes of structure. *Stewart v. Mahony*, 5 Fed. 302; *Treadwell v. Fox*, 24 Fed. Cas. No. 14,156. Tapering umbrella stick is patentable. *Rose v. Hirsch*, 77 Fed. 469, 23 C. C. A. 246 [*reversing* 71 Fed. 881].

**Placing hand-holds on book-shelves** is not invention. *Fenton Metallic Mfg. Co. v. Chase*, 73 Fed. 831.

**Mere directions how to use a tool skilfully** is not invention. *Walker v. Rawson*, 29 Fed. Cas. No. 17,083, 4 Ban. & A. 128.

**Changing sequence of operation** is not invention. *Union Paper-Bag Mach. Co. v. Waterbury*, 70 Fed. 240, 17 C. C. A. 84 [*affirming* 58 Fed. 566].

**Putting old article in convenient receptacle** is not invention. *Hurd v. Snow*, 35 Fed. 423.

**Making parts match or fit each other** is not invention. *Delvin v. Heise*, 43 Fed. 795 [*affirmed* in 159 U. S. 251, 15 S. Ct. 1038, 40 L. ed. 138].

**Placing sheets of fly paper face to face** is not invention. *Andrews v. Thum*, 67 Fed. 911, 15 C. C. A. 67 [*reversing* 53 Fed. 84].

**For other cases illustrative of lack of invention** see *Corbin Cabinet Lock Co. v. Eagle Co.*, 150 U. S. 33, 14 S. Ct. 28, 37 L. ed. 989; *Patent Clothing Co. v. Glover*, 141 U. S. 560, 12 S. Ct. 79, 35 L. ed. 858; *McClain v. Ort-mayer*, 141 U. S. 419, 12 S. Ct. 76, 35 L. ed. 800; *Clark Pomace-Holder Co. v. Ferguson*, 119 U. S. 335, 7 S. Ct. 382, 30 L. ed. 406; *Estey v. Burdett*, 109 U. S. 633, 3 S. Ct. 531, 27 L. ed. 1058; *Office Specialty Mfg. Co. v. Cooke, etc., Co.*, 73 Fed. 684; *New York v. American Cable R. Co.*, 70 Fed. 853, 17 C. C. A. 467 [*reversing* 56 Fed. 149, 68 Fed. 227]; *Covert v. Travers Co.*, 70 Fed. 788;

*Philadelphia Novelty Mfg. Co. v. Weeks*, 61 Fed. 405, 9 C. C. A. 555 [*affirming* 52 Fed. 816]; *Butte City St. R. Co. v. Pacific Cable R. Co.*, 60 Fed. 410, 9 C. C. A. 41 [*reversing* 55 Fed. 760]; *Green v. Lynn*, 55 Fed. 516; *National Surface Guard Co. v. Merrill*, 49 Fed. 157, 1 C. C. A. 214; *Root v. Sontag*, 47 Fed. 309; *Davis v. Parkman*, 45 Fed. 693 [*affirmed* in 71 Fed. 961, 18 C. C. A. 398]; *Williams Mfg. Co. v. Franklin*, 41 Fed. 393; *Puetz v. Bransford*, 31 Fed. 458; *Celluloid Mfg. Co. v. Zylonite Novelty Co.*, 30 Fed. 617.

62. *In re Kemper*, 14 Fed. Cas. No. 7,687, *Cranch Pat. Dec.* 89, *McArthur Pat. Cas.* 1.

63. See *supra*, II, A, 5.

64. *Busell Trimmer Co. v. Stevens*, 137 U. S. 423, 11 S. Ct. 150, 34 L. ed. 719 [*affirming* 28 Fed. 575]; *Foot v. Silsby*, 9 Fed. Cas. No. 4,919, 1 Blatchf. 542, 1 Fish. Pat. Rep. 391.

65. *Millett v. Allen*, 27 App. Cas. (D. C.) 70; *Derby v. Thompson*, 146 U. S. 476, 13 S. Ct. 181, 36 L. ed. 1051; *Sewall v. Jones*, 91 U. S. 171, 23 L. ed. 275; *Evans v. Eaton*, 3 Wheat. (U. S.) 454, 4 L. ed. 433; *Lettelier v. Mann*, 91 Fed. 909; *Fry v. Rookwood Pottery Co.*, 90 Fed. 494; *Stearns v. Russell*, 85 Fed. 218, 29 C. C. A. 121; *Crompton v. Knowles*, 7 Fed. 199; *Dawson v. Follen*, 7 Fed. Cas. No. 3,670, 1 Robb Pat. Cas. 9, 2 Wash. 311; *Hovey v. Henry*, 12 Fed. Cas. No. 6,742; *Larabee v. Cortlan*, 14 Fed. Cas. No. 8,084, 3 Fish. Pat. Cas. 5, Taney 180; *Roemer v. Simon*, 20 Fed. Cas. No. 11,997, 1 Ban. & A. 138, 5 Off. Gaz. 555; *Spain v. Gamble*, 22 Fed. Cas. No. 13,199, *McArthur Pat. Cas.* 358.

66. *In re Colton*, 21 App. Cas. (D. C.) 17; *Yale Lock Mfg. Co. v. Greenleaf*, 117 U. S. 554, 6 S. Ct. 846, 29 L. ed. 952; *Thompson v. Boisselier*, 114 U. S. 1, 5 S. Ct. 1042, 29 L. ed. 76; *Milligan, etc., Glue Co. v. Upton*, 97 U. S. 3, 24 L. ed. 985; *Wills v. Scranton Cold Storage Co.*, 147 Fed. 525 [*affirmed* in 153 Fed. 181]; *Dunbar v. Eastern Elevating Co.*, 81 Fed. 201, 26 C. C. A. 330; *Baldwin v. Haynes*, 28 Fed. 99; *May v. Fond du Lac County*, 27 Fed. 691; *Perry v. Co-operative Foundry Co.*, 12 Fed. 436, 20 Blatchf. 498. See also *Wisner v. Grant*, 7 Fed. 485.



would not know how to do if the occasion for it arose.<sup>67</sup> He has not made an invention merely because he was the first to see the occasion or appreciate the advisability of doing the thing,<sup>68</sup> or because he has done it better. An article is not patentable merely because it is better, cheaper, or more merchantable,<sup>69</sup> although novelty combined with superiority may show invention.<sup>70</sup>

**6. SIMPLICITY DOES NOT NEGATIVE.** Simplicity of the means employed does not show that there was no exercise of the inventive faculty in devising it,<sup>71</sup> but on the contrary the highest order of inventive genius may have been required to perceive that such simple means might be used to accomplish the desired result.<sup>72</sup>

**7. COMPLEXITY NOT PROOF OF INVENTION.** Mere multiplicity of elements in the means employed does not show that invention was required to devise it.<sup>73</sup> Multiplicity of elements may go on indefinitely without making invention.<sup>74</sup>

**8. MECHANICAL SKILL.** Where the ordinary person skilled in the particular art advised of the end to be accomplished would spontaneously think of or produce the means for accomplishing it, the production of the means involves mere mechanical skill and not invention.<sup>75</sup> The design of the patent laws is to reward

Utility may help to determine the question of invention, increased efficiency being accepted as an important factor. *American Caramel Co. v. Mills*, 149 Fed. 743, 79 C. C. A. 449.

**67.** *Hollister v. Benedict, etc., Mfg. Co.*, 113 U. S. 59, 5 S. Ct. 717, 28 L. ed. 901; *Dunbar v. Meyers*, 94 U. S. 187, 24 L. ed. 34; *Johnson Co. v. Tidewater Steel Works*, 56 Fed. 43, 5 C. C. A. 412 [*affirming* 50 Fed. 90]; *Welling v. Crane*, 14 Fed. 571; *Barry v. Gugenheim*, 2 Fed. Cas. No. 1,061, 5 Fish. Pat. Cas. 452, 1 Off. Gaz. 382; *Carter v. Mesinger*, 5 Fed. Cas. No. 2,478, 11 Blatchf. 34; *Smith v. Frazer*, 22 Fed. Cas. No. 13,048, 5 Fish. Pat. Cas. 543, 2 Off. Gaz. 175. And see *supra*, III, E, 1; *infra*, III, E, 8.

Every shadow of a shade of an idea is not patentable. *Atlantic Works v. Brady*, 107 U. S. 192, 2 S. Ct. 225, 27 L. ed. 438.

**68.** *Hollister v. Benedict, etc., Mfg. Co.*, 113 U. S. 59, 5 S. Ct. 717, 28 L. ed. 901; *Couse v. Johnson*, 6 Fed. Cas. No. 3,288, 4 Ban. & A. 501, 16 Off. Gaz. 719.

**69.** *Hotchkiss v. Greenwood*, 11 How. (U. S.) 248, 13 L. ed. 683; *Greist Mfg. Co. v. Parsons*, 125 Fed. 116, 60 C. C. A. 34; *Peters v. Union Biscuit Co.*, 120 Fed. 679 [*reversed* on other grounds in 125 Fed. 601, 60 C. C. A. 337]; *Shoe v. Gimbels*, 96 Fed. 96; *Birmingham Cement Mfg. Co. v. Gates Iron Works*, 78 Fed. 350, 24 C. C. A. 132; *Schwarzwaelder v. Detroit*, 77 Fed. 886; *Andrews v. Thum*, 67 Fed. 911, 15 C. C. A. 67; *Smith v. Nichols*, 22 Fed. Cas. No. 13,084, 6 Fish. Pat. Cas. 61, *Holmes* 172, 2 Off. Gaz. 649 [*affirmed* in 21 Wall. 112, 22 L. ed. 566]; *Yearsley v. Brookfield*, 30 Fed. Cas. No. 18,131, *McArthur Pat. Cas.* 193.

**70.** *Ballard v. McCluskey*, 58 Fed. 880.

**71.** *United Shirt, etc., Co. v. Beattie*, 149 Fed. 736, 79 C. C. A. 442 [*affirming* 138 Fed. 136]; *Johnson v. Brooklyn Heights R. Co.*, 75 Fed. 668; *Ross v. Montana Union R. Co.*, 45 Fed. 424; *McCormick v. Seymour*, 15 Fed. Cas. No. 8,726, 2 Blatchf. 240; *Many v. Sizer*, 16 Fed. Cas. No. 9,056, 1 Fish. Pat. Cas. 17; *Tesse v. Phelps*, 23 Fed. Cas. No. 13,819, *McAllister* 48; *Yates v. Great West-*

*ern R. Co.*, 24 Grant Ch. (U. C.) 495; *Sumner v. Abell*, 15 Grant Ch. (U. C.) 532; *Powell v. Begley*, 13 Grant Ch. (U. C.) 381.

**72.** *Webster Loom Co. v. Higgins*, 105 U. S. 580, 26 L. ed. 1177; *Gindorff v. Deering*, 81 Fed. 952; *King v. Hammond*, 14 Fed. Cas. No. 7,797, 4 Fish. Pat. Cas. 488; *Ryah v. Goodwin*, 21 Fed. Cas. No. 12,186, 1 Robb Pat. Cas. 725, 3 Sumn. 514.

**73.** See *infra*, III, E, 21, b.

**74.** *Richards v. Chase Elevator Co.*, 158 U. S. 299, 15 S. Ct. 831, 39 L. ed. 991, 159 U. S. 477, 16 S. Ct. 53, 40 L. ed. 225.

**75.** *In re Volkmann*, 28 App. Cas. (D. C.) 441; *In re Hayes*, 27 App. Cas. (D. C.) 393; *In re Baker*, 26 App. Cas. (D. C.) 363; *Black Diamond Coal-Min. Co. v. Excelsior Coal Co.*, 156 U. S. 611, 15 S. Ct. 482, 39 L. ed. 553; *Giles v. Heysinger*, 150 U. S. 627, 14 S. Ct. 211, 37 L. ed. 1204; *Knapp v. Morss*, 150 U. S. 221, 14 S. Ct. 81, 37 L. ed. 1059; *French v. Carter*, 137 U. S. 239, 11 S. Ct. 90, 34 L. ed. 664; *Shenfield v. Nashawannuck Mfg. Co.*, 137 U. S. 56, 11 S. Ct. 5, 34 L. ed. 573; *Royer v. Roth*, 132 U. S. 201, 10 S. Ct. 58, 33 L. ed. 322; *Aron v. Manhatten R. Co.*, 132 U. S. 84, 10 S. Ct. 24, 33 L. ed. 272; *Clark Pomace-Holder Co. v. Ferguson*, 119 U. S. 335, 7 S. Ct. 382, 30 L. ed. 406; *Yale Lock Mfg. Co. v. Greenleaf*, 117 U. S. 554, 6 S. Ct. 846, 29 L. ed. 952; *Hollister v. Benedict, etc., Mfg. Co.*, 113 U. S. 59, 5 S. Ct. 717, 28 L. ed. 901; *Morris v. McMillin*, 112 U. S. 244, 5 S. Ct. 218, 28 L. ed. 702; *Phillips v. Detroit*, 111 U. S. 604, 4 S. Ct. 580, 28 L. ed. 532; *Slawson v. Grand St., etc., R. Co.*, 107 U. S. 649, 2 S. Ct. 663, 27 L. ed. 576; *Atlantic Works v. Brady*, 107 U. S. 192, 2 S. Ct. 225, 27 L. ed. 438; *Dunbar v. Meyers*, 94 U. S. 187, 24 L. ed. 34; *Smyth Mfg. Co. v. Sheridan*, 149 Fed. 208, 79 C. C. A. 166; *Gates Iron Works v. Overland Gold Min. Co.*, 147 Fed. 700, 78 C. C. A. 88; *Felt, etc., Mfg. Co. v. Mechanical Accountant Co.*, 129 Fed. 386; *U. S. Peg-Wood, etc., Co. v. B. F. Sturtevant Co.*, 125 Fed. 378, 60 C. C. A. 244; *Stanley Rule, etc., Co. v. Ohio Tool Co.*, 115 Fed. 813 [*affirmed* in 125 Fed. 947, 60 C. C. A. 185]; *National Hollow Brake-*



those who make some substantial discovery or invention, which adds to our knowledge and makes a step in advance in the useful arts. It was never their object to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufacture.<sup>76</sup> Mere mechanical skill can never rise to the sphere of invention. The latter involves higher thought and brings into activity a different faculty. Their domains are distinct. The line which separates them is sometimes difficult to trace; nevertheless, in the eye of the law, it always subsists.<sup>77</sup>

**9. SUPERIOR FINISH OR FORM NOT INVENTION.** It is well settled that an article of manufacture is not patentable because means have been devised for making it more perfectly than before.<sup>78</sup> It must be new in itself and not merely in

Beam Co. v. Interchangeable Brake-Beam Co., 99 Fed. 758; Yale, etc., Mfg. Co. v. Sargent, 97 Fed. 106; Davey Pegging-Mach. Co. v. Prouty, 96 Fed. 336; Ingraham Co. v. E. N. Welch Mfg. Co., 92 Fed. 1019, 35 C. C. A. 163; Thomson-Houston Electric Co. v. Union R. Co., 87 Fed. 879; Tiemann v. Kraatz, 85 Fed. 437, 29 C. C. A. 257; Gormully, etc., Mfg. Co. v. Western Wheel Works, 84 Fed. 968, 28 C. C. A. 586; National Harrow Co. v. Wescott, 84 Fed. 671; Buck v. Timony, 78 Fed. 487; National Folding-Box, etc., Co. v. Stecher Lith. Co., 77 Fed. 828; Clune v. Madden, 77 Fed. 205; Schreiber, etc., Co. v. Grimm, 72 Fed. 671, 19 C. C. A. 67; Union Paper-Bag Mach. Co. v. Waterbury, 70 Fed. 240, 17 C. C. A. 84; Smith v. Macbeth, 67 Fed. 137, 14 C. C. A. 241; Westinghouse v. Edison Electric Light Co., 63 Fed. 588, 11 C. C. A. 342; Johnson Co. v. Pennsylvania Steel Co., 62 Fed. 156; Merritt v. Middleton, 61 Fed. 680, 10 C. C. A. 10; Northrop v. Keighley, 48 Fed. 455; Davis v. Parkman, 45 Fed. 693 [affirmed in 71 Fed. 961, 18 C. C. A. 398]; Facer v. Midvale Steel-Work Co., 38 Fed. 231; Yale Lock Mfg. Co. v. Norwich Nat. Bank, 6 Fed. 377, 19 Blatchf. 123; Perfection Window Cleaner Co. v. Bosley, 2 Fed. 574, 9 Biss. 385; Belt v. Crittenden, 2 Fed. 82, 1 McCrary 209; Barry v. Gugenheim, 2 Fed. Cas. No. 1,061, 5 Fish. Pat. Cas. 452, 1 Off. Gaz. 382; Blandy v. Griffith, 3 Fed. Cas. No. 1,529, 3 Fish. Pat. Cas. 609; Flood v. Hicks, 9 Fed. Cas. No. 4,877, 2 Biss. 169, 4 Fish. Pat. Cas. 156; Teese v. Phelps, 23 Fed. Cas. No. 13,819, McAllister 48; Saxby v. Gloucester Waggon Co., 7 Q. B. D. 305, 50 L. J. Q. B. 577 [affirmed in 75 L. T. J. 167].

Although study, effort, and experience were required for the production of the patented device, there is no invention if only mechanical skill was required. Butler v. Steckel, 27 Fed. 219.

An obvious mechanical expedient is not patentable. Consolidated Store-Service Co. v. Siegel-Cooper Co., 103 Fed. 489.

Merely broadening the flange of a mail bag and increasing the number of rivets used in attaching it to the bag require no invention. Thompson v. U. S., 27 Ct. Cl. 61.

A tapering shaft and cylindrical bearing being old in stone crushers, the desirability and practicability of producing a continuous line of contact in the bearing is obvious, and

involves no invention. Fraser v. Gates Iron Works, 85 Fed. 441, 29 C. C. A. 261.

Mechanical skill in making clothing illustrated see Corser v. Brattleboro Overall Co., 93 Fed. 809; Way v. McClarin, 91 Fed. 663; Fay v. Duell, 90 Off. Gaz. 1157; Ypsilanti Dress Stay Mfg. Co. v. Van Valkenburg, 76 Off. Gaz. 333; Dalby v. Lynes, 71 Off. Gaz. 1317; Shenfield v. Nashawannuck Mfg. Co., 53 Off. Gaz. 1093.

The true test of invention is not whether an ordinary mechanic can make the combination, if it is suggested, but whether he would make the combination without suggestion, by means of his ordinary knowledge. Woodman v. Stimpson, 30 Fed. Cas. No. 17,979, 3 Fish. Pat. Cas. 98.

**76.** Atlantic Works v. Brady, 107 U. S. 192, 200, 2 S. Ct. 225, 27 L. ed. 438, in which it was further said: "Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts."

**77.** Blandy v. Griffith, 3 Fed. Cas. No. 1,529, 3 Fish. Pat. Cas. 609.

**78.** *In re* Draper, 10 App. Cas. (D. C.) 545; Risdon Iron, etc., Works v. Medart, 158 U. S. 68, 15 S. Ct. 745, 39 L. ed. 899; Burt v. Evory, 133 U. S. 349, 10 S. Ct. 394, 33 L. ed. 647; Pickering v. McCullough, 104 U. S. 310, 26 L. ed. 749; Smith v. Nichols, 21 Wall. (U. S.) 112, 22 L. ed. 566; Harder v. U. S. Steel Piling Co., 149 Fed. 434; Baker v. Duncombe Mfg. Co., 146 Fed. 744, 77 C. C. A. 234; Farmers' Mfg. Co. v. Spruks Mfg. Co., 119 Fed. 594 [reversed on other grounds in 127 Fed. 691, 62 C. C. A. 447]; National Folding-Box, etc., Co. v. Stecher Lith. Co., 81 Fed. 395, 26 C. C. A. 448; Hake v. Brown, 37 Fed. 783; Aiken v. Dolan, 1 Fed. Cas. No. 110, 3 Fish. Pat. Cas. 197; Arnold v. Pettee, 1 Fed. Cas. No. 561b; *In re* Fultz, 9 Fed. Cas. No. 5,156, McArthur Pat. Cas. 178; Isaacs v. Abrams, 13 Fed. Cas. No. 7,095, 3 Ban. & A. 616, 14 Off. Gaz. 861; Meyer v. Pritchard, 17 Fed. Cas. No. 9,517, 1 Ban. & A. 261, 12 Blatchf. 101, 7 Off. Gaz. 1012; Wooster v.



workmanship.<sup>79</sup> A machine-made article is not patentable over one which is hand-made or rough.<sup>80</sup>

**10. DIFFERENCE IN DEGREE NOT PATENTABLE.** A difference in degree is a mere carrying forward of new or more extended application by one person of the original thought of another.<sup>81</sup> And a change in an existing means which produces nothing save a difference in degree is not patentable.<sup>82</sup>

Calhoun, 30 Fed. Cas. No. 18,035, 11 Blatchf. 215, 6 Fish. Pat. Cas. 514; Huntington v. Lutz, 13 U. C. C. P. 168. And see *supra*, III, B, 9.

Obtaining a more attractive exterior, or securing a more salable article, does not prove originality of conception. *In re Hoey*, 28 App. Cas. (D. C.) 416.

**79.** McDonald v. McLean, 38 Fed. 328, 13 Sawy. 635; Holly v. Vergennes Mach. Co., 4 Fed. 74, 18 Blatchf. 327; Smith v. Elliott, 22 Fed. Cas. No. 13,041, 9 Blatchf. 400, 5 Fish. Pat. Cas. 315, 1 Off. Gaz. 331.

Skilful manipulation does not make invention. *Blakesley Novelty Co. v. Connecticut Web Co.*, 78 Fed. 480.

**80.** Boyd v. Janesville Hay-Tool Co., 37 Fed. 887; U. S. Bung Mfg. Co. v. Independent Bung, etc., Co., 31 Fed. 76, 24 Blatchf. 406; MacKay v. Jackman, 12 Fed. 615, 20 Blatchf. 466; Brooks v. Bicknell, 4 Fed. Cas. No. 1,944, 3 McLean 250, 2 Robb Pat. Cas. 118; Draper v. Hudson, 7 Fed. Cas. No. 4,069, 6 Fish. Pat. Cas. 327, Holmes 208, 3 Off. Gaz. 354; Miller's Falls Co. v. Baekus, 17 Fed. Cas. No. 9,598, 5 Ban. & A. 53, 17 Off. Gaz. 852; *In re Nutting*, 18 Fed. Cas. No. 10,385, McArthur Pat. Cas. 455; Wooster v. Calhoun, 30 Fed. Cas. No. 18,035, 11 Blatchf. 215, 6 Fish. Pat. Cas. 514.

Communited glue is not patentable over glue in flakes. *Milligan, etc., Glue Co. v. Upton*, 17 Fed. Cas. No. 9,607, 1 Ban. & A. 497, 4 Cliff. 237, 6 Off. Gaz. 837 [*affirmed* in 97 U. S. 3, 24 L. ed. 985].

**81.** *In re Klemm*, 21 App. Cas. (D. C.) 186; *In re Iwan*, 17 App. Cas. (D. C.) 566; Voightmann v. Weis, etc., Cornice Co., 133 Fed. 298 [*affirmed* in 148 Fed. 848]; Galvin v. Grand Rapids, 115 Fed. 511, 53 C. C. A. 165; Dodge Mfg. Co. v. Ohio Valley Pulley Works, 101 Fed. 584; Soehner v. Favorite Stove, etc., Co., 84 Fed. 182, 28 C. C. A. 317; Troy Laundry Mach. Co. v. Ap Rees, 67 Fed. 336, 14 C. C. A. 405; Hill v. Houghton, 12 Fed. Cas. No. 6,493, 1 Ban. & A. 291, 6 Off. Gaz. 3; Smith v. Nichols, 22 Fed. Cas. No. 13,084, 6 Fish. Pat. Cas. 61, Holmes 172, 2 Off. Gaz. 649 [*affirmed* in 21 Wall. 112, 22 L. ed. 566].

Mere superiority of device does not prove invention. *Rice v. Heald*, 20 Fed. Cas. No. 11,752 [*reversed* on other grounds in 104 U. S. 737, 26 L. ed. 910].

**82.** *In re Beswick*, 16 App. Cas. (D. C.) 345; American Road-Mach. Co. v. Pennock, etc., Co., 164 U. S. 26, 17 S. Ct. 1, 41 L. ed. 337; Wright v. Yuengling, 155 U. S. 47, 15 S. Ct. 1, 39 L. ed. 64; Ansonia Brass, etc., Co. v. Electrical Supply Co., 144 U. S. 11, 12 S. Ct. 601, 36 L. ed. 327; International Tooth-Crown Co. v. Gaylord, 140 U. S. 55,

11 S. Ct. 716, 35 L. ed. 347; Burt v. Ivory, 133 U. S. 349, 10 S. Ct. 394, 33 L. ed. 647; Guidet v. Brooklyn, 105 U. S. 550, 26 L. ed. 1106; Smith v. Nichols, 21 Wall. (U. S.) 112, 22 L. ed. 566; Eames v. Worcester Polytechnic Inst., 123 Fed. 67, 60 C. C. A. 37; Johnston v. Woodbury, 96 Fed. 421; Lappin Brake-Shoe Co. v. Corning Brake-Shoe Co., 94 Fed. 162 [*affirmed* in 99 Fed. 1004, 40 C. C. A. 2151]; Corser v. Brattleboro Overall Co., 93 Fed. 809; Solvay Process Co. v. Michigan Alkali Co., 90 Fed. 818, 33 C. C. A. 285; Talbot v. Fear, 89 Fed. 197, 32 C. C. A. 186; Gibbon v. Loewer Sole-Rounder Co., 79 Fed. 325, 24 C. C. A. 612; Eastman Co. v. Getz, 77 Fed. 412; Ferris v. Batcheller, 70 Fed. 714; Caverly v. Deere, 66 Fed. 305, 13 C. C. A. 452 [*affirming* 52 Fed. 758]; American Roll-Paper Co. v. Weston, 59 Fed. 147, 8 C. C. A. 56; Steiner Fire-Extinguisher Co. v. Adrian, 59 Fed. 132, 8 C. C. A. 44 [*affirming* 52 Fed. 731]; Curtis v. Overman Wheel Co., 58 Fed. 784, 7 C. C. A. 493 [*reversing* 53 Fed. 247]; D. E. Jones Co. v. Munger Improved Cotton Mach. Mfg. Co., 49 Fed. 61; Peoria Target Co. v. Cleveland Target Co., 47 Fed. 725; Spill v. Celluloid Mfg. Co., 21 Fed. 631, 22 Blatchf. 441; Theberath v. Rubber, etc., Harness Trimming Co., 15 Fed. 246; Sawyer v. Miller, 12 Fed. 725, 4 Woods 472; Perry v. Co-operative Foundry Co., 12 Fed. 149, 20 Blatchf. 505; Beatty v. Hodges, 8 Fed. 610, 19 Blatchf. 381; Dane v. Chicago Mfg. Co., 6 Fed. Cas. No. 3,557, 3 Biss. 380, 6 Fish. Pat. Cas. 130, 2 Off. Gaz. 677; Parkhurst v. Kinsman, 18 Fed. Cas. No. 10,757, 1 Blatchf. 488, Fish. Pat. Rep. 161, 8 N. Y. Leg. Obs. 146; Tatham v. Le Roy, 23 Fed. Cas. No. 13,760, 2 Blatchf. 474; Thomson v. U. S., 27 Ct. Cl. 61.

Mere enlarging and strengthening is not invention. *Woodbury Patent Planing Mach. Co. v. Keith*, 101 U. S. 479, 25 L. ed. 939.

A change in size or proportions is not invention. *Day v. Bankers' etc., Tel. Co.*, 7 Fed. Cas. No. 3,672, 9 Blatchf. 345, 5 Fish. Pat. Cas. 268, 1 Off. Gaz. 551.

Increasing weight of hand-wheel is not invention. *American Road-Mach. Co. v. Pennock, etc., Co.*, 164 U. S. 26, 17 S. Ct. 1, 41 L. ed. 337.

Use of pure chemicals in place of impure is not invention. *Buckan v. McKesson*, 7 Fed. 100, 18 Blatchf. 485.

Change in strength of solution used is not invention. *Spill v. Celluloid Mfg. Co.*, 21 Fed. 631, 22 Blatchf. 441 [*affirmed* in 140 U. S. 698, 11 S. Ct. 1028, 35 L. ed. 593].

Merely extending valve rod for convenience is not invention. *Crosby Steam Gage, etc., Co. v. Ashton Valve Co.*, 94 Fed. 516, 36 C. C. A. 335.



11. **DUPLICATION OF PARTS.**<sup>83</sup> A mere duplication of parts is not patentable;<sup>84</sup> but, where one so modifies the other as to produce a new result and not the mere added results of the two, there may be patentability.<sup>85</sup>

12. **DOUBLE USE.** Double use is the use of an old means for a new but analogous purpose and is not patentable.<sup>86</sup> The application of an old process or

83. Duplication or combination of parts as infringement see *infra*, XIII, A, 6, i.

84. *In re* Volkmann, 28 App. Cas. (D. C.) 441; *In re* Klemm, 21 App. Cas. (D. C.) 186; *McBerty v. Cook*, 16 App. Cas. (D. C.) 133; *Maier v. Bloom*, 95 Fed. 159; *Interior Lumber Co. v. Perkins*, 80 Fed. 523, 25 C. C. A. 613; *Shaw Electric Crane Co. v. Worthington*, 77 Fed. 992; *Office Specialty Mfg. Co. v. Globe Co.*, 77 Fed. 465, 23 C. C. A. 242; *New Departure Bell Co. v. Bevin Bros. Mfg. Co.*, 73 Fed. 469, 19 C. C. A. 534; *Troy Laundry Mach. Co. v. Ap Rees*, 67 Fed. 337, 14 C. C. A. 405; *Thomson v. U. S.*, 27 Ct. Cl. 61; *In re* Scott, 117 Off. Gaz. 278.

Putting additional pane of glass in fare box is not invention. *Slawson v. Grand St.*, etc., R. Co., 107 U. S. 649, 2 S. Ct. 663, 27 L. ed. 576.

The insertion of an additional gear and pinion wheel in a train of such wheels arranged to transmit motion is not invention. *In re* Volkmann, 28 App. Cas. (D. C.) 441.

Putting several articles in one package is not patentable. *King v. Frostel*, 14 Fed. Cas. No. 7,794, 4 Ban. & A. 236, 8 Biss. 510, 8 Reporter 490, 16 Off. Gaz. 956 [affirmed in 109 U. S. 99, 3 S. Ct. 85, 27 L. ed. 870].

Making screen in three parts instead of two is not invention. *Ferguson v. Ed. Roos Mfg. Co.*, 71 Fed. 416, 18 C. C. A. 162.

Connecting the shafts of two mills is not invention. *Consolidated Roller-Mill Co. v. Barnard*, 43 Fed. 527 [affirmed in 156 U. S. 261, 15 S. Ct. 333, 39 L. ed. 417].

Insertion of an additional gear and pinion wheel in a train of such wheels arranged to transmit motion is not invention. *New Departure Bell Co. v. Bevin Bros. Mfg. Co.*, 73 Fed. 469, 19 C. C. A. 534.

85. *Goss Printing-Press Co. v. Scott*, 108 Fed. 253, 47 C. C. A. 302; *Gindorff v. Deering*, 81 Fed. 952; *Brush Electric Co. v. Ft. Wayne Electric Light Co.*, 40 Fed. 826; *Parker v. Hulme*, 18 Fed. Cas. No. 10,740, 1 Fish. Pat. Cas. 44.

86. *In re* McNeil, 28 App. Cas. (D. C.) 461; *In re* Welch, 28 App. Cas. (D. C.) 362; *In re* Klemm, 21 App. Cas. (D. C.) 186; *In re* Bedford, 14 App. Cas. (D. C.) 376; *Mast v. Stover Mfg. Co.*, 177 U. S. 485, 20 S. Ct. 708, 44 L. ed. 856; *Market St. Cable R. Co. v. Rowley*, 155 U. S. 621, 15 S. Ct. 224, 39 L. ed. 284, 70 Off. Gaz. 632; *Leggett v. Standard Oil Co.*, 149 U. S. 287, 13 S. Ct. 902, 37 L. ed. 737, 63 Off. Gaz. 1201; *Lovell Mfg. Co. v. Cary*, 147 U. S. 623, 13 S. Ct. 472, 37 L. ed. 307, 62 Off. Gaz. 1821; *Busell Trimmer Co. v. Stevens*, 137 U. S. 423, 11 S. Ct. 150, 34 L. ed. 719, 53 Off. Gaz. 2044; *Fond du Lac County v. May*, 137 U. S. 395, 11 S. Ct. 98, 34 L. ed. 714; *St. Germain v. Brunswick*, 135 U. S. 227, 10 S. Ct. 822,

34 L. ed. 122, 51 Off. Gaz. 1129; *Howe Mach. Co. v. National Needle Co.*, 134 U. S. 388, 10 S. Ct. 570, 33 L. ed. 963, 31 Off. Gaz. 475; *Marchand v. Emken*, 132 U. S. 195, 10 S. Ct. 65, 33 L. ed. 332, 49 Off. Gaz. 1841; *Day v. Fair Haven*, etc., R. Co., 132 U. S. 98, 10 S. Ct. 11, 33 L. ed. 265, 49 Off. Gaz. 1364; *Peters v. Hanson*, 129 U. S. 541, 9 S. Ct. 393, 32 L. ed. 742, 47 Off. Gaz. 945; *Crescent Brewing Co. v. Gottfried*, 128 U. S. 158, 9 S. Ct. 83, 32 L. ed. 390, 45 Off. Gaz. 944; *Holland v. Shipley*, 127 U. S. 396, 8 S. Ct. 1089, 32 L. ed. 185; *Dreyfus v. Searle*, 124 U. S. 60, 8 S. Ct. 390, 31 L. ed. 352; *Blake v. San Francisco*, 113 U. S. 679, 5 S. Ct. 692, 28 L. ed. 1070; *Morris v. McMillin*, 112 U. S. 244, 5 S. Ct. 218, 28 L. ed. 702; *Pennsylvania R. Co. v. Locomotive Engine Safety Truck Co.*, 110 U. S. 490, 4 S. Ct. 220, 28 L. ed. 222, 27 Off. Gaz. 207; *Vinton v. Hamilton*, 104 U. S. 485, 26 L. ed. 807; *Roberts v. Ryer*, 91 U. S. 150, 23 L. ed. 267; *Brown v. Piper*, 91 U. S. 37, 23 L. ed. 200; *Tucker v. Spalding*, 13 Wall. (U. S.) 453, 20 L. ed. 515; *Baker v. F. A. Duncombe Mfg. Co.*, 146 Fed. 744, 77 C. C. A. 234; *Voightmann v. Weis*, etc., *Cornice Co.*, 133 Fed. 298 [affirmed in 148 Fed. 848]; *Antisdel v. Bent*, 122 Fed. 811; *Indiana Novelty Mfg. Co. v. Crocker Chair Co.*, 103 Fed. 496, 43 C. C. A. 287; *Thomson-Houston Electric Co. v. Nassau Electric R. Co.*, 98 Fed. 105; *Chatillon v. Forschner*, 96 Fed. 342; *Thomson-Houston Electric Co. v. Rahway Electric Light*, etc., *Co.*, 95 Fed. 660; *Briggs v. Duell*, 93 Fed. 972, 36 C. C. A. 38; *Gaitley v. Greene*, 92 Fed. 367; *Falk Mfg. Co. v. Missouri R. Co.*, 91 Fed. 155; *Solvay Process Co. v. Michigan Alkali Co.*, 90 Fed. 818, 33 C. C. A. 285; *Clisby v. Reese*, 88 Fed. 645, 32 C. C. A. 80; *Capital Sheet-Metal Co. v. Kinnear*, etc., *Co.*, 87 Fed. 333, 31 C. C. A. 3; *Safeguard Account Co. v. Wellington*, 86 Fed. 146; *Bannerman v. Sanford*, 85 Fed. 448; *Paul Boynton Co. v. Morris Chute Co.*, 82 Fed. 440; *Interior Lumber Co. v. Perkins*, 80 Fed. 528, 25 C. C. A. 613 [reversing 51 Fed. 286]; *Shaw Electric Crane Co. v. Worthington*, 77 Fed. 992; *Office Specialty Mfg. Co. v. Globe Co.*, 77 Fed. 465, 23 C. C. A. 242 [affirming 65 Fed. 599]; *Potts v. Creager*, 77 Fed. 454; *Adams Electric R. Co. v. Lindell R. Co.*, 77 Fed. 432, 23 C. C. A. 223; *Eastman Co. v. Getz*, 77 Fed. 412; *New Departure Bell Co. v. Bevin Bros. Mfg. Co.*, 73 Fed. 469, 19 C. C. A. 534; *Inman Mfg. Co. v. Beach*, 71 Fed. 420, 18 C. C. A. 165, 74 Off. Gaz. 379; *Codman v. Amia*, 70 Fed. 710 [affirmed in 74 Fed. 634, 20 C. C. A. 566]; *Thomson Meter Co. v. National Meter Co.*, 65 Fed. 427, 12 C. C. A. 671, 70 Off. Gaz. 925; *Steiner Fire-Extinguisher Co. v. Adrian*, 59 Fed. 132, 8 C. C. A. 44; *Forgie v. Oil-Well Supply Co.*,



machine to a similar or analogous subject with no change in the manner of apply-

57 Fed. 742 [*affirmed* in 58 Fed. 871, 7 C. C. A. 551]; *Zinsser v. Krueger*, 48 Fed. 296, 1 C. C. A. 73 [*affirming* 45 Fed. 572]; *Whitcomb v. Spring Valley Coal Co.*, 47 Fed. 652; *Simmond v. Morrison*, 44 Fed. 757; *Grinnell v. Walworth Mfg. Co.*, 43 Fed. 590; *McCarty v. Lehigh Valley R. Co.*, 43 Fed. 384; *Smith v. Partridge*, 42 Fed. 57; *Royer v. Schultz Belting Co.*, 40 Fed. 160 [*following* *Royer v. Chicago Mfg. Co.*, 20 Fed. 853]; *Hale, etc., Mfg. Co. v. Hartford Woven Wire Mattress Co.*, 36 Fed. 762; *Mann's Boudoir Car Co. v. Monarch Parlor Sleeping Car Co.*, 34 Fed. 130; *Byerly v. Cleveland Linseed Oil Works*, 31 Fed. 73; *Scheidler v. Tustin*, 23 Fed. 887; *Royer v. Chicago Mfg. Co.*, 20 Fed. 853; *Clark Pomace-Holder Co. v. Ferguson*, 17 Fed. 79, 21 Blatchf. 376; *New York Grape Sugar Co. v. American Grape Sugar Co.*, 10 Fed. 835, 20 Blatchf. 386; *Gottfried v. Crescent Brewing Co.*, 9 Fed. 762; *Crandal v. Walters*, 9 Fed. 659, 20 Blatchf. 97; *Griffiths v. Holmes*, 8 Fed. 154; *Rowell v. Lindsay*, 6 Fed. 290, 10 Biss. 217 [*affirmed* in 113 U. S. 97, 5 S. Ct. 507, 28 L. ed. 906]; *American Whip Co. v. Hampden Whip Co.*, 1 Fed. 87; *Bean v. Smallwood*, 2 Fed. Cas. No. 1,173, 2 Robb Pat. Cas. 133, 2 Story 408; *Ea p. Berry*, 3 Fed. Cas. No. 1,353; *In re Blandy*, 3 Fed. Cas. No. 1,528, *McArthur Pat. Cas.* 552; *Couse v. Johnson*, 6 Fed. Cas. No. 3,288, 4 Ban. & A. 501, 16 Off. Gaz. 719; *Dennis v. Cross*, 7 Fed. Cas. No. 3,792, 3 Biss. 389, 6 Fish. Pat. Cas. 138; *Hazard v. Green*, 11 Fed. Cas. No. 6,277; *Mahn v. Harwood*, 16 Fed. Cas. No. 8,966, 3 Ban. & A. 515, 14 Off. Gaz. 859 [*affirmed* in 112 U. S. 354, 6 S. Ct. 451, 28 L. ed. 665]; *Northrup v. Adams*, 18 Fed. Cas. No. 10,328, 2 Ban. & A. 567, 12 Off. Gaz. 430; *Piper v. Moon*, 19 Fed. Cas. No. 11,182, 10 Blatchf. 264, 6 Fish. Pat. Cas. 180, 3 Off. Gaz. 4; *Richardson v. Lockwood*, 20 Fed. Cas. No. 11,787, 6 Fish. Pat. Cas. 454, 4 Off. Gaz. 398; *Swift v. Whisen*, 23 Fed. Cas. No. 13,700, 2 Bond 115, 3 Fish. Pat. Cas. 343; *Tyler v. Deval*, 24 Fed. Cas. No. 14,307, 1 Code Rep. (N. Y.) 30; U. S., etc., *Salamander Felting Co. v. Haven*, 28 Fed. Cas. No. 16,788, 2 Ban. & A. 164, 9 Off. Gaz. 253; *Winans v. Boston, etc., R. Co.*, 30 Fed. Cas. No. 17,858, 2 Robb Pat. Cas. 136, 2 Story 412; *Woven-Wire Mattress Co. v. Whittlesey*, 30 Fed. Cas. No. 18,058, 8 Biss. 23; *Millett, etc., Steam Gage, etc., Co. v. Allen*, 115 Off. Gaz. 1586; *In re Adams*, 114 Off. Gaz. 2093; *Parkes v. Stevens*, L. R. 5 Ch. 36, 22 L. T. Rep. N. S. 635, 18 Wkly. Rep. 233; *Jordan v. Moore*, L. R. 1 C. P. 624, 12 Jur. N. S. 766, 35 L. J. C. P. 268, 14 Wkly. Rep. 769; *Reg. v. Cutler*, 14 Q. B. 372 note, 68 E. C. L. 373, 3 C. & K. 215, 1 Stark. 354, 2 E. C. L. 138; *Thompson v. James*, 32 Beav. 570, 55 Eng. Reprint 224; *Window Cleanot Co. v. Bosley*, 15 Brodix Am. & Eng. Pat. Cas. 64; *Ralston v. Smith*, 20 C. B. N. S. 28, 11 H. L. Cas. 223, 35 L. J. C. P. 49, 13 L. T. Rep. N. S. 1, 11 Eng.

Reprint 1318; *Ormson v. Clarke*, 13 C. B. N. S. 337, 9 Jur. N. S. 749, 32 L. J. C. P. 8, 7 L. T. Rep. N. S. 361, 11 Wkly. Rep. 118 [*affirmed* in 14 C. B. N. S. 475, 10 Jur. N. S. 128, 32 L. J. C. P. 291, 11 Wkly. Rep. 787, 108 E. C. L. 475]; *Horton v. Mabon*, 12 C. B. N. S. 437, 31 L. J. C. P. 255, 6 L. T. Rep. N. S. 289, 10 Wkly. Rep. 582, 104 E. C. L. 437 [*affirmed* in 16 C. B. N. S. 141, 9 L. T. Rep. N. S. 815, 12 Wkly. Rep. 491, 111 E. C. L. 141]; *Patent Bottle Envelope Co. v. Seymour*, 5 C. B. N. S. 164, 5 Jur. N. S. 174, 28 L. J. C. P. 22, 94 E. C. L. 164; *Tetley v. Easton*, 2 C. B. N. S. 706, 26 L. J. C. P. 269, 89 E. C. L. 706; *Steiner v. Heald*, 6 Exch. 607, 17 Jur. 875, 20 L. J. Exch. 410; *Young v. Fernie*, 4 Giffard 577, 10 Jur. N. S. 926, 10 L. T. Rep. N. S. 861, 12 Wkly. Rep. 901, 66 Eng. Reprint 836; *Brook v. Aston*, 5 Jur. N. S. 1025, 28 L. J. Q. B. 175 [*affirming* 8 E. & B. 478, 5 Jur. N. S. 279, 27 L. J. Q. B. 145, 6 Wkly. Rep. 42, 92 E. C. L. 478]; *Meldrum v. Wilson*, 7 Can. Exch. 198; *Abell v. McPherson*, 17 Grant Ch. (U. C.) 23 [*affirmed* in 18 Grant Ch. (U. C.) 437].

**Applications of rule.**—Use in gloves of a welt old in shoes is not invention. *Busby v. Ladd*, 39 Fed. 551. Stitch old in cardigan jackets not patentable for undershirts. *Dalby v. Lynes*, 64 Fed. 376. Use of old shifting device on furling machines is not invention. *Royer v. Roth*, 132 U. S. 201, 10 S. Ct. 58, 33 L. ed. 322. Fire-extinguisher is anticipated by soda-water apparatus. *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 18 Fed. Cas. No. 10,337, 1 Ban. & A. 177, 6 Off. Gaz. 34, 10 Phila. (Pa.) 227. Safety pins in ore crusher is mere double use. *Gates Iron Works v. Fraser*, 153 U. S. 332, 14 S. Ct. 883, 38 L. ed. 734. Lifting pills by device used for lifting paper is not patentable. *Stearns v. Russell*, 85 Fed. 218, 29 C. C. A. 121. Anti-friction rollers in pipe cutter is not invention. *Saunders v. Allen*, 60 Fed. 610, 9 C. C. A. 157. Preserving corn by process old for other vegetables is not patentable. *Jones v. Hodges*, 13 Fed. Cas. No. 7,469, *Holmes* 37. Making flat suspender ends like other button holes has been made not invention. *Shenfield v. Nashawannuck Mfg. Co.*, 137 U. S. 56, 11 S. Ct. 5, 34 L. ed. 573. Tempering furniture springs by process old applied to watch springs not invention. *Lovell Mfg. Co. v. Cary*, 147 U. S. 623, 13 S. Ct. 472, 37 L. ed. 307 [*reversing* 31 Fed. 344]. Swaging tooth crowns by old method of swaging is not invention. *Rynear Co. v. Evans*, 83 Fed. 696. Electric gas lighter applied to gas engines is not invention. *Union Gas-Engine Co. v. Doak*, 88 Fed. 86. Hog hoist is anticipated by hoist for building material. *In re Lowry*, 14 App. Cas. (D. C.) 473. Suspenders and stocking supporters are analogous. *In re Smith*, 14 App. Cas. (D. C.) 181. Woodworking machine used in shoemaking is not invention. *McKay-Copeland Lasting Mach. Co. v. Cope-*



ing it and no result substantially distinct in its nature will not sustain a patent even if the new form of result has not before been contemplated.<sup>87</sup>

**13. NEW AND NON-ANALOGOUS USE.** The transfer of an old invention from one art to another which is not analogous and the adaptation of it to perform new functions and accomplish new results in the new art may amount to invention.<sup>88</sup>

land Rapid-Laster Mfg. Co., 77 Fed. 306. Painting on clay and canvas are analogous. Fry v. Rookwood Pottery, 101 Fed. 723, 41 C. C. A. 634. Wood-planing and ice-cutting are analogous. *In re Briggs*, 9 App. Cas. (D. C.) 478. Journal bearings are in the same art in whatever apparatus they are found. *Fraser v. Gates Iron Works*, 85 Fed. 441, 29 C. C. A. 261. Use of valve in a new place is not invention unless changes necessary. *Judson v. Moore*, 14 Fed. Cas. No. 7,569, 1 Bond 285, 1 Fish. Pat. Cas. 544.

**Chemical processes.**—It has been held that the rule does not apply to chemical processes. *Young v. Fernie*, 4 Giffard 577, 10 Jur. N. S. 926, 10 L. T. Rep. N. S. 861, 12 Wkly. Rep. 901, 66 Eng. Reprint 836.

87. *Millett v. Allen*, 27 App. Cas. (D. C.) 70; *In re Butterfield*, 23 App. Cas. (D. C.) 84; *In re Verley*, 19 App. Cas. (D. C.) 597; *In re Nimmy*, 13 App. Cas. (D. C.) 565; *Western Electric Co. v. La Rue*, 139 U. S. 601, 11 S. Ct. 670, 35 L. ed. 294 [affirming 31 Fed. 80, 24 Blatchf. 392]; *Miller v. Foree*, 116 U. S. 22, 6 S. Ct. 204, 29 L. ed. 552; *Pennsylvania R. Co. v. Locomotive Engine Safety Truck Co.*, 110 U. S. 490, 4 S. Ct. 220, 28 L. ed. 222; *National Meter Co. v. Neptune Meter Co.*, 122 Fed. 75 [reversed on other grounds in 127 Fed. 563, 62 C. C. A. 345]; *Johnson Co. v. Toledo Traction Co.*, 119 Fed. 885, 56 C. C. A. 415; *Standard Caster, etc., Co. v. Caster Socket Co.*, 113 Fed. 162, 51 C. C. A. 109; *Thomson-Houston Electric Co. v. Nassau Electric R. Co.*, 107 Fed. 277, 46 C. C. A. 263; *Edison Electric Light Co. v. E. G. Bernard Co.*, 88 Fed. 267; *U. S. Repair, etc., Co. v. Standard Paving Co.*, 87 Fed. 339; *Adams Electric R. Co. v. Lindell R. Co.*, 77 Fed. 432, 23 C. C. A. 223; *Young v. Baltimore County Hedge, etc., Fence Co.*, 51 Fed. 109; *Union Paper-Collar Co. v. Leland*, 24 Fed. Cas. No. 14,394, 1 Ban. & A. 491, *Holmes* 427, 7 Off. Gaz. 221.

88. *In re Weiss*, 21 App. Cas. (D. C.) 214; *Potts v. Creager*, 155 U. S. 597, 15 S. Ct. 194, 39 L. ed. 275; *Hale, etc., Mfg. Co. v. Oneonta, etc., R. Co.*, 124 Fed. 514; *Diamond Drill, etc., Co. v. Kelly*, 120 Fed. 289; *R. Thomas, etc., Co. v. Electric Porcelain, etc., Co.*, 111 Fed. 923; *Wilfley v. Denver Engineering Works Co.*, 111 Fed. 760; *American Well Works v. F. C. Austin Mfg. Co.*, 98 Fed. 992 [affirmed in 121 Fed. 76, 57 C. C. A. 330]; *Dodge v. Porter*, 98 Fed. 624; *Reynolds v. Buzzell*, 96 Fed. 997, 37 C. C. A. 656; *Carnegie Steel Co. v. Cambria Iron Co.*, 89 Fed. 721 [affirmed in 185 U. S. 403, 22 S. Ct. 698, 46 L. ed. 968]; *Hanifen v. E. H. Godshalk Co.*, 78 Fed. 811; *Rose v. Hirsh*, 77 Fed. 469, 23 C. C. A. 246; *Dick Co. v. Henry*, 75 Fed. 388; *Taylor v. Sawyer Spindle Co.*, 75 Fed. 301, 22 C. C. A. 203; *A. B. Dick Co.*

*v. Wichelman*, 74 Fed. 799; *Binns v. Zucker, etc., Chemical Co.*, 70 Fed. 711; *Taws v. Laughlins*, 70 Fed. 102; *Consolidated Brake-Shoe Co. v. Chicago, etc., R. Co.*, 69 Fed. 412; *Pacific Contracting Co. v. Southern California Bituminous Paving Co.*, 48 Fed. 300; *Peninsular Novelty Co. v. American Shoe-Tip Co.*, 39 Fed. 791; *Moffitt v. Rogers*, 8 Fed. 147 [affirmed in 106 U. S. 423, 1 S. Ct. 70, 27 L. ed. 761]; *In re Boughton*, 3 Fed. Cas. No. 1,696, *McArthur Pat. Cas.* 278; *Burden v. Corning*, 4 Fed. Cas. No. 2,144 [reversed on other grounds in 15 How. 252, 14 L. ed. 683]; *Clark Patent Steam, etc., Regulator Co. v. Copeland*, 5 Fed. Cas. No. 2,866, 2 Fish. Pat. Cas. 221; *Gottfried v. Phillip Best Brewing Co.*, 10 Fed. Cas. No. 5,633, 5 Ban. & A. 4, 17 Off. Gaz. 675; *Plastic Slate-Roofing Joint-Stock Co. v. Moore*, 19 Fed. Cas. No. 11,209, *Holmes* 167; *Treadwell v. Parrott*, 24 Fed. Cas. No. 14,158, 5 Blatchf. 369, 3 Fish. Pat. Cas. 124; *Winans v. Schenectady, etc., R. Co.*, 30 Fed. Cas. No. 17,865, 2 Blatchf. 279; *Penn v. Bibby*, L. R. 2 Ch. 127, 36 L. J. Ch. 455, 15 L. T. Rep. N. S. 299, 15 Wkly. Rep. 208; *Lane Fox v. Kensington Electric Lighting Co.*, [1892] 3 Ch. 424, 67 L. T. Rep. N. S. 440; *Higgs v. Goodwin*, E. B. & E. 529, 5 Jur. N. S. 97, 27 L. J. Q. B. 421, 96 E. C. L. 529; *Newton v. Vaucher*, 6 Exch. 859, 21 L. J. Exch. 305; *Hills v. London Gas Light Co.*, 5 H. & N. 312, 29 L. J. Exch. 409; *Crane v. Price*, 12 L. J. C. P. 81, 4 M. & G. 580, 5 Scott N. R. 338, 43 E. C. L. 301; *Gadd v. Manchester*, 67 L. T. Rep. N. S. 569; *Dangerfield v. Jones*, 13 L. T. Rep. N. S. 142; *Bicknell v. Peterson*, 24 Ont. App. 427. And see *supra*, III, B, 8; III, C, 4, j.

**Applications of rule.**—Mending holes in firemen's hose and mending tin cans not analogous. *Ex p. Mackay*, 16 Fed. Cas. No. 8,836. Automatic safe lock not analogous to gas cock. *Yale Lock Co. v. Norwich Nat. Bank*, 6 Fed. 377, 19 Blatchf. 123. Corset springs not analogous to carriage springs. *Barnes v. Straus*, 2 Fed. Cas. No. 1,022, 9 Blatchf. 553, 5 Fish. Pat. Cas. 531, 2 Off. Gaz. 62. Carriage step not analogous to shoe soles or stirrups. *Rubber Step Mfg. Co. v. Metropolitan R. Co.*, 20 Fed. Cas. No. 12,101, 3 Ban. & A. 252, 13 Off. Gaz. 549. Spinning machines and centrifugal driers are not analogous. *Taylor v. Sawyer Spindle Co.*, 75 Fed. 301, 22 C. C. A. 203 [affirming 69 Fed. 837]. Egg crate not anticipated by sample case. *Coburn v. Schroeder*, 8 Fed. 519, 19 Blatchf. 377. Dyeing and tanning are not analogous. *Tannage Co. v. Zahn*, 70 Fed. 1003, 17 C. C. A. 552 [reversing 66 Fed. 986]. Sucker rods for wells and lightning rods are not analogous. *Grosjean v. Peck, etc., Co.*, 11 Fed. Cas. No. 5,841, 11 Blatchf. 54. Wash boiler and bake pan not analogous. *Bell v. U. S. Stamping*



As already shown, if the new use be so nearly analogous to the former one that the applicability of the device to its new use would occur to a person of ordinary mechanical skill, it is only a case of double use; but if the relations between them be remote, and especially if the use of the old device produce a new result, it may at least involve an exercise of the inventive faculty.<sup>89</sup> "Indeed, it often requires as acute a perception of the relation between cause and effect, and as much of the peculiar intuitive genius which is a characteristic of great inventors, to grasp the idea that a device used in one art may be made available in another, as would be necessary to create the device *de novo*. And this is not the less true if, after the thing has been done, it appears to the ordinary mind so simple as to excite wonder that it was not thought of before; . . . but the decisive answer is that with dozens and perhaps hundred of others laboring in the same field, it had never occurred to any one before."<sup>90</sup>

**14. SUBSTITUTION OF EQUIVALENTS**<sup>91</sup>—**a. In General.** The substitution of an art, machine manufacture, or composition of matter of one element or device for another which performs the same functions in substantially the same way and accomplishes substantially the same result is not invention.<sup>92</sup> The substantial

Co., 32 Fed. 549. System of electric distribution not analogous to gas and water distribution. Edison Electric Co. v. Westinghouse, 55 Fed. 490 [reversed on other grounds in 63 Fed. 588, 11 C. C. A. 342]. Combination of muslin and paper patentable for collars, although before used for maps. Union Paper Collar Co. v. White, 24 Fed. Cas. No. 14,396, 2 Ban. & A. 60, 7 Off. Gaz. 698, 877, 11 Phila. (Pa.) 479, 1 Wkly. Notes Cas. 362. Spikes and nails are in different arts. Diamond State Iron Co. v. Goldie, 84 Fed. 972, 28 C. C. A. 589. Dyeing and tanning are not analogous. Tannage Patent Co. v. Donallen, 93 Fed. 811. Spinning wheels and centrifugal machines are not analogous. Taylor v. Sawyer Spindle Co., 75 Fed. 301, 22 C. C. A. 203; Codman v. Amia, 74 Fed. 634, 20 C. C. A. 566. Where no change is necessary to adapt device to new use there is no invention, however remote the art. Stearns v. Russell, 85 Fed. 218, 29 C. C. A. 121.

89. Potts v. Creager, 155 U. S. 597, 15 S. Ct. 194, 39 L. ed. 275; General Electric Co. v. Bullock Electric Mfg. Co., 152 Fed. 427, 81 C. C. A. 569 [reversing 146 Fed. 552].

90. Potts v. Creagher, 155 U. S. 597, 607, 15 S. Ct. 194, 39 L. ed. 275; Taylor v. Sawyer Spindle Co., 75 Fed. 301, 22 C. C. A. 203.

91. Substitution of equivalents of elements in infringing combination see *infra*, XIII, A, 6, g.

92. *In re* Hodges, 28 App. Cas. (D. C.) 525; *In re* Thurston, 26 App. Cas. (D. C.) 315; *In re* McNeill, 20 App. Cas. (D. C.) 294; Lehigh Valley R. Co. v. Kearney, 158 U. S. 461, 15 S. Ct. 871, 39 L. ed. 1055; Du Bois v. Kirk, 158 U. S. 58, 15 S. Ct. 729, 39 L. ed. 895; Sargent v. Covert, 152 U. S. 516, 14 S. Ct. 676, 38 L. ed. 536; Hoyt v. Horne, 145 U. S. 302, 12 S. Ct. 922, 36 L. ed. 713; Hartshorn v. Saginaw Barrel Co., 119 U. S. 664, 7 S. Ct. 421, 30 L. ed. 539; Stephenson v. Brooklyn Cross-Town R. Co., 114 U. S. 149, 5 S. Ct. 777, 29 L. ed. 58; Hall v. Macneale, 107 U. S. 90, 2 S. Ct. 73, 27 L. ed. 367; Heald v. Rice, 104 U. S. 737, 26 L. ed. 910; Crouch v. Roemer, 103 U. S. 797, 26 L. ed. 426;

Union Paper Bag Mach. Co. v. Murphy, 97 U. S. 120, 24 L. ed. 935; Robertson v. Blake, 94 U. S. 728, 24 L. ed. 245; Dunbar v. Meyers, 94 U. S. 187, 24 L. ed. 34; Smith v. Nichols, 21 Wall. (U. S.) 112, 22 L. ed. 566; Stimpson v. Woodman, 10 Wall. (U. S.) 117, 19 L. ed. 866; O'Reilly v. Morse, 15 How. (U. S.) 62, 14 L. ed. 601; Lourie Implement Co. v. Lenhart, 130 Fed. 122, 64 C. C. A. 456; U. S. Peg Wood, etc., Co. v. B. F. Sturtevant Co., 125 Fed. 378, 60 C. C. A. 244; Seiler v. Fuller, etc., Mfg. Co., 121 Fed. 85, 57 C. C. A. 339; Alaska Packers' Assoc. v. Letson, 119 Fed. 599; Lane v. Welds, 99 Fed. 286, 39 C. C. A. 528; Potts v. Creager, 97 Fed. 78, 38 C. C. A. 47; Bundy Mfg. Co. v. Detroit Time-Register Co., 94 Fed. 524, 36 C. C. A. 375; Parsons v. Seelye, 92 Fed. 1005; Boynton Co. v. Morris Chute Co., 82 Fed. 440; Forgie v. Duff Mfg. Co., 81 Fed. 865, 26 C. C. A. 654; New Departure Bell Co. v. Hardware Specialty Co., 69 Fed. 152; Oval Wood Dish Co. v. Sandy Creek, N. Y., Wood Mfg. Co., 60 Fed. 285; Geo. L. Thomson Mfg. Co. v. Walbridge, 60 Fed. 91 [affirmed in 67 Fed. 1021, 15 C. C. A. 166]; Saunders v. Allen, 53 Fed. 109 [affirmed in 60 Fed. 610, 9 C. C. A. 157]; McCarty v. Lehigh Valley R. Co., 43 Fed. 384; American Split-Feather Duster Co. v. Levy, 43 Fed. 381; May v. Fond du Lac County, 27 Fed. 691; Sawyer v. Miller, 12 Fed. 725, 4 Woods 472; Perry v. Co-operative Foundry Co., 12 Fed. 436, 20 Blatchf. 498; Crompton v. Knowles, 7 Fed. 204; Holly v. Vergennes Mfg. Co., 4 Fed. 74, 18 Blatchf. 327; Blanchard's Gun-Stock Turning Factory v. Warner, 3 Fed. Cas. No. 1,521, 1 Blatchf. 258, Fish. Pat. Rep. 184; Conover v. Roach, 6 Fed. Cas. No. 3,125, 4 Fish. Pat. Cas. 12; *Ex p.* Dietz, 7 Fed. Cas. No. 3,902; *In re* Everson, 8 Fed. Cas. No. 4,580, McArthur Pat. Cas. 406; Fisher v. Craig, 9 Fed. Cas. No. 4,817, 1 Ban. & A. 365, 3 Sawy. 69; King v. Louisville Cement Co., 14 Fed. Cas. No. 7,798, 6 Fish. Pat. Cas. 336, 4 Off. Gaz. 181; Potter v. Thayer, 19 Fed. Cas. No. 11,340, 6 Fish. Pat. Cas. 603, Holmes 293, 2 Off. Gaz. 32; Spain v. Gamble, 22 Fed. Cas.



equivalent of a thing is, in the sense of the patent law, the same as the thing itself. Two devices which perform the same function in substantially the same way and accomplish substantially the same result are therefore the same, although they may differ in name and form.<sup>93</sup>

**b. Superiority of Substituted Part No Test.** The fact that the substituted part performs the function better does not make the act of substitution an invention,<sup>94</sup> unless some new or added function or result is secured which would not be obvious to one skilled in the art.<sup>95</sup>

**15. SUBSTITUTION OF MATERIAL.** The mere substitution of one material for another in an old article where it performs substantially the same functions is not an invention,<sup>96</sup> although the substituted material may be better for the pur-

No. 13,199, McArthur Pat. Cas. 358; Treadwell v. Fox, 24 Fed. Cas. No. 14,156; Woodbury Patent Planing-Mach. Co. v. Keith, 30 Fed. Cas. No. 17,970, 4 Ban. & A. 100 [affirmed in 101 U. S. 479, 25 L. ed. 939]; Millett v. Allen, 115 Off. Gaz. 1586; Wisner v. Coulthard, 22 Can. Sup. Ct. 178; Hunter v. Carrick, 11 Can. Sup. Ct. 300; Smith v. Goldie, 9 Can. Sup. Ct. 46.

Substitution of bolt for screw not patentable. Root v. Sontag, 47 Fed. 309.

Substitution of logs for rollers not invention. Woodbury Patent Planing-Mach. Co. v. Keith, 30 Fed. Cas. No. 17,970, 4 Ban. & A. 100 [affirmed in 101 U. S. 479, 25 L. ed. 939].

Substitution of screw for hand operated paddles not invention. Marchand v. Emken, 132 U. S. 195, 10 S. Ct. 65, 33 L. ed. 332 [affirming 26 Fed. 629, 23 Blatchf. 435].

Substitution of electric motor for engine not invention. Shaw Electric Crane Co. v. Shriver, 86 Fed. 466, 30 C. C. A. 196.

Substitution of internal for external gears not invention. Mast v. Stover Mfg. Co., 91 Off. Gaz. 1239.

Unless the mode of operation is the same there is no equivalency.—Conover v. Roach, 6 Fed. Cas. No. 3,125, 4 Fish. Pat. Cas. 12.

Unexpected result shows lack of equivalency.—Westinghouse Electric, etc., Co. v. New England Granite Co., 103 Fed. 951.

Substitution of single element performing function of several.—Where three separate elements in a patented device, each performing an individual function, are supplanted in another device by a single element which itself performs the functions of all three, the threefold capacity of the single element is not the equivalent of the three separate elements. Lambert Hoisting Engine Co. v. Lidgerwood Mfg. Co., 154 Fed. 372, 83 C. C. A. 350 [modifying 150 Fed. 364].

Mechanical devices are equivalents when skilful and experienced workmen know that one will produce the same result as the other. May v. Fond du Lac County, 27 Fed. 691; Carter v. Baker, 5 Fed. Cas. No. 2,472, 4 Fish. Pat. Cas. 404, 1 Savvy. 512; Johnson v. Root, 13 Fed. Cas. No. 7,411, 1 Fish. Pat. Cas. 351.

What are equivalents illustrated.—Howard v. Detroit Stove Works, 150 U. S. 164, 14 S. Ct. 68, 37 L. ed. 1039; Morley Sewing Mach. Co. v. Lancaster, 129 U. S. 263, 9 S. Ct. 299, 32 L. ed. 715; Goodyear Dental Vulcanite

Co. v. Davis, 102 U. S. 222, 26 L. ed. 149; Hyndman v. Roots, 97 U. S. 224, 24 L. ed. 975; Tyler v. Boston, 7 Wall. (U. S.) 327, 19 L. ed. 93.

93. Union Paper Bag Mach. Co. v. Murphy, 97 U. S. 120, 24 L. ed. 935.

94. *In re* McNeill, 20 App. Cas. (D. C.) 294; National Hat-Pouncing Mach. Co. v. Hedden, 148 U. S. 482, 13 S. Ct. 680, 37 L. ed. 529; Stimpson v. Woodman, 10 Wall. (U. S.) 117, 19 L. ed. 866; Lyons v. Bishop, 95 Fed. 154; Parsons v. Seelye, 92 Fed. 1005; Kelly v. Springfield R. Co., 81 Fed. 617 [affirmed in 92 Fed. 614, 34 C. C. A. 570]; National Folding-Box, etc., Co. v. Stecher Lith. Co., 81 Fed. 395, 26 C. C. A. 448; Codman v. Amia, 74 Fed. 634, 20 C. C. A. 566; Puetz v. Bransford, 31 Fed. 458; Hutchinson v. Meyer, 12 Fed. Cas. No. 6,957.

95. Substitution of part performing new function may be invention. Mosher v. Joyce, 31 Fed. 557; Woodward v. Dinsmore, 30 Fed. Cas. No. 18,003, 4 Fish. Pat. Cas. 163.

Torsional spring for fulcrum and coil spring in telegraph instrument is invention. La Rue v. Western Electric Co., 31 Fed. 80, 24 Blatchf. 392 [affirmed in 139 U. S. 601, 11 S. Ct. 670, 35 L. ed. 294].

Coil spring for flat spring invention. Bray v. U. S. Net, etc., Co., 70 Fed. 1006.

96. Brinkerhoff v. Aloe, 146 U. S. 515, 13 S. Ct. 221, 36 L. ed. 1068; Gardner v. Herz, 118 U. S. 180, 6 S. Ct. 1027, 30 L. ed. 158; Houghton v. Whitin Mach. Works, 153 Fed. 740, 83 C. C. A. 84; New York Belting, etc., Co. v. Sierer, 149 Fed. 756 [affirmed in 158 Fed. 819]; Drake Castle Pressed Steel Lug Co. v. Brownell, 123 Fed. 86, 59 C. C. A. 216; National Tooth Crown Co. v. Macdonald, 117 Fed. 617; Union Hardware Co. v. Selchow, 112 Fed. 1006; Billings, etc., Co. v. Van Wagoner, etc., Hardware Co., 98 Fed. 732; Kilbourne v. W. Bingham Co., 50 Fed. 697, 1 C. C. A. 617 [affirming 47 Fed. 57]; Vulcanized Fiber Co. v. Taylor, 49 Fed. 744; Tibbe, etc., Mfg. Co. v. Heineken, 37 Fed. 686; National Sheet-Metal Roofing Co. v. Garwood, 35 Fed. 658; Mott Iron-Works v. Cassidy, 31 Fed. 47, 24 Blatchf. 289; Forscher v. Baumgarten, 26 Fed. 858; Welling v. Crane, 21 Fed. 707; American Iron Co. v. Anglo-American Roofing Co., 16 Fed. 915, 21 Blatchf. 324; Palmenberg v. Buchholz, 13 Fed. 672, 21 Blatchf. 162; Carter v. Mesinger, 5 Fed. Cas. No. 2,473, 11 Blatchf. 34; Holbrook v. Small, 12 Fed. Cas. No. 6,595,



pose.<sup>97</sup> The rule applies even where the material is new and was invented by the one claiming the substitution as his invention. He should claim the material only unless the act of substitution after the production of the material call for inventive thought.<sup>98</sup> Where, however, the substituted material performs new functions and its adaptability for the purpose was not obvious there may be invention in the substitution.<sup>99</sup> And substitution may be considered on the issue of invention where it makes possible changes in other elements of a combination to produce improved operation.<sup>1</sup>

**16. CHANGE OF LOCATION OF PARTS.** Ordinarily changes of the relative location of parts without changing the functions performed is not an invention.<sup>2</sup>

**17. OMISSION OF PARTS.**<sup>3</sup> The omission of a part with a corresponding omission of its function is not invention,<sup>4</sup> but an omission of a part with a rearrangement

2 Ban. & A. 396, 10 Off. Gaz. 508; Mannie v. Everett, 16 Fed. Cas. No. 9,039; Rushton v. Crawley, L. R. 10 Eq. 522; Ball v. Compton Corset Co., 13 Can. Sup. Ct. 469.

**Drawn metal for cast metal is not invention.** McKloskey v. Du Bois, 8 Fed. 710, 19 Blatchf. 205.

**Wood for stone in pavement blocks is not invention.** Phillips v. Detroit, 19 Fed. Cas. No. 11,100, 4 Ban. & A. 347, 17 Off. Gaz. 191 [affirmed in 111 U. S. 604, 4 S. Ct. 580, 28 L. ed. 532].

**Artificial honey is not a mere substitution of materials in real honey.** *In re Corbin*, 6 Fed. Cas. No. 3,224, McArthur Pat. Cas. 521.

**Substitution of materials in designs not invention.** *Post v. T. C. Richards Hardware Co.*, 26 Fed. 618.

**97.** *In re Cheneau*, 5 App. Cas. (D. C.) 197; *Gates Iron Works v. Fraser*, 153 U. S. 332, 14 S. Ct. 883, 38 L. ed. 734 [affirming 42 Fed. 49]; *Florsheim v. Schilling*, 137 U. S. 64, 11 S. Ct. 20, 34 L. ed. 574; *Hicks v. Kelsey*, 18 Wall. (U. S.) 670, 21 L. ed. 852; *A. B. Dick Co. v. Wichelman*, 105 Fed. 629; *Dodge Mfg. Co. v. Ohio Valley Pulley Works*, 101 Fed. 584; *Plastic Fireproof Constr. Co. v. San Francisco*, 97 Fed. 620; *Strom Mfg. Co. v. Weir Frog Co.*, 83 Fed. 170, 27 C. C. A. 502; *Hotchkiss v. Greenwood*, 12 Fed. Cas. No. 6,718, 4 McLean 456, 2 Robb Pat. Cas. 730 [affirmed in 11 How. 248, 13 L. ed. 683]; *In re Maynard*, 16 Fed. Cas. No. 9,352, McArthur Pat. Cas. 536.

**98.** *Brigham v. Coffin*, 149 U. S. 557, 13 S. Ct. 939, 37 L. ed. 845; *Underwood v. Gerber*, 149 U. S. 224, 13 S. Ct. 854, 37 L. ed. 710.

**99.** *Ansonia Brass, etc., Co. v. Electrical Supply Co.*, 144 U. S. 11, 12 S. Ct. 601, 36 L. ed. 327; *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 486, 23 L. ed. 952; *George Frost Co. v. Cohn*, 119 Fed. 505, 56 C. C. A. 185 [affirming 112 Fed. 1009]; *King v. Anderson*, 90 Fed. 500; *Fairbanks Wood Rim Co. v. Moore*, 78 Fed. 490; *Perkins v. Interior Lumber Co.*, 51 Fed. 286; *Clarke v. Johnson*, 4 Fed. 437, 18 Blatchf. 450; *Spill v. Celluloid Mfg. Co.*, 2 Fed. 707, 18 Blatchf. 190; *Ex p. Adams*, 1 Fed. Cas. No. 38a; *Goodyear Dental Vulcanite Co. v. Willis*, 10 Fed. Cas. No. 5,603, 1 Ban. & A. 568, 1 Flipp. 388, 7 Off. Gaz. 41.

**Substitution of carbon filament for platinum is invention.** *Edison Electric Light Co. v. U. S. Electric Lighting Co.*, 52 Fed. 300, 3 C. C. A. 83.

**1.** *Houghton v. Whitin Mach. Works*, 153 Fed. 740, 83 C. C. A. 84.

**2.** *In re Garrett*, 27 App. Cas. (D. C.) 19; *Goss Printing-Press Co. v. Scott*, 108 Fed. 253, 47 C. C. A. 302; *Lettelier v. Mann*, 91 Fed. 909; *Stevenson Co. v. McFassell*, 88 Fed. 278; *Olmsted v. Andrews*, 77 Fed. 835, 23 C. C. A. 488; *New Departure Bell Co. v. Bevin Bros. Mfg. Co.*, 73 Fed. 459, 19 C. C. A. 534; *Reed v. Pomeroy*, 71 Fed. 299; *Stutz v. Robson*, 54 Fed. 506; *Haughey v. Lee*, 48 Fed. 382; *Davis v. Parkman*, 45 Fed. 693 [affirmed in 71 Fed. 961, 18 C. C. A. 398]; *Gorse v. Parker*, 35 Fed. 129; *Hancock Inspirator Co. v. Lelly*, 27 Fed. 88; *Dederick v. Whitman Agricultural Co.*, 26 Fed. 755; *Phipps v. Yost*, 26 Fed. 447; *Dane v. Illinois*, 6 Fed. Cas. No. 3,558, 3 Biss. 374, 6 Fish. Pat. Cas. 124, 2 Off. Gaz. 680; *Gilbert, etc., Mfg. Co. v. Walworth Mfg. Co.*, 10 Fed. Cas. No. 5,418, 2 Ban. & A. 271, 9 Off. Gaz. 746; *Kirby v. Beardsley*, 14 Fed. Cas. No. 7,837, 5 Blatchf. 438, 3 Fish. Pat. Cas. 265; *Marsh v. Dodge, etc., Mfg. Co.*, 16 Fed. Cas. No. 9,115; *Owens v. Taylor*, 29 Grant Ch. (U. C.) 210; *Taylor v. Brandon Mfg. Co.*, 21 Ont. App. 361.

**Mere reversal of parts is not invention.** *In re Iwan*, 17 App. Cas. (D. C.) 566; *Penfield v. Chambers Bros. Co.*, 92 Fed. 630, 34 C. C. A. 579; *Sax v. Taylor Iron Works*, 30 Fed. 835 [affirmed in 149 U. S. 485, 13 S. Ct. 1051, 37 L. ed. 964].

**Making lower roll instead of upper movable is not invention.** *Abbott Mach. Co. v. Bonn*, 51 Fed. 223.

**Changing location of attachment for train pipes for convenience is not invention.** *Plumb v. New York, etc., R. Co.*, 97 Fed. 645.

**3. Omission of elements in infringing combination see *infra*, XIII, A, 6, h.**

**4.** *In re Butterfield*, 23 App. Cas. (D. C.) 84; *Richards v. Chase Elevator Co.*, 159 U. S. 477, 16 S. Ct. 53, 40 L. ed. 225; *Magin v. Karle*, 150 U. S. 387, 14 S. Ct. 153, 37 L. ed. 1118; *Dececo Co. v. George E. Gilchrist Co.*, 125 Fed. 293, 60 C. C. A. 207; *Gormully, etc., Mfg. Co. v. Sager Mfg. Co.*, 87 Fed. 945; *Ferguson v. Ed. Roos Mfg. Co.*, 71 Fed. 416, 18 C. C. A. 162; *Needham v.*



of the remaining parts whereby the same result is secured by a less number of parts may be.<sup>5</sup>

**18. MAKING PARTS INTEGRAL OR SEPARATE.** There is ordinarily no invention in making solid castings in place of attached parts,<sup>6</sup> or in making separately parts before made integral.<sup>7</sup> The practice is so well known as to be within the knowledge of the ordinary mechanic.<sup>8</sup>

**19. MAKING DEVICE PORTABLE.** There is no invention in merely making an old device in such form that it is portable.<sup>9</sup>

**20. COMBINATION<sup>10</sup>—a. In General.** Where old elements are brought into a new relation, where by their interaction they perform new functions and produce a new result there is a patentable invention.<sup>11</sup> But it is not invention to merely

Washburn, 17 Fed. Cas. No. 10,082, 1 Ban. & A. 537, 4 Cliff. 254, 7 Off. Gaz. 649; Stow v. Chicago, 23 Fed. Cas. No. 13,512, 3 Ban. & A. 83, 8 Biss. 47 [affirmed in 104 U. S. 547, 26 L. ed. 816].

**5.** Richards v. Chase Elevator Co., 159 U. S. 477, 16 S. Ct. 53, 40 L. ed. 225; Magin v. Karle, 150 U. S. 387, 14 S. Ct. 153, 37 L. ed. 1118; Lawther v. Hamilton, 124 U. S. 1, 8 S. Ct. 342, 31 L. ed. 325; Brown v. Huntington Piano Co., 134 Fed. 735, 67 C. C. A. 639 [affirming 131 Fed. 273]; Eck v. Kutz, 132 Fed. 758; Dececo Co. v. George E. Gilchrist Co., 125 Fed. 293; American Graphophone Co. v. Leeds, 87 Fed. 873; Coupe v. Weatherhead, 16 Fed. 673; Stow v. Chicago, 23 Fed. Cas. No. 13,512, 3 Ban. & A. 83, 8 Biss. 47 [affirmed in 104 U. S. 547, 26 L. ed. 816].

Omission of element of composition may be invention. Tarr v. Folsom, 23 Fed. Cas. No. 13,756, 1 Ban. & A. 24, Holmes 312, 5 Off. Gaz. 92.

**6.** Howard v. Detroit Stove Works, 150 U. S. 164, 14 S. Ct. 68, 37 L. ed. 1039; General Electric Co. v. Yost Electric Mfg. Co., 131 Fed. 874; Eames v. Worcester Polytechnic Inst., 123 Fed. 67, 60 C. C. A. 37; Lay v. Indianapolis Brush, etc., Mfg. Co., 120 Fed. 831, 57 C. C. A. 313; Standard Caster, etc., Co. v. Caster Socket Co., 113 Fed. 162, 51 C. C. A. 109; Consolidated Electric Mfg. Co. v. Holtzer, 67 Fed. 907, 15 C. C. A. 63; Williams v. Goodyear Metallic Rubber Shoe Co., 54 Fed. 498, 4 C. C. A. 485; Kilbourne v. W. Bingham Co., 50 Fed. 697, 1 C. C. A. 617 [affirming 47 Fed. 57]; Bothe v. Paddock-Hawley Iron Co., 50 Fed. 536, 1 C. C. A. 575.

Riveted in place of cast parts is not patentable. Johnson Co. v. Pacific Rolling Mills Co., 59 Fed. 242.

Pasting parts together is not invention. Johnson v. Hero Fruit-Jar Co., 55 Fed. 659.

Swaging instead of casting is not invention. Strom Mfg. Co. v. Weir Frog Co., 75 Fed. 279 [affirmed in 83 Fed. 170, 27 C. C. A. 502].

Fusing instead of cementing parts is not invention. *In re Locke*, 17 App. Cas. (D. C.) 314.

Making collar button in one piece is patentable. Kremenz v. S. Cottle Co., 148 U. S. 556, 13 S. Ct. 719, 37 L. ed. 558 [reversing 39 Fed. 323].

**7.** Making part detachable is not invention. Roehr v. Bliss, 82 Fed. 445; Kidd v. Horry, 33 Fed. 712.

Making parts removable may be invention. McMichael, etc., Mfg. Co. v. Stafford, 105 Fed. 380.

**8.** *In re Seabury*, 23 App. Cas. (D. C.) 377.

**9.** Hendy v. Golden State, etc., Iron Works, 127 U. S. 370, 8 S. Ct. 1275, 32 L. ed. 207; Thompson v. Boisselier, 114 U. S. 1, 5 S. Ct. 1042, 29 L. ed. 76; Atlantic Works v. Brady, 107 U. S. 192, 2 S. Ct. 225, 27 L. ed. 438; Olmsted v. Andrews, 77 Fed. 835, 23 C. C. A. 488; Black Diamond Coal Min. Co. v. Excelsior Coal Co., 70 Off. Gaz. 1797. And see Kokomo Fence Machine Co. v. Kitselman, 189 U. S. 8 [reversing 108 Fed. 632, 47 C. C. A. 538].

**10.** Combination of parts of prior invention as showing prior knowledge or use see *supra*, III, C, 4, i.

New combination as showing novelty of device see *supra*, III, B, 10.

**11.** Hailes v. Van Wormer, 20 Wall. (U. S.) 353, 22 L. ed. 241; Seymour v. Osborne, 11 Wall. (U. S.) 516, 20 L. ed. 33; Spear v. Keystone Lantern Co., 131 Fed. 879 [reversed on other grounds in 136 Fed. 595, 69 C. C. A. 369]; Perkins Electric Switch Mfg. Co. v. Buchanan, 129 Fed. 134 [affirmed in 135 Fed. 90, 67 C. C. A. 564]; L. A. Thompson Scenic R. Co. v. Chestnut Hill Casino Co., 127 Fed. 698, 62 C. C. A. 454; Brill v. North Jersey St. R. Co., 124 Fed. 778 [reversed on other grounds in 134 Fed. 580, 67 C. C. A. 380]; Peters v. Union Biscuit Co., 120 Fed. 679 [reversed on other grounds in 125 Fed. 601, 60 C. C. A. 337]; Diamond Drill, etc., Co. v. Kelly, 120 Fed. 295; Moore v. Schaw, 118 Fed. 602; Dowagiac Mfg. Co. v. Minnesota Moline Plow Co., 118 Fed. 136, 55 C. C. A. 86; Consolidated Rubber Tire Co. v. Finley Rubber Tire Co., 116 Fed. 629; Dowagiac Mfg. Co. v. Superior Drill Co., 115 Fed. 886, 53 C. C. A. 36; Nelson v. A. D. Farmer, etc., Type-Founding Co., 95 Fed. 145, 37 C. C. A. 32; American Graphophone Co. v. Leeds, 87 Fed. 873; Deere v. Rock Island Plow Co., 84 Fed. 171, 28 C. C. A. 308; Muller v. Lodge, etc., Mach. Tool Co., 77 Fed. 621, 23 C. C. A. 357; Western Wheel-Scraper Co. v. Doinnin, 77 Fed. 194; American Soda-Fountain Co. v. Green, 75 Fed. 680; Taylor v. Sawyer Spindle Co., 75 Fed. 301, 22 C. C. A. 203; Fisher v.



extend the use of an old combination of elements, where no new result is produced and no new method of producing the old result.<sup>12</sup>

**b. Lack of Novelty in Elements Immaterial.** The invention in such case has nothing to do with the novelty or lack of novelty in the separate elements, but resides in the particular way in which the elements have been combined.<sup>13</sup> When a combination is claimed it is said that there is an implied concession that the elements are separately old.<sup>14</sup>

**c. Coaction of Elements Necessary.** It is not necessary that each element should perform its own function and also modify the function performed by every other,<sup>15</sup> but there must be such coaction and modification that a result is

American Pneumatic Tool Co., 71 Fed. 523, 18 C. C. A. 235 [affirming 69 Fed. 331]; U. S. Printing Co. v. American Playing-Card Co., 70 Fed. 50; Johnson v. Forty Second St., etc., R. Co., 33 Fed. 499; Niles Tool Co. v. Betts Mach. Co., 27 Fed. 301; McKesson v. Carnrick, 9 Fed. 44, 19 Blatchf. 158; Brickill v. New York, 7 Fed. 479, 18 Blatchf. 273; McMillan v. Rees, 1 Fed. 722; Ames v. Howard, 1 Fed. Cas. No. 326, 1 Robb Pat. Cas. 689, 1 Sumn. 482; Bailey Washing, etc., Mach. Co. v. Lincoln, 2 Fed. Cas. No. 750, 4 Fish. Pat. Cas. 379; Blake v. Stafford, 3 Fed. Cas. No. 1,504, 6 Blatchf. 195, 3 Fish. Pat. Cas. 294; Gallahue v. Butterfield, 9 Fed. Cas. No. 5,198, 10 Blatchf. 232, 6 Fish. Pat. Cas. 203, 2 Off. Gaz. 645; Herring v. Nelson, 12 Fed. Cas. No. 6,424, 3 Ban. & A. 55, 14 Blatchf. 293, 12 Off. Gaz. 753; Many v. Sizer, 16 Fed. Cas. No. 9,056, 1 Fish. Pat. Cas. 17; Pitts v. Whitman, 19 Fed. Cas. No. 11,196, 2 Robb Pat. Cas. 189, 2 Story 609; Roemer v. Logowitz, 20 Fed. Cas. No. 11,996; Russell, etc., Mfg. Co. v. Mallory, 21 Fed. Cas. No. 12,166, 10 Blatchf. 140, 5 Fish. Pat. Cas. 632, 2 Off. Gaz. 495; Union Sugar Refinery v. Matthieson, 24 Fed. Cas. No. 14,399, 3 Cliff. 639, 2 Fish. Pat. Cas. 600; Woodward v. Dinsmore, 30 Fed. Cas. No. 18,003, 4 Fish. Pat. Cas. 163; Clark v. Adie, 2 App. Cas. 315, 46 L. J. Ch. 585, 36 L. T. Rep. N. S. 923 [affirming 23 Wkly. Rep. 898]; Harrison v. Anderston Foundry Co., 1 App. Cas. 574; Murray v. Clayton, L. R. 7 Ch. 570, 20 Wkly. Rep. 649; Adie v. Clark, 3 Ch. D. 134, 45 L. J. Ch. 228, 35 L. T. Rep. N. S. 349, 24 Wkly. Rep. 1007; Daw v. Eley, L. R. 3 Eq. 496, 36 L. J. Ch. 482, 15 L. T. Rep. N. S. 559; Newton v. Grand Junction R. Co., 5 Exch. 331 note, 20 L. J. Exch. 427 note; Lukie v. Robson, 2 Jur. 201; *In re Martin*, 3 Wkly. Rep. 433; Dansereau v. Bellemare, 16 Can. Sup. Ct. 180; Hunter v. Carrick, 28 Grant Ch. (U. C.) 489 [reversed on other grounds in 10 Ont. App. 449 (affirmed in 11 Can. Sup. Ct. 300)].

Addition of one element to old combination may be patentable. Buck v. Hermance, 4 Fed. Cas. No. 2,082, 1 Blatchf. 398, Fish. Pat. Rep. 251; Frink v. Petry, 9 Fed. Cas. No. 5,128, 1 Ban. & A. 1, 11 Blatchf. 422, 5 Off. Gaz. 201; Hall v. Wiles, 11 Fed. Cas. No. 5,954, 2 Blatchf. 194, Fish. Pat. Rep. 433.

Alarm and time recorder combined is patentable. Municipal Signal Co. v. Gamewell Fire-Alarm Tel. Co., 52 Fed. 459.

Merely putting several articles in one package is not invention. King v. Frostel, 14 Fed. Cas. No. 7,794, 4 Ban. & A. 236, 8 Biss. 510, 16 Off. Gaz. 956, 8 Reporter 490 [affirmed in 109 U. S. 99, 3 S. Ct. 85, 27 L. ed. 870].

12. Voightmann v. Weis, etc., Cornice Co., 148 Fed. 848, 78 C. C. A. 538 [affirming 133 Fed. 298]; Schweicher v. Levinson, 147 Fed. 704, 78 C. C. A. 92.

13. Hobbs v. Beach, 180 U. S. 383, 21 S. Ct. 409, 45 L. ed. 586; Seabury v. Am Ende, 152 U. S. 561, 14 S. Ct. 683, 38 L. ed. 553; Webster Loom Co. v. Higgins, 105 U. S. 580, 26 L. ed. 1177; Hailes v. Van Wormer, 20 Wall. (U. S.) 353, 22 L. ed. 241; Eck v. Kutz, 132 Fed. 758; Lowrie v. H. A. Meldrum Co., 124 Fed. 761 [reversed on other grounds in 130 Fed. 886, 65 C. C. A. 194]; Emerson Electric Mfg. Co. v. Van Nort Bros. Electric Co., 116 Fed. 974; American Tobacco Co. v. Streat, 83 Fed. 700, 28 C. C. A. 18; Buck v. Hermance, 4 Fed. Cas. No. 2,082, 1 Blatchf. 398, Fish. Pat. Rep. 251; Ryan v. Goodwin, 21 Fed. Cas. No. 12,186, 1 Robb Pat. Cas. 725, 3 Sumn. 514; Westlake v. Cartter, 29 Fed. Cas. No. 17,451, 6 Fish. Pat. Cas. 519, 4 Off. Gaz. 636; Woodman v. Stimpson, 30 Fed. Cas. No. 17,979, 3 Fish. Pat. Cas. 98 [reversed on other grounds in 10 Wall. 117, 19 L. ed. 866]; Spencer v. Jack, 3 De G. J. & S. 346, 8 Jur. N. S. 1165, 10 L. T. Rep. N. S. 242, 1 Wkly. Rep. 114, 68 Eng. Ch. 262, 46 Eng. Reprint 669; Lister v. Leather, 8 E. & B. 1004, 4 Jur. N. S. 947, 27 L. J. Q. B. 295, 92 E. C. L. 1004; Bovill v. Moore, 2 Marsh. 211, 17 Rev. Rep. 514, 4 E. C. L. 481; Smith v. Goldie, 9 Can. Sup. Ct. 46; Griffin v. Toronto R. Co., 7 Can. Exch. 411; Mitchell v. Nancoek Inspirator Co., 2 Can. Exch. 539; Toronto Tel. Mfg. Co. v. Bell Tel. Co., 2 Can. Exch. 495; Yates v. Great Western R. Co., 24 Grant Ch. (U. C.) 495; Patric v. Sylvester, 23 Grant Ch. (U. C.) 573; Emery v. Iredale, 11 U. C. C. P. 106. And see *supra*, III, C, 4, i.

14. Hay v. S. F. Heath Cycle Co., 71 Fed. 411, 18 C. C. A. 157.

15. Hailes v. Van Wormer, 20 Wall. (U. S.) 353, 22 L. ed. 241; Dayton Malleable Iron Co. v. Forster, 153 Fed. 201; Sanders v. Hancock, 128 Fed. 424, 63 C. C. A. 166; American St. Car Advertising Co. v. Newton St. R. Co., 82 Fed. 732; National Cash-Register Co. v. American Cash-Register Co., 53 Fed. 367, 3 C. C. A. 559; Wood v. Packer, 17 Fed. 650; Strobridge v. Landers, 11 Fed. 880, 20 Blatchf. 73; Fitch v. Bragg, 8 Fed. 588.



produced which is not merely the sum of the results produced by the separate elements.<sup>16</sup>

**21. AGGREGATION—a. In General.** An aggregation is the mere bringing together of separate elements without changing the function performed by them or producing any result other than the added result of the separate operation of the elements and is not a patentable invention.<sup>17</sup> A combination, to be patent-

16. *Adams v. Bellaire Stamping Co.*, 141 U. S. 539, 12 S. Ct. 66, 35 L. ed. 849; *Beecher Mfg. Co. v. Atwater Mfg. Co.*, 114 U. S. 523, 5 S. Ct. 1007, 29 L. ed. 232; *Voightman v. Perkinson*, 133 Fed. 934 [*affirmed* in 138 Fed. 56, 70 C. C. A. 482]; *Diamond Match Co. v. Ruby Match Co.*, 127 Fed. 341; *J. L. Mott Iron Works v. Hoffman, etc.*, Mfg. Co., 120 Fed. 1019, 56 C. C. A. 151 [*affirming* 110 Fed. 772]; *Goodyear Tire, etc., Co. v. Rubber Tire Wheel Co.*, 116 Fed. 363, 53 C. C. A. 583; *Parsons v. Minneapolis Threshing-Mach. Co.*, 106 Fed. 941; *St. Louis Car-Coupler Co. v. National Malleable Castings Co.*, 87 Fed. 885, 31 C. C. A. 265; *Deere v. Rock Island Plow Co.*, 84 Fed. 171, 28 C. C. A. 308; *Beach v. Hobbs*, 82 Fed. 916; *American Soda-Fountain Co. v. Green*, 75 Fed. 680; *Bowers v. Von Schmidt*, 63 Fed. 572; *Westinghouse v. New York Air-Brake Co.*, 59 Fed. 581; *Brickill v. Hartford*, 49 Fed. 372; *Railway Register Mfg. Co. v. North Hudson Co. R. Co.*, 24 Fed. 793; *Peard v. Johnson*, 23 Fed. 507; *Stutz v. Armstrong*, 20 Fed. 843; *Clark Pomace-Holder Co. v. Ferguson*, 17 Fed. 79, 21 Blatchf. 376; *Western Electric Mfg. Co. v. Chicago Electric Mfg. Co.*, 14 Fed. 691, 11 Biss. 427; *Hoe v. Cottrell*, 1 Fed. 597, 17 Blatchf. 546; *Gallahue v. Butterfield*, 9 Fed. Cas. No. 5,198, 10 Blatchf. 232, 6 Fish. Pat. Cas. 203, 2 Off. Gaz. 645; *Swift v. Whisen*, 23 Fed. Cas. No. 13,700, 2 Bond 115, 3 Fish. Pat. Cas. 343.

**Simultaneous operation of elements is not necessary.** *Hoffman v. Young*, 2 Fed. 74; *Birdsall v. McDonald*, 3 Fed. Cas. No. 1,434, 1 Ban. & A. 165, 6 Off. Gaz. 682; *Forbush v. Cook*, 9 Fed. Cas. No. 4,931, 2 Fish. Pat. Cas. 668.

17. *In re Seabury*, 23 App. Cas. (D. C.) 377; *In re Davenport*, 23 App. Cas. (D. C.) 370; *In re Griswold*, 9 App. Cas. (D. C.) 496; *Richards v. Chase Elevator Co.*, 159 U. S. 477, 16 S. Ct. 53, 40 L. ed. 225; *Richards v. Chase Elevator Co.*, 158 U. S. 299, 15 S. Ct. 831, 39 L. ed. 991; *Palmer v. Corning*, 156 U. S. 342, 15 S. Ct. 381, 39 L. ed. 445; *Wright v. Yuengling*, 155 U. S. 47, 15 S. Ct. 1, 39 L. ed. 64; *Giles v. Heysinger*, 150 U. S. 627, 14 S. Ct. 211, 37 L. ed. 1204; *Ide v. Ball Engine Co.*, 149 U. S. 550, 13 S. Ct. 941, 37 L. ed. 843; *Brinkerhoff v. Aloe*, 146 U. S. 515, 13 S. Ct. 221, 36 L. ed. 1068; *Derby v. Thompson*, 146 U. S. 476, 13 S. Ct. 181, 36 L. ed. 1051; *Patent Clothing Co. v. Glover*, 141 U. S. 560, 12 S. Ct. 79, 35 L. ed. 858; *Adams v. Bellaire Stamping Co.*, 141 U. S. 539, 12 S. Ct. 66, 35 L. ed. 849; *Cluett v. Clafflin*, 140 U. S. 180, 11 S. Ct. 725, 35 L. ed. 385; *Union Edge-Setter Co. v. Keith*, 139 U. S. 530, 11 S. Ct. 621, 35 L. ed. 261; *Busell Trimmer Co. v. Stevens*, 137 U. S.

423, 11 S. Ct. 150, 34 L. ed. 719; *Fond du Lac County v. May*, 137 U. S. 395, 11 S. Ct. 98, 34 L. ed. 714; *Burt v. Ivory*, 133 U. S. 349, 10 S. Ct. 394, 33 L. ed. 647; *Hendy v. Golden State, etc., Iron Works*, 127 U. S. 370, 8 S. Ct. 1275, 32 L. ed. 207; *Thatcher Heating Co. v. Burtis*, 121 U. S. 286, 7 S. Ct. 1034, 30 L. ed. 942; *Beecher Mfg. Co. v. Atwater Mfg. Co.*, 114 U. S. 523, 5 S. Ct. 1007, 29 L. ed. 232; *Bussey v. Excelsior Mfg. Co.*, 110 U. S. 131, 4 S. Ct. 38, 28 L. ed. 95; *Pickering v. McCullough*, 104 U. S. 310, 26 L. ed. 749; *Rubber-Coated Harness Trimming Co. v. Welling*, 97 U. S. 7, 24 L. ed. 942; *Reckendorfer v. Faber*, 92 U. S. 347, 23 L. ed. 719; *Hailes v. Van Wormer*, 20 Wall. (U. S.) 353, 22 L. ed. 241; *Cameron Septic Tank Co. v. Saratoga Springs*, 151 Fed. 242 [*reversed* on other grounds in 159 Fed. 453]; *Rich v. Baldwin*, 133 Fed. 920, 66 C. C. A. 464; *West Coast Safety Faucet Co. v. Jackson Brewing Co.*, 117 Fed. 295, 54 C. C. A. 533; *Wellman v. Midland Steel Co.*, 106 Fed. 221; *Gast v. New York Asbestos Mfg. Co.*, 105 Fed. 68; *Campbell Printing-Press, etc., Co. v. Duplex Printing-Press Co.*, 101 Fed. 282, 41 C. C. A. 351; *Smith v. Maxwell*, 93 Fed. 466; *Clisby v. Reese*, 88 Fed. 645, 32 C. C. A. 80; *Osgood Dredge Co. v. Metropolitan Dredging Co.*, 75 Fed. 670, 21 C. C. A. 491; *Office Specialty Mfg. Co. v. Globe Co.*, 65 Fed. 599 [*affirmed* in 77 Fed. 465, 23 C. C. A. 242]; *Deere v. J. I. Case Plow Works*, 56 Fed. 841, 6 C. C. A. 157; *Mott Iron Works Co. v. Standard Mfg. Co.*, 53 Fed. 819, 4 C. C. A. 28; *Campbell v. Bailey*, 45 Fed. 564 [*affirmed* in 63 Fed. 463, 11 C. C. A. 284]; *National Progress Bunching Mach. Co. v. John R. Williams Co.*, 44 Fed. 190, 12 L. R. A. 107; *Young v. Jackson*, 43 Fed. 387; *Rapid Service Store R. Co. v. Taylor*, 43 Fed. 249; *Richards v. Michigan Cent. R. Co.*, 40 Fed. 165; *Jones v. Clow*, 39 Fed. 785; *Schmid v. Scovill Mfg. Co.*, 37 Fed. 345; *Tower v. Bemis, etc., Hardware, etc., Co.*, 19 Fed. 498; *Doubleday v. Roess*, 11 Fed. 737; *Moffitt v. Rogers*, 8 Fed. 147 [*affirmed* in 106 U. S. 423, 1 S. Ct. 70, 27 L. ed. 76]; *Double-Pointed Tack Co. v. Two Rivers Mfg. Co.*, 3 Fed. 26, 9 Biss. 258; *Sarven v. Hall*, 21 Fed. Cas. No. 12,369, 9 Blatchf. 524, 5 Fish. Pat. Cas. 415, 1 Off. Gaz. 437; *Griswold v. Seymour*, 78 Off. Gaz. 482.

**Placing oil tank and other receptacles on one car not invention.** *Standard Oil Co. v. Southern Pac. Co.*, 54 Fed. 521, 4 C. C. A. 491 [*affirming* 48 Fed. 109].

**Window in stove flue is mere aggregation.** *Perry v. Co-operative Foundry Co.*, 12 Fed. 436, 20 Blatchf. 498.

**Placing rubber on end of lead pencil is aggregation not invention.** *Reckendorfer v.*



able, must produce a different force, effect, or result in the combined forces or processes from that given by their separate parts.<sup>18</sup> No one, by bringing together several old devices without producing a new and useful result, the joint product of the elements of the combination, and something more than an aggregate of old results, can acquire a right to prevent others from using the same devices, either singly or in other combinations, or, even if a new and useful result is obtained, can prevent others from using some of the devices, omitting others, in combination.<sup>19</sup> Superiority does not make aggregation patentable.<sup>20</sup>

**b. Multiplication of Elements.** The multiplication of elements may go on indefinitely without producing a patentable invention,<sup>21</sup> since no exercise of the inventive faculty is involved in merely collecting at one place or in one machine a lot of elements which do not so modify the actions of each other as to produce a new result.<sup>22</sup>

**c. Novel Elements.** Novelty in one or more of the separate elements does not justify a claim to the collection of those elements unless there is coaction between them producing a new result.<sup>23</sup> The novel element in such case may be patentable if claimed separately.<sup>24</sup>

**22. EVIDENCE OF INVENTION — a. Unsuccessful Efforts of Others.** Proof that others skilled in the art had previously sought to accomplish the results of the patented device and that their efforts and experiments were unsuccessful may be and ordinarily is evidence that invention and not mere judgment and skill was required in conceiving and producing it.<sup>25</sup> It has been held, however, that the

Faber, 92 U. S. 347, 23 L. ed. 719; Rubber Tip Pencil Co. v. Howard, 20 Fed. Cas. No. 12,102, 9 Blatchf. 490, 5 Fish. Pat. Cas. 377, 1 Off. Gaz. 407 [affirmed in 20 Wall. 498, 22 L. ed. 410].

Fire lighter attached to kindling wood is not invention. *Alcott v. Young*, 1 Fed. Cas. No. 149, 4 Ban. & A. 197, 16 Blatchf. 134, 7 Reporter 552, 16 Off. Gaz. 403.

Aggregation of door and striker plate.—*In re Forg*, 2 App. Cas. (D. C.) 58.

Aggregation of staple and washer see Double-Pointed Tack Co. v. Two Rivers Mfg. Co., 109 U. S. 117, 3 S. Ct. 105, 27 L. ed. 877.

18. *Reckendorfer v. Faber*, 92 U. S. 347, 23 L. ed. 719.

19. *Hailes v. Van Wormer*, 20 Wall. (U. S.) 353, 22 L. ed. 241.

20. Office Specialty Mfg. Co. v. Fenton Metallic Mfg. Co., 174 U. S. 492, 19 S. Ct. 641, 43 L. ed. 1058; Goodyear Tire, etc., Co. v. Rubber Tire Wheel Co., 116 Fed. 363, 53 C. C. A. 583. Aggregation applies to article as well as machine. *Antisdel v. Chicago Hotel Cabinet Co.*, 89 Fed. 308, 32 C. C. A. 216. Aggregation applies to designs. *Northrup v. Adams*, 18 Fed. Cas. No. 10,328, 2 Ban. & A. 567, 12 Off. Gaz. 430.

21. *Richards v. Chase Elevator Co.*, 158 U. S. 299, 15 S. Ct. 831, 39 L. ed. 991, 159 U. S. 477, 16 S. Ct. 53, 40 L. ed. 225.

22. *Florsheim v. Schilling*, 137 U. S. 64, 11 S. Ct. 20, 34 L. ed. 574; *Overweight Counterbalance Elevator Co. v. Henry Vogt Mach. Co.*, 102 Fed. 957, 43 C. C. A. 80; *Interior Lumber Co. v. Perkins*, 80 Fed. 528, 25 C. C. A. 613; *Campbell v. H. T. Conde Implement Co.*, 74 Fed. 745; *Sugar Apparatus Mfg. Co. v. Yaryan Mfg. Co.*, 43 Fed. 140; *Buck v. Hermance*, 4 Fed. Cas. No. 2,082, 1 Blatchf. 398, 1 Fish. Pat. Rep. 251.

23. *In re McNeill*, 20 App. Cas. (D. C.) 294; *Batten v. Clayton*, 2 Fed. Cas. No. 1,105.

Claim to combination is an implied concession that the elements are separately old. *Overweight Counterbalance Elevator Co. v. Improved Order of Red Men's Hall Assoc.*, 94 Fed. 155, 36 C. C. A. 125; *Hay v. S. F. Heath Cycle Co.*, 71 Fed. 411, 18 C. C. A. 157.

24. Claim to combination protects all new parts. *Parkes v. Stevens*, L. R. 5 Ch. 36, 22 L. T. Rep. N. S. 635, 18 Wkly. Rep. 233 [affirmed in L. R. 8 Eq. 353, 38 L. J. Ch. 627, 17 Wkly. Rep. 846].

25. *Gandy v. Main Belting Co.*, 143 U. S. 587, 12 S. Ct. 598, 36 L. ed. 272; *American Graphophone Co. v. Universal Talking Mach. Mfg. Co.*, 151 Fed. 595, 81 C. C. A. 139 [reversing 145 Fed. 636, 643]; *Albright v. Langfeld*, 131 Fed. 473; *Electric Smelting, etc., Co. v. Pittsburgh Reduction Co.*, 125 Fed. 926, 60 C. C. A. 636; *George Frost Co. v. Cohn*, 119 Fed. 505, 56 C. C. A. 185; *Hanifen v. Armitage*, 117 Fed. 845; *Star Brass Works v. General Electric Co.*, 111 Fed. 398, 49 C. C. A. 409; *Tannage Patent Co. v. Donallan*, 93 Fed. 811; *Thomson-Houston Electric Co. v. Winchester Ave. R. Co.*, 71 Fed. 192; *Binns v. Zucker, etc., Chemical Co.*, 70 Fed. 711; *Westinghouse v. New York Air-Brake Co.*, 59 Fed. 581 [modified in 63 Fed. 962, 11 C. C. A. 528]; *Columbia Chemical Works v. Rutherford*, 58 Fed. 787; *Consolidated Brake-Shoe Co. v. Detroit Steel, etc., Co.*, 47 Fed. 874; *Niles Tool-Works v. Betts Mach. Co.*, 27 Fed. 301; *Ward v. Grand Detour Plow Co.*, 14 Fed. 696; *Pearl v. Ocean Mills*, 19 Fed. Cas. No. 10,876, 2 Ban. & A. 469, 11 Off. Gaz. 2; *Terry Clock Co. v. New Haven Clock Co.*, 23 Fed. Cas. No. 13,840, 4 Ban.



scope of mechanical skill not being restricted to the skill of any particular mechanic, it is not conclusive that more than mechanical skill was involved in producing a particular device, that, prior to the application for the patent thereon, a device has been produced by another person for the same purpose which was different from and inferior to that of the patent;<sup>26</sup> and simultaneous suggestion by many is evidence that invention is lacking.<sup>27</sup>

**b. Supplying Long-Felt Want.** A long-felt want and unsupplied need for means accomplishing the results of the patented device is evidence tending to show that its production called for an exercise of the inventive faculties.<sup>28</sup>

**c. Popularity of the Supposed Invention.** The fact that the patented device meets with immediate public favor and displaces others for the same purpose on the market is evidence of utility and some evidence of invention,<sup>29</sup> but will not be

& A. 121, 17 Off. Gaz. 909. *Compare* Butler v. Steckel, 27 Fed. 219.

**Conception of new method involving different principle.**—Where an existing process or device discloses what appear to be insuperable objections to practical operations, it is persuasive evidence of invention that an improver has the foresight and courage to break away from such disclosure and conceive of some new method involving a different principle. *American Graphophone Co. v. Universal Talking Mach. Mfg. Co.*, 151 Fed. 595, 81 C. C. A. 139 [*reversing* 145 Fed. 636, 643].

26. *Johnson Co. v. Pennsylvania Steel Co.*, 67 Fed. 940 [*affirmed* in 70 Fed. 244, 17 C. C. A. 88].

27. *Thomson-Houston Electric Co. v. Lorain Steel Co.*, 117 Fed. 249, 54 C. C. A. 281; *Haslem v. Pittsburg Plate-Glass Co.*, 68 Fed. 479; *Bromley Bros. Carpet Co. v. Stewart*, 51 Fed. 912.

28. *Matter of Pennock*, 1 MacArthur (D. C.) 531; *Seabury v. Am Ende*, 152 U. S. 561, 14 S. Ct. 683, 38 L. ed. 553; *Keystone Mfg. Co. v. Adams*, 151 U. S. 139, 14 S. Ct. 295, 38 L. ed. 103 [*reversing* 35 Fed. 579]; *Brill v. North Jersey St. R. Co.*, 124 Fed. 778 [*reversed* on other grounds in 134 Fed. 580, 67 C. C. A. 380]; *Hale, etc., Mfg. Co. v. Oneonta, etc., R. Co.*, 124 Fed. 514; *Peters v. Union Biscuit Co.*, 120 Fed. 679 [*reversed* on other grounds in 125 Fed. 601, 60 C. C. A. 337]; *Hallock v. Davison*, 107 Fed. 482; *Celluloid Co. v. Arlington Mfg. Co.*, 85 Fed. 449; *Steel-Clad Bath Co. v. Davison*, 77 Fed. 736; *Taylor v. Sawyer Spindle Co.*, 75 Fed. 301, 22 C. C. A. 203 [*affirming* 69 Fed. 837]; *Taylor Burner Co. v. Diamond*, 72 Fed. 182; *Horn v. Bergner*, 68 Fed. 428 [*affirmed* in 72 Fed. 687]; *Consolidated Brake-Shoe Co. v. Detroit Steel, etc., Co.*, 59 Fed. 902; *Watson v. Stevens*, 51 Fed. 757, 2 C. C. A. 500 [*reversing* 47 Fed. 117]; *Electrical Accumulator Co. v. New York, etc., R. Co.*, 50 Fed. 81; *Guarantee Trust, etc., Co. v. New Haven Gas-Light Co.*, 39 Fed. 268; *Asmus v. Alden*, 27 Fed. 684 [*reversed* on other grounds in 145 U. S. 226, 12 S. Ct. 939, 36 L. ed. 685].

**Increasing work performed by machine** one fourth shows invention. *Webster Loom Co. v. Higgins*, 105 U. S. 580, 26 L. ed. 1177.

**Superiority indicates invention.** *Sawyer*

*Spindle Co. v. Taylor*, 69 Fed. 837 [*affirmed* in 75 Fed. 301, 22 C. C. A. 203]; *Ex p. Arthur*, 1 Fed. Cas. No. 563a; *Judson v. Cope*, 14 Fed. Cas. No. 7,565, 1 Bond 327, 1 Fish. Pat. Cas. 615; *Many v. Sizer*, 16 Fed. Cas. No. 9,056, 1 Fish. Pat. Cas. 17; *Seymour v. Marsh*, 21 Fed. Cas. No. 12,687, 6 Fish. Pat. Cas. 115, 2 Off. Gaz. 675, 9 Phila. (Pa.) 380.

29. *Fenton Metallic Mfg. Co. v. Office Specialty Mfg. Co.*, 12 App. Cas. (D. C.) 201; *Olin v. Timken*, 155 U. S. 141, 15 S. Ct. 49, 39 L. ed. 100; *Seabury v. Am Ende*, 152 U. S. 561, 14 S. Ct. 683, 38 L. ed. 553; *Keystone Mfg. Co. v. Adams*, 151 U. S. 139, 14 S. Ct. 295, 38 L. ed. 103; *Duer v. Corbin Cabinet Lock Co.*, 149 U. S. 216, 13 S. Ct. 850, 37 L. ed. 707; *Kremetz v. S. Cottle Co.*, 148 U. S. 556, 13 S. Ct. 719, 37 L. ed. 558; *Grant v. Walter*, 148 U. S. 547, 13 S. Ct. 699, 37 L. ed. 552; *Gandy v. Main Belting Co.*, 143 U. S. 587, 12 S. Ct. 598, 36 L. ed. 272; *McCreary v. Pennsylvania Canal Co.*, 141 U. S. 459, 12 S. Ct. 40, 35 L. ed. 817; *McClain v. Ortmayer*, 141 U. S. 419, 12 S. Ct. 76, 35 L. ed. 800; *Magowan v. New York Belting, etc., Co.*, 141 U. S. 332, 12 S. Ct. 71, 35 L. ed. 781; *Goodyear Tire, etc., Co. v. Rubber Tire Wheel Co.*, 116 Fed. 363, 53 C. C. A. 583; *Kinloch Tel. Co. v. Western Electric Co.*, 113 Fed. 659, 51 C. C. A. 369; *Kalamazoo R. Supply Co. v. Duff Mfg. Co.*, 113 Fed. 264, 51 C. C. A. 221; *National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co.*, 106 Fed. 693, 45 C. C. A. 544; *Christy v. Hygeia Pneumatic Bicycle Saddle Co.*, 93 Fed. 965, 36 C. C. A. 31; *Stevenson Co. v. McFassell*, 90 Fed. 707, 33 C. C. A. 249; *Morrin v. Lawler*, 90 Fed. 285; *Wilkins Shoe-Button Fastener Co. v. Webb*, 89 Fed. 982; *Allington, etc., Mfg. Co. v. Globe Co.*, 89 Fed. 865; *Consolidated Car Heating Co. v. American Electric Heating Corp.*, 82 Fed. 993; *Taylor v. Sawyer Spindle Co.*, 75 Fed. 301, 22 C. C. A. 203 [*affirming* 69 Fed. 837]; *Dueber Watch-Case Mfg. Co. v. Robbins*, 75 Fed. 17, 21 C. C. A. 198; *Brownson v. Dodson-Fisher-Brockmann Co.*, 71 Fed. 517; *National Co. v. Belcher*, 68 Fed. 665; *Holmes v. Truman*, 67 Fed. 542, 14 C. C. A. 517; *Miller v. Handley*, 61 Fed. 100; *Saunders v. Allen*, 60 Fed. 610, 9 C. C. A. 157; *Lalancé, etc., Mfg. Co. v. Habermann Mfg. Co.*, 53 Fed. 375; *Featherstone v. George R. Bidwell Cycle*



accepted as proof except in cases of doubt.<sup>30</sup> This is because the popularity may be due to extensive advertising or other things than its superiority.<sup>31</sup>

**F. Statutory Forfeiture Regardless of Intent**—1. **IN GENERAL.** Since the purpose of the patent system is to secure for the public of this country a knowledge of and the right to use new inventions and discoveries the inventor is required to proceed diligently in securing his patent under penalty of a forfeiture of his inchoate right.<sup>32</sup> There are provisions in the statutes by which this forfeiture may occur contrary to the inventor's intent and without his knowledge.<sup>33</sup>

2. **PUBLICATION TWO YEARS BEFORE APPLICATION.** If the invention is described in a patent or printed publication in this country or abroad, with or without the knowledge or consent of the inventor, more than two years before his application for patent is filed, no valid patent can issue.<sup>34</sup>

Co., 53 Fed. 113; *Fox v. Perkins*, 52 Fed. 205, 3 C. C. A. 32; *Watson v. Stevens*, 51 Fed. 757, 2 C. C. A. 500; *Electrical Accumulator Co. v. New York, etc., R. Co.*, 50 Fed. 81; *Stearns v. Phillips*, 43 Fed. 792; *Chicopee Folding-Box Co. v. Nugent*, 41 Fed. 139 [affirmed in 51 Fed. 229, 2 C. C. A. 165]; *Parker v. Dickinson*, 38 Fed. 413; *Palmer v. Johnston*, 34 Fed. 336; *Good v. Bailey*, 33 Fed. 42; *Hill v. Biddle*, 27 Fed. 560; *Miller v. Pickering*, 16 Fed. 540; *Western Electric Mfg. Co. v. Chicago Electric Mfg. Co.*, 14 Fed. 691, 11 Biss. 427; *Gottfried v. Crescent Brewing Co.*, 13 Fed. 479; *Lindsay v. Stein*, 10 Fed. 907, 20 Blatchf. 370; *Shedd v. Washburn*, 9 Fed. 904; *Washburn, etc., Mfg. Co. v. Haish*, 4 Fed. 900, 10 Biss. 65; *Strobridge v. Lindsay*, 2 Fed. 692; *Adams v. Edwards*, 1 Fed. Cas. No. 53, 1 Fish. Pat. Cas. 1; *Birdsall v. McDonald*, 3 Fed. Cas. No. 1,434, 1 Ban. & A. 165, 6 Off. Gaz. 682; *Eames v. Cook*, 8 Fed. Cas. No. 4,239, 2 Fish. Pat. Cas. 146; *Judson v. Moore*, 14 Fed. Cas. No. 7,569, 1 Bond 285, 1 Fish. Pat. Cas. 544; *Lorillard v. McDowell*, 15 Fed. Cas. No. 8,510, 2 Ban. & A. 531, 11 Off. Gaz. 640, 13 Phila. (Pa.) 461; *Schaum v. Baker*, 21 Fed. Cas. No. 12,440; *Stanley Works v. Sargent*, 22 Fed. Cas. No. 13,289, 8 Blatchf. 344, 4 Fish. Pat. Cas. 443.

Where the patent is void, extensive use is immaterial. *Duer v. Corbin Cabinet Lock Co.*, 149 U. S. 216, 13 S. Ct. 850, 37 L. ed. 707 [affirming 37 Fed. 338].

No extent of use can cure the want of invention or make aggregation patentable. *Voightmann v. Weis, etc., Cornice Co.*, 133 Fed. 298 [affirmed in 148 Fed. 848, 78 C. C. A. 538].

30. *In re Smith*, 14 App. Cas. (D. C.) 181; *Durham v. Seymour*, 6 App. Cas. (D. C.) 78; *Adams v. Bellaire Stamping Co.*, 141 U. S. 539, 12 S. Ct. 66, 35 L. ed. 849; *McClain v. Ortmyer*, 141 U. S. 419, 12 S. Ct. 76, 35 L. ed. 800; *Voightmann v. Weis, etc., Cornice Co.*, 148 Fed. 848, 78 C. C. A. 538 [affirming 133 Fed. 298]; *General Electric Co. v. Yost Electric Mfg. Co.*, 131 Fed. 874; *American Salesbook Co. v. Carter-Crume Co.*, 125 Fed. 499 [reversed on other grounds in 129 Fed. 1004, 62 C. C. A. 679]; *American Sales Book Co. v. Bullivant*, 117 Fed. 255, 54 C. C. A. 287; *Standard Caster, etc., Co. v. Caster Socket Co.*, 113 Fed. 162, 51 C. C. A.

109; *Goss Printing-Press Co. v. Scott*, 103 Fed. 650 [reversed on other grounds in 108 Fed. 253, 47 C. C. A. 302]; *National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co.*, 99 Fed. 758; *Lane v. Welds*, 99 Fed. 286, 39 C. C. A. 528; *Ingraham Co. v. E. N. Welch Mfg. Co.*, 92 Fed. 1019, 35 C. C. A. 163; *Rubber Tire Wheel Co. v. Columbia Pneumatic Wagon Wheel Co.*, 91 Fed. 978; *McEwan Bros. Co. v. McEwan*, 91 Fed. 787; *Perry v. Revere Rubber Co.*, 86 Fed. 633; *Michigan Stove Co. v. Fuller-Warren Co.*, 81 Fed. 376; *Schwarzwaelder v. Detroit*, 77 Fed. 886; *Klein v. Seattle*, 77 Fed. 200, 23 C. C. A. 114 [affirming 63 Fed. 702]; *Consolidated Electric Mfg. Co. v. Holtzer*, 67 Fed. 907, 15 C. C. A. 63; *Saunders v. Allen*, 60 Fed. 610, 9 C. C. A. 157; *Washburn, etc., Mfg. Co. v. Grinnell Wire Co.*, 24 Fed. 23; *Wilson Packing Co. v. Chicago Packing, etc., Co.*, 9 Fed. 547, 10 Biss. 559; *Dion v. Dupuis*, 12 Quebec Super. Ct. 465.

That success is important only in case of doubt see *Falk Mfg. Co. v. Missouri R. Co.*, 103 Fed. 295, 43 C. C. A. 240.

31. *Gardner v. Herz*, 118 U. S. 180, 6 S. Ct. 1027, 30 L. ed. 158; *Doig v. Morgan Mach. Co.*, 122 Fed. 460, 59 C. C. A. 616; *Dowagiac v. Superior Drill Co.*, 115 Fed. 886, 53 C. C. A. 36; *Dueber Watch Case Co. v. Robbins*, 75 Fed. 17, 21 C. C. A. 198 [reversing 71 Fed. 186]; *Stahl v. Williams*, 64 Fed. 121; *Fox v. Perkins*, 52 Fed. 205, 3 C. C. A. 32; *Peoria Target Co. v. Cleveland Target Co.*, 47 Fed. 725. And see *Ypsilanti Dress-Stay Mfg. Co. v. Van Valkenburg*, 72 Fed. 277 [affirmed in 78 Fed. 926, 24 C. C. A. 416], in which it was said that popularity may be due to workmanship, attractive display, or advertising.

32. *In re Mower*, 15 App. Cas. (D. C.) 144; *Mason v. Hepburn*, 13 App. Cas. (D. C.) 86; *Kendall v. Winsor*, 21 How. (U. S.) 322, 16 L. ed. 165; *Eck v. Kutz*, 132 Fed. 758; *Campbell Printing-Press, etc., Co. v. Duplex Printing-Press Co.*, 86 Fed. 315; *Von Schmidt v. Bowers*, 80 Fed. 121, 25 C. C. A. 323; *Matthes v. Burt*, 114 Off. Gaz. 764.

33. U. S. Rev. St. (1878) § 4886; *Blandy v. Griffith*, 3 Fed. Cas. No. 1,529, 3 Fish. Pat. Cas. 609.

34. U. S. Rev. St. (1873) §§ 4886, 4920 [U. S. Comp. St. (1901) pp. 3382, 3394], as amended by Act, March 3, 1897.



**3. FOREIGN PATENT.** If the inventor first secures or allows his representatives to secure a patent upon the invention abroad on an application filed more than twelve months before his application in this country no valid patent can issue here.<sup>35</sup> The limitation is four months in case of design patents.<sup>36</sup>

**4. CONCEALMENT OF INVENTION.** If the inventor conceals the invention from the public for a long period of time after he has perfected it, and in the mean time some other party makes the invention, the invention becomes public property and cannot be patented by any one,<sup>37</sup> or is to be patented to the one who was really second to invent, but first to give to the public.<sup>38</sup>

**5. DATE OF APPLICATION.** The date of application controlling in considering public use or sale and publication is the date of application in this country,<sup>39</sup> or the date of application abroad within twelve months of the application here, provided the foreign country is a member of the international convention or has similar treaty relations with this country.<sup>40</sup>

**6. RENEWAL OR SUBSTITUTE APPLICATION.** Where an application here is forfeited and renewed,<sup>41</sup> or is filed as a substitute for and continuation of a prior application,<sup>42</sup> the original filing date controls; but to obtain the benefit of the original

35. U. S. Rev. St. (1878) § 4887 [U. S. Comp. St. (1901) p. 3382], as amended March 3, 1903. Under the act of March 3, 1897, the limitation was seven months and that applies to applications filed between Jan. 1, 1898, and the passage of the act of 1903. *In re Swinburne*, 19 App. Cas. (D. C.) 565.

**Application of statute.**—The act applies only to patents granted after Jan. 1, 1898. *Rubber Tire Wheel Co. v. Davie*, 100 Fed. 85; *Patric v. Sylvester*, 23 Grant Ch. (U. C.) 573.

36. U. S. Rev. St. (1878) § 4887 [U. S. Comp. St. (1901) p. 3382], as amended March 3, 1903.

37. *In re Mower*, 15 App. Cas. (D. C.) 144; *Bates v. Coe*, 98 U. S. 31, 25 L. ed. 68; *Consolidated Fruit Jar Co. v. Wright*, 94 U. S. 92, 24 L. ed. 68; *Kindall v. Winsor*, 21 How. (U. S.) 322, 16 L. ed. 165; *Ransom v. New York*, 20 Fed. Cas. No. 11,573, 1 Fish. Pat. Cas. 252. The inventor may forfeit his rights as an inventor by a wilful or negligent postponement of his claims, or by an attempt to withhold the benefit of his improvement from the public until a similar or the same improvement shall have been made and introduced by others. *Kendall v. Winsor*, 21 How. (U. S.) 322, 16 L. ed. 165.

Where due to poverty, concealment and failure to apply for patent is not a bar. *Celluloid Mfg. Co. v. Crofut*, 24 Fed. 796; *Ayling v. Hull*, 2 Fed. Cas. No. 686, 2 Cliff. 494; *Sprague v. Adrianne*, 22 Fed. Cas. No. 13,248, 3 Ban. & A. 124, 14 Off. Gaz. 308.

38. *Brown v. Blood*, 22 App. Cas. (D. C.) 216; *Thomson v. Weston*, 19 App. Cas. (D. C.) 373; *Warner v. Smith*, 13 App. Cas. (D. C.) 111; *Mason v. Hepburn*, 13 App. Cas. (D. C.) 86; *Berg v. Thistle*, 3 Fed. Cas. No. 1,337; *Bullock Printing-Press Co. v. Jones*, 4 Fed. Cas. No. 2,132, 3 Ban. & A. 195, 13 Off. Gaz. 124; *Consolidated Fruit-Jar Co. v. Wright*, 6 Fed. Cas. No. 3,135, 12 Blatchf. 149, 1 Ban. & A. 320, 6 Off. Gaz. 327; *Marcy v. Trotter*, 16 Fed. Cas. No. 9,063; *Snowden v. Pierce*, 22 Fed. Cas. No.

13,151, 2 Hayw. & H. 386; *Spear v. Belson*, 22 Fed. Cas. No. 13,223, *McArthur Pat. Cas.* 699; *U. S. Rifle, etc., Co. v. Whitney Arms Co.*, 28 Fed. Cas. No. 16,793, 2 Ban. & A. 493, 14 Blatchf. 94, 11 Off. Gaz. 373; *Walker v. Forbes*, 29 Fed. Cas. No. 17,069; *Matthes v. Burt*, 114 Off. Gaz. 764.

39. Date of filing in patent office and not date of execution controls. *Campbell v. New York*, 35 Fed. 504, 1 L. R. A. 48.

The English application dates from provisional specification. *In re Swinburn*, 19 App. Cas. (D. C.) 565.

40. U. S. Rev. St. (1878) § 4887 [U. S. Comp. St. (1901) p. 3382], as amended March 3, 1903.

41. U. S. Rev. St. (1878) § 4897 [U. S. Comp. St. (1901) p. 3386]; *Cain v. Park*, 14 App. Cas. (D. C.) 42; *Ligowski Clay-Pigeon Co. v. American Clay-Bird Co.*, 34 Fed. 328.

The renewed application confers no right in addition to that of the first application.—It confers no right as against a prior inventor who happened to file his application subsequent to that of the second inventor. At most the first application could only acquire an inchoate right as against a prior inventor, dependent upon it being made to appear that the first inventor had either abandoned his invention or lost the right to it by the want of reasonable diligence in perfecting it and making application for a patent. *Christensen v. Noyes*, 90 Off. Gaz. 227.

42. *Godfrey v. Eames*, 1 Wall. (U. S.) 317, 17 L. ed. 684; *Stimpson v. West Chester R. Co.*, 4 How. (U. S.) 380, 11 L. ed. 1020; *L. E. Waterman Co. v. McCutcheon*, 127 Fed. 1020, 61 C. C. A. 653; *L. E. Waterman v. Forsyth*, 121 Fed. 103; *International Tooth-Crown Co. v. Richmond*, 30 Fed. 775; *Graham v. McCormick*, 11 Fed. 859, 10 Biss. 39; *Bell v. Daniels*, 3 Fed. Cas. No. 1,247, 1 Bond 212, 1 Fish. Pat. Cas. 372; *Bevin v. East Hampton Bell Co.*, 3 Fed. Cas. No. 1,379, 9 Blatchf. 50, 5 Fish. Pat. Cas. 23; *Dental Vulcanite Co. v. Wetherbee*, 7 Fed.



date, the renewal must be in accordance with the terms of the law;<sup>43</sup> and where there is unreasonable delay between applications, the date of the second controls.<sup>44</sup>

**7. DIVISIONAL APPLICATIONS.** The principles stated in the preceding section apply in the case of divisional applications.<sup>45</sup>

**8. PRIOR PUBLIC USE OR SALE — a. As Bar to Patent.** By the provisions of the statutes, if the invention was in public use or on sale in this country with or without the consent of the inventor more than two years before his application was filed the grant of a patent is barred.<sup>46</sup> It must, however, have been in public use

Cas. No. 3,810, 2 Cliff. 555, 3 Fish. Pat. Cas. 87; Goodyear Dental Vulcanite Co. v. Root, 10 Fed. Cas. No. 5,597, 1 Ban. & A. 384, 6 Off. Gaz. 154; Goodyear Dental Vulcanite Co. v. Smith, 10 Fed. Cas. No. 5,598, 1 Ban. & A. 201, Holmes 354, 5 Off. Gaz. 585 [affirmed in 93 U. S. 486, 23 L. ed. 952]; Henry v. Francetown Soapstone Stove Co., 11 Fed. Cas. No. 6,382, 2 Ban. & A. 221, 9 Off. Gaz. 408; Howe v. Newton, 12 Fed. Cas. No. 6,771, 2 Fish. Pat. Cas. 531; Johnsen v. Fassman, 13 Fed. Cas. No. 7,365, 5 Fish. Pat. Cas. 471, 1 Woods 138, 2 Off. Gaz. 94; Jones v. Sewall, 13 Fed. Cas. No. 7,495, 3 Cliff. 563, 6 Fish. Pat. Cas. 343, 3 Off. Gaz. 630; Matthews v. Wade, 16 Fed. Cas. No. 9,292, McArthur Pat. Cas. 143; Rich v. Lippincott, 20 Fed. Cas. No. 11,758, 2 Fish. Pat. Cas. 1, 1 Pittsb. (Pa.) 31; Singer v. Braunsdorf, 22 Fed. Cas. No. 12,897, 7 Blatchf. 521; Smith v. Prior, 22 Fed. Cas. No. 13,095, 4 Fish. Pat. Cas. 469, 2 Sawy. 461, 4 Off. Gaz. 633; Weston v. White, 29 Fed. Cas. No. 17,459, 2 Ban. & A. 364, 13 Blatchf. 447.

Withdrawal due to mistake of patent office will not forfeit rights. Hayden v. James, 11 Fed. Cas. No. 6,260.

Application abandoned before another is filed cannot avail the patentee. Carty v. Kellogg, 7 App. Cas. (D. C.) 542; Hayes-Young Tie Plate Co. v. St. Louis Transit Co., 130 Fed. 900; Lindsay v. Stein, 10 Fed. 907, 20 Blatchf. 370; Bevin v. East Hampton Bell Co., 3 Fed. Cas. No. 1,379, 9 Blatchf. 50, 5 Fish. Pat. Cas. 23; Rich v. Lippincott, 20 Fed. Cas. No. 11,758, 2 Fish. Pat. Cas. 1.

For excusable delay in renewing application see Colgate v. Western Union Tel. Co., 6 Fed. Cas. No. 2,995, 4 Ban. & A. 36, 15 Blatchf. 365, 14 Off. Gaz. 943; Goodyear Dental Vulcanite Co. v. Willis, 10 Fed. Cas. No. 5,603, 1 Ban. & A. 568, 1 Flipp. 388, 7 Off. Gaz. 41; Howes v. McNeal, 12 Fed. Cas. No. 6,789, 3 Ban. & A. 376, 15 Blatchf. 103, 15 Off. Gaz. 608.

43. Ostergren v. Tripler, 17 App. Cas. (D. C.) 557; Christensen v. Noyes, 90 Off. Gaz. 223.

44. U. S. Rifle, etc., Co. v. Whitney Arms Co., 118 U. S. 22, 6 S. Ct. 950, 30 L. ed. 53; Consolidated Fruit-Jar Co. v. Bellaire Stamping Co., 27 Fed. 377; Yale Lock Mfg. Co. v. Berkshire Nat. Bank, 26 Fed. 104; Bevin v. East Hampton Bell Co., 3 Fed. Cas. No. 1,379, 9 Blatchf. 50, 5 Fish. Pat. Cas. 23; *Ex p.* Dedericks, 7 Fed. Cas. No. 3,734; *Ex p.* Raymond, 20 Fed. Cas. No. 11,592a; Wickersham v. Singer, 29 Fed. Cas. No. 17,610, McArthur Pat. Cas. 645.

45. Stirling Co. v. St. Louis Brewing Assoc., 79 Fed. 80; Dederick v. Fox, 56 Fed. 714; Frankfort Whisky Process Co. v. Mill Creek Distilling Co., 37 Fed. 533; Graham v. Geneva Lake Crawford Mfg. Co., 11 Fed. 138.

46. U. S. Rev. St. (1878) §§ 4886, 4920; Andrews v. Hovey, 123 U. S. 267, 8 S. Ct. 101, 31 L. ed. 160; Consolidated Fruit Jar Co. v. Wright, 94 U. S. 92, 24 L. ed. 68; Letteller v. Mann, 91 Fed. 917; Hutchinson v. Everett, 26 Fed. 531; Union Paper-Bag Mach. Co. v. Atlas Bag Co., 6 Fed. 398; Arnold v. Bishop, 1 Fed. Cas. No. 552, Cranch Pat. Dec. 103, McArthur Pat. Cas. 27; Blackinton v. Douglass, 3 Fed. Cas. No. 1,470, McArthur Pat. Cas. 622; Cleveland v. Towle, 5 Fed. Cas. No. 2,888, 3 Fish. Pat. Cas. 525; Cowperwaithe v. Gill, 6 Fed. Cas. No. 3,298; Eliithorp v. Robertson, 8 Fed. Cas. No. 4,410, McArthur Pat. Cas. 634; Hunt v. Howe, 12 Fed. Cas. No. 6,891, McArthur Pat. Cas. 366; Justice v. Jones, 13 Fed. Cas. No. 7,588, McArthur Pat. Cas. 635; Kelleher v. Darling, 14 Fed. Cas. No. 7,653, 4 Cliff. 424, 3 Ban. & A. 438, 14 Off. Gaz. 673; Lovering v. Dutcher, 15 Fed. Cas. No. 8,553, 2 Hayw. & H. 367; Manning v. Cape Ann Isinglass, etc., Co., 16 Fed. Cas. No. 9,041, 4 Ban. & A. 612, 9 Reporter 337 [affirmed in 108 U. S. 462, 2 S. Ct. 860, 27 L. ed. 793]; Monce v. Woodworth, 17 Fed. Cas. No. 9,706, 4 Ban. & A. 307, 19 Off. Gaz. 998; Rugg v. Haines, 20 Fed. Cas. No. 12,114, McArthur Pat. Cas. 420; Tappan v. National Bank-Note Co., 24 Fed. Cas. No. 14,100.

The rule is inflexible without regard to excuses for delay. Blandy v. Griffith, 3 Fed. Cas. No. 1,529, 3 Fish. Pat. Cas. 609; Sisson v. Gilbert, 22 Fed. Cas. No. 12,912, 9 Blatchf. 185, 5 Fish. Pat. Cas. 109. *Contra*, see McMillan v. Barclay, 16 Fed. Cas. No. 8,902, 5 Fish. Pat. Cas. 189, 4 Brewst. (Pa.) 275.

The rule applies to designs as well as mechanical inventions. Anderson v. Monroe, 55 Fed. 407; Anderson v. Eiler, 46 Fed. 777 [affirmed in 50 Fed. 775, 1 C. C. A. 659]; Theberath v. Rubber, etc., Harness Trimming Co., 15 Fed. 246; *In re* Tournier, 94 Off. Gaz. 2166.

In England any use by inventor or others in realm before patent is a bar. Househill Coal, etc., Co. v. Neilson, 9 Cl. & F. 788, 8 Eng. Reprint 616. The use must be public. Heath v. Smith, 2 C. L. R. 1584, 3 E. & B. 256, 18 Jur. 601, 23 L. J. Q. B. 166, 2 Wkly. Rep. 200, 77 E. C. L. 256; Caldwell v. Van-



or on sale for more than two years prior to the application to bar the grant of a patent.<sup>47</sup>

**b. Nature of Use Sufficient to Bar Patent**—(i) *IN GENERAL*. The bar of public use arises from use by the inventor himself or by others,<sup>48</sup> but in either case it must be such as makes the invention accessible to some members of the public.<sup>49</sup> Public use, however, does not mean a general adoption or use by the public, but a use in public, as distinguished from a secret use.<sup>50</sup> Exhibition of a design is a public use.<sup>51</sup>

(ii) *SINGLE INSTANCE SUFFICIENT*. A single instance of public use by a single individual will operate as a bar.<sup>52</sup> General and continuous use is unnecessary.<sup>53</sup>

(iii) *KNOWLEDGE OR CONSENT OF THE INVENTOR*. The bar arises whether or not the inventor knows of or consents to the public use.<sup>54</sup>

vlissengen, 9 Hare 415, 16 Jur. 115, 21 L. J. Ch. 97, 41 Eng. Ch. 415, 68 Eng. Reprint 571; Carpenter v. Smith, 11 L. J. Exch. 213, 9 M. & W. 300.

In Canada public use with the inventor's consent before application is a bar. Bonathan v. Bowmanville Furniture Mfg. Co., 31 U. C. Q. B. 413.

47. Agawam Woolen Co. v. Jordan, 7 Wall. (U. S.) 583, 19 L. ed. 177; Babcock v. Degener, 2 Fed. Cas. No. 698, McArthur Pat. Cas. 607; McCormick v. Seymour, 15 Fed. Cas. No. 8,726, 2 Blatchf. 1204 [modified in 16 How. 480, 14 L. ed. 204]; McMillan v. Barclay, 16 Fed. Cas. No. 8,902, 5 Fish. Pat. Cas. 189, 4 Brewst. (Pa.) 275; Melhus v. Silsbee, 16 Fed. Cas. No. 9,404, 4 Mason 108, 1 Robb Pat. Cas. 506; Root v. Ball, 20 Fed. Cas. No. 12,035, 4 McLean 177, 2 Robb Pat. Cas. 513; Sanders v. Logan, 21 Fed. Cas. No. 12,295, 2 Fish. Pat. Cas. 167; Sicles v. Pacific Mail Steamship Co., 22 Fed. Cas. No. 12,842.

48. National Phonograph Co. v. Lambert Co., 125 Fed. 388 [affirmed in 142 Fed. 164, 73 C. C. A. 382]; Thomson-Houston Electric Co. v. Lorain Steel Co., 117 Fed. 249, 54 C. C. A. 281; Pennock v. Dialogue, 19 Fed. Cas. No. 10,941, 1 Robb Pat. Cas. 466, 4 Wash. 538 [affirmed in 2 Pet. 1, 7 L. ed. 327]; Sisson v. Gilbert, 22 Fed. Cas. No. 12,912, 9 Blatchf. 185, 5 Fish. Pat. Cas. 109.

Where the inventor for pay teaches others to use the invention it is public use. International Tooth-Crown Co. v. Gaylord, 140 U. S. 55, 11 S. Ct. 716, 35 L. ed. 347.

In England use bars a patent in Scotland. Brown v. Annandale, 8 Cl. & F. 437, 8 Eng. Reprint 170; In re Robinson, 5 Moore P. C. 65, 13 Eng. Reprint 414. Making without sale after application may not constitute a bar. Betts v. Menzies, 5 Jur. N. S. 1164, 28 L. J. Q. B. 361; Summers v. Abell, 15 Grant Ch. (U. C.) 532.

49. Indiana Novelty Mfg. Co. v. Crocker Chair Co., 90 Fed. 488; American Roll-Paper Co. v. Weston, 59 Fed. 147, 8 C. C. A. 56.

50. Blackinton v. Douglass, 3 Fed. Cas. No. 1,470, McArthur Pat. Cas. 622; Ellithorp v. Robertson, 8 Fed. Cas. No. 4,409, McArthur Pat. Cas. 585; Henry v. Providence Tool Co., 11 Fed. Cas. No. 6,384, 3 Ban. & A. 501, 14 Off. Gaz. 855; Hunt v. Howe,

12 Fed. Cas. No. 6,891, McArthur Pat. Cas. 366.

Use in shop where the workmen are under no pledge of secrecy is a public use. Perkins v. Nashua Card, etc., Co., 2 Fed. 451.

51. Young v. Clipper Mfg. Co., 121 Fed. 560 [affirmed in 130 Fed. 150, 64 C. C. A. 502].

Exhibition of an experimentally constructed machine by the inventor to a non-paying audience is not a public use. Victor Talking Mach. Co. v. American Graphophone Co., 140 Fed. 860 [affirmed in 145 Fed. 350, 76 C. C. A. 180].

52. Clark Pomace-Holder Co. v. Ferguson, 17 Fed. 79, 21 Blatchf. 376; Jones v. Barker, 11 Fed. 597; Egbert v. Lippmann, 8 Fed. Cas. No. 4,306, 3 Ban. & A. 468, 15 Blatchf. 295, 14 Off. Gaz. 822 [affirmed in 104 U. S. 333, 26 L. ed. 755]; Dalby v. Lynes, 71 Off. Gaz. 1317; Worley v. Loker Tobacco Co., 21 Off. Gaz. 559; Househill Coal, etc., Co. v. Neilson, 9 Cl. & F. 788, 8 Eng. Reprint 616; Hessin v. Coppin, 19 Grant Ch. (U. C.) 629; Abell v. McPherson, 17 Grant Ch. (U. C.) 23.

Three articles made and used as samples constitute a bar. Dalby v. Lynes, 64 Fed. 376.

53. Flomerfelt v. Newwitter, 88 Fed. 696; Clisby v. Reese, 88 Fed. 645, 32 C. C. A. 80.

54. In re Drawbaugh, 3 App. Cas. (D. C.) 236; Andrews v. Hovey, 123 U. S. 267, 8 S. Ct. 101, 31 L. ed. 160; Kelleher v. Darling, 14 Fed. Cas. No. 7,653, 3 Ban. & A. 438, 4 Cliff. 424, 14 Off. Gaz. 673.

In Canada public use one year is a bar with or without consent. Patric v. Sylvester, 23 Grant Ch. (U. C.) 573.

Under the former law, knowledge and consent were necessary. Davis v. Fredericks, 19 Fed. 99, 21 Blatchf. 556; Emery v. Cavanagh, 17 Fed. 242; Campbell v. New York, 9 Fed. 500, 35 Fed. 504, 1 L. R. A. 48; Carroll v. Gambrill, 5 Fed. Cas. No. 2,454, McArthur Pat. Cas. 581; Draper v. Wattles, 7 Fed. Cas. No. 4,073, 3 Ban. & A. 618, 16 Off. Gaz. 629; Jones v. Sewall, 13 Fed. Cas. No. 7,495, 3 Cliff. 563, 6 Fish. Pat. Cas. 343, 3 Off. Gaz. 630 [reversed on other grounds in 91 U. S. 171, 23 L. ed. 275]; Russell, etc., Mfg. Co. v. Mallory, 21 Fed. Cas. No. 12,166, 10 Blatchf. 140, 5 Fish. Pat. Cas. 632, 2



(iv) *INVENTION MUST BE COMPLETE.* To constitute public use the invention must have been complete.<sup>55</sup> This does not mean, however, that the machine embodying it must have been perfect, but merely that it shall be sufficiently perfect to be practically applied to its intended purpose.<sup>56</sup>

(v) *EXPERIMENTAL USE.* Use for purposes of experiment having in view the perfection of the invention is not a public use, although it occurs in public,<sup>57</sup> and such experimental use may continue for many years without operating as a bar,<sup>58</sup> according to the character of the particular invention and the time necessary to develop and perfect it and determine its practical efficiency.<sup>59</sup>

(vi) *SECRET USE.* Use of the invention in secret either by the inventor or his agents under an injunction of secrecy is not a public use.<sup>60</sup> But permitting another to use the invention without any injunction of secrecy is public use, although the use may have been concealed from others.<sup>61</sup>

(vii) *NATURAL AND INTENDED USE.* Use of an invention in public, however, in its natural and intended way is a public use,<sup>62</sup> although from its nature it is concealed from the general view of the public.<sup>63</sup>

(viii) *USE FOR PROFIT.* When an invention is used for the purpose of

Off. Gaz. 495; *Ryan v. Goodwin*, 21 Fed. Cas. No. 12,186, 1 Robb Pat. Cas. 725, 3 Sumn. 514; *Whitney v. Emmett*, 29 Fed. Cas. No. 17,585, *Baldw.* 303, 1 Robb Pat. Cas. 567; *Wyeth v. Stone*, 30 Fed. Cas. No. 18,107, 2 Robb Pat. Cas. 23, 1 Story 273.

55. *Huntington Dry-Pulverizer Co. v. Newell Universal Mill Co.*, 109 Fed. 269; *Peeney v. Lakeview*, 35 Fed. 586; *Graham v. McCormick*, 11 Fed. 859, 10 Biss. 39; *Sanders v. Logan*, 21 Fed. Cas. No. 12,295, 2 Fish. Pat. Cas. 167, 2 Pittsb. (Pa.) 241.

56. *Newark Mach. Co. v. Hargett*, 28 Fed. 567; *Sanders v. Logan*, 21 Fed. Cas. No. 12,295, 2 Fish. Pat. Cas. 167, 2 Pittsb. (Pa.) 241.

57. *Elizabeth v. American Nicholson Pavement Co.*, 97 U. S. 126, 24 L. ed. 1000; *American Caramel Co. v. Mills*, 149 Fed. 743, 79 C. C. A. 449 [reversing 138 Fed. 142]; *Comptograph Co. v. Universal Accountant Mach. Co.*, 142 Fed. 539 [reversed on other grounds in 146 Fed. 981, 77 C. C. A. 227]; *Thomson-Houston Electric Co. v. Lorain Steel Co.*, 117 Fed. 249, 54 C. C. A. 281; *Westinghouse Electric, etc., Co. v. Saranac Lake Electric Light Co.*, 108 Fed. 221; *Pacific Cable R. Co. v. Butte City St. R. Co.*, 55 Fed. 760 [reversed in 60 Fed. 410, 9 C. C. A. 41]; *Eastern Paper-Bag Co. v. Standard Paper-Bag Co.*, 30 Fed. 63; *Railway Register Mfg. Co. v. Broadway, etc., R. Co.*, 22 Fed. 655, 26 Fed. 522; *Birdsall v. McDonald*, 3 Fed. Cas. No. 1,434, 1 Ban. & A. 165, 6 Off. Gaz. 682; *Jennings v. Pierce*, 13 Fed. Cas. No. 7,283, 3 Ban. & A. 361, 15 Blatchf. 42; *Jones v. Sewall*, 13 Fed. Cas. No. 7,495, 3 Cliff. 563, 6 Fish. Pat. Cas. 343, 3 Off. Gaz. 630; *Locomotive Engine Safety Truck Co. v. Pennsylvania R. Co.*, 15 Fed. Cas. No. 8,453, 1 Ban. & A. 470, 10 Blatchf. 292, 6 Off. Gaz. 927, 1 Wkly. Notes Cas. (Pa.) 16; *Morris v. Huntington*, 17 Fed. Cas. No. 9,831, 1 Paine 348, 1 Robb Pat. Cas. 448; *Pitts v. Hall*, 19 Fed. Cas. No. 11,192, 2 Blatchf. 229, Fish. Pat. Rep. 441; *Stanley v. Hewitt*, 22 Fed. Cas. No. 13,285; *U. S. Rifle, etc., Co. v. Whitney*

*Arms Co.*, 28 Fed. Cas. No. 16,793, 2 Ban. & A. 493, 14 Blatchf. 94, 11 Off. Gaz. 373 [affirmed in 118 U. S. 22, 6 S. Ct. 950, 30 L. ed. 53]; *Winans v. Schenectady, etc., R. Co.*, 30 Fed. Cas. No. 17,865, 2 Blatchf. 279; *Wyeth v. Stone*, 30 Fed. Cas. No. 18,107, 2 Robb Pat. Cas. 23, 1 Story 273; *Morgan v. Seaward*, 1 Jur. 527, 6 L. J. Exch. 153, M. & H. 55, 2 M. & W. 544; *Conway v. Ottawa Electric R. Co.*, 8 Can. Exch. 432.

Unavoidable disclosure in experiments is no bar. *In re Newall*, 4 C. B. N. S. 269, 4 Jur. N. S. 562, 27 L. J. C. P. 337, 93 E. C. L. 269; *Bentley v. Fleming*, 1 C. & K. 587, 47 E. C. L. 587; *Hills v. London Gas Light Co.*, 5 H. & N. 312, 29 L. J. Exch. 409.

58. Use of pavement on public street six years for experiment not public use. *Elizabeth v. American Nicholson Pavement Co.*, 97 U. S. 126, 24 L. ed. 1000.

59. *Henry v. Francetown Soapstone Stove Co.*, 11 Fed. Cas. No. 6,382, 2 Ban. & A. 221, 9 Off. Gaz. 408.

Use without inventor's knowledge during experiments by him is no bar. *Campbell v. New York*, 47 Fed. 515.

60. *Adams v. Edwards*, 1 Fed. Cas. No. 53, 1 Fish. Pat. Cas. 1; *Hunt v. Howe*, 12 Fed. Cas. No. 6,891, *McArthur Pat. Cas.* 366.

61. *Manning v. Cape Ann Isinglass, etc., Co.*, 108 U. S. 462, 2 S. Ct. 860, 27 L. ed. 793; *Elizabeth v. American Nicholson Pavement Co.*, 97 U. S. 126, 24 L. ed. 1000.

62. *Brush v. Condit*, 132 U. S. 39, 10 S. Ct. 1, 33 L. ed. 251; *Hall v. Macneale*, 107 U. S. 90, 2 S. Ct. 73, 27 L. ed. 367; *Thomson-Houston Electric Co. v. Lorain Steel Co.*, 110 Fed. 654 [affirmed in 117 Fed. 249, 54 C. C. A. 281]; *Lettelier v. Mann*, 91 Fed. 917.

Use in employer's factory is public use. *In re Tournier*, 17 App. Cas. (D. C.) 481; *Worley v. Loker Tobacco Co.*, 104 U. S. 340, 26 L. ed. 821.

63. *Brush v. Condit*, 132 U. S. 39, 10 S. Ct. 1, 33 L. ed. 251; *Hall v. Macneale*, 107 U. S. 90, 2 S. Ct. 73, 27 L. ed. 367; *Perkins v. Nashua Card, etc., Co.*, 2 Fed. 451.



experiment it is not rendered a public use by the fact that a profit was derived from its use.<sup>64</sup> But where profit was the controlling cause of the use and the experiment was merely incidental the grant of a patent is barred.<sup>65</sup>

(IX) *USE IN A FOREIGN COUNTRY.* Use abroad is not a public use which will invalidate a patent in the United States. To constitute a bar the use must be in this country.<sup>66</sup> In Canada public use abroad before the invention by the patentee invalidates the patent.<sup>67</sup>

**c. On Sale**—(i) *IN GENERAL.* An invention is on sale when articles or machines embodying it are made and offered for sale or are sold,<sup>68</sup> but an offer or agreement to make and deliver an invention not already made and tested does not place it on sale.<sup>69</sup> An assignment of the right to secure a patent is not placing the invention on sale.<sup>70</sup>

(II) *SINGLE SALE SUFFICIENT.* A single unrestricted sale is sufficient to constitute placing the invention on sale.<sup>71</sup>

(III) *OFFER FOR SALE.* An offer to sell articles previously made and tested embodying the invention places it on sale, although no actual sales were made.<sup>72</sup>

(IV) *SALE FOR EXPERIMENT.* There may be an actual sale without placing the invention on sale within the meaning of the law where done for the purpose of securing an adequate test of the invention.<sup>73</sup> There is a clear distinction between sales for the purpose of testing the market and sales to test the invention

64. *Smith, etc., Mfg. Co. v. Sprague*, 123 U. S. 249, 8 S. Ct. 122, 31 L. ed. 141; *Swain v. Holyoke Mach. Co.*, 109 Fed. 154, 48 C. C. A. 265; *Jennings v. Pierce*, 13 Fed. Cas. No. 7,283, 3 Ban. & A. 361, 15 Blatchf. 42.

65. *Root v. Third Ave. R. Co.*, 146 U. S. 210, 13 S. Ct. 100, 36 L. ed. 946; *Smith, etc., Mfg. Co. v. Sprague*, 123 U. S. 249, 8 S. Ct. 122, 31 L. ed. 141 [*reversing* 12 Fed. 721]; *Consolidated Fruit Jar Co. v. Wright*, 94 U. S. 92, 24 L. ed. 68.

66. U. S. Rev. St. (1878) § 4923 [U. S. Comp. St. (1901) p. 3396]; *Gandy v. Main Belting Co.*, 143 U. S. 587, 12 S. Ct. 598, 36 L. ed. 272; *Badische Anilin, etc., Fabrik v. Kalle*, 94 Fed. 163; *American Sulphite Pulp Co. v. Howland Falls Pulp Co.*, 70 Fed. 986 [*reversed* on other grounds in 80 Fed. 395, 25 C. C. A. 500]; *Worswick Mfg. Co. v. Steiger*, 17 Fed. 250; *Roemer v. Logowitz*, 20 Fed. Cas. No. 11,996. And see *supra*, III, B, 5.

67. *Vanorman v. Leonard*, 2 U. C. Q. B. 72.

68. *Consolidated Fruit Jar Co. v. Wright*, 94 U. S. 92, 24 L. ed. 68; *Swain v. Holyoke Mach. Co.*, 109 Fed. 154, 48 C. C. A. 265; *Covert v. Covert*, 106 Fed. 183 [*affirmed* in 115 Fed. 493, 53 C. C. A. 225]; *Delemater v. Heath*, 58 Fed. 414, 7 C. C. A. 279; *Plimpton v. Winslow*, 14 Fed. 919; *Kells v. McKenzie*, 9 Fed. 284; *Burton v. Greenville*, 3 Fed. 642; *In re Mills*, 117 Off. Gaz. 904; *Smith, etc., Mfg. Co. v. Mellon*, 66 Off. Gaz. 173; *Henry v. Francetown Soapstone Co.*, 17 Off. Gaz. 569.

In Canada the rule is that sale one year before application does not constitute a bar unless the sale was with the inventor's consent. *Patrie v. Sylvester*, 23 Grant. Ch. (U. C.) 573.

69. *Sparkman v. Higgins*, 22 Fed. Cas. No. 13,208, 1 Blatchf. 205, Fish. Pat. Rep. 110,

5 N. Y. Leg. Obs. 122; *In re Mills*, 117 Off. Gaz. 904.

If something remains to be done to property by the vendor, an agreement to sell it is merely executory. *Hatch v. Standard Oil Co.*, 100 U. S. 124, 25 L. ed. 554.

70. U. S. Electric Lighting Co. v. Consolidated Electric Light Co., 33 Fed. 869.

71. *Swain v. Holyoke Mach. Co.*, 102 Fed. 910 [*affirmed* in 109 Fed. 154, 48 C. C. A. 265]; *Delemater v. Heath*, 58 Fed. 414, 7 C. C. A. 279; *Schneider v. Thill*, 21 Fed. Cas. No. 12,470a, 5 Ban. & A. 565; *In re Mills*, 117 Off. Gaz. 904; *Henry v. Francetown Soapstone Co.*, 17 Off. Gaz. 569; *Hessen v. Coppin*, 19 Grant Ch. (U. C.) 629; *Abell v. McPherson*, 17 Grant Ch. (U. C.) 23.

72. *Washburn, etc., Mfg. Co. v. Beat 'Em All Barbed-Wire Co.*, 143 U. S. 275, 12 S. Ct. 443, 36 L. ed. 154; *Cantrell v. Wallick*, 117 U. S. 689, 6 S. Ct. 970, 29 L. ed. 1017; *Coffin v. Ogden*, 8 Wall. (U. S.) 120, 21 L. ed. 821; *Mack v. Spencer Mfg. Co.*, 52 Fed. 819; *Wright v. Postel*, 44 Fed. 352; *Cluett v. Clafin*, 30 Fed. 921; *Plimpton v. Winslow*, 14 Fed. 919; *Washburn v. Gould*, 29 Fed. Cas. No. 17,214, 3 Story 122, 2 Robb Pat. Cas. 206; *Waterman v. Thomson*, 29 Fed. Cas. No. 17,260, 2 Fish. Pat. Cas. 461; *Mullins v. Hart*, 3 C. & K. 297.

Leaving one article at a store for sale places the invention on sale. *Covert v. Covert*, 106 Fed. 183 [*affirmed* on other grounds in 115 Fed. 493, 44 C. C. A. 225].

73. *Smith, etc., Mfg. Co. v. Sprague*, 123 U. S. 249, 8 S. Ct. 122, 31 L. ed. 141; *Swain v. Holyoke Mach. Co.*, 109 Fed. 154, 48 C. C. A. 265; *Delemater v. Heath*, 58 Fed. 414, 7 C. C. A. 279; *Harmon v. Struthers*, 43 Fed. 437, 57 Fed. 637; *Innis v. Oil City Boiler Works*, 22 Fed. 780; *Graham v. Geneva Lake Crawford Mfg. Co.*, 11 Fed. 133; *In re Mills*, 117 Off. Gaz. 904; *Henry v. Francetown Soapstone Co.*, 17 Off. Gaz. 569.



itself. The former is a trader's and not an inventor's experiment and does not carve an exception out of the statute.<sup>74</sup>

(v) *CONDITIONAL SALE*. The sale must be absolute to constitute a bar, and where the inventor retains a certain control over the machine for purposes of test it is not on sale.<sup>75</sup>

(vi) *PERFECTED INVENTION*. It is not necessary that the machine sold shall be perfect or well made mechanically but it is sufficient that it is operative.<sup>76</sup>

(vii) *BURDEN OF PROOF*. The presumption is against two years public use or sale, and the burden is upon the one alleging it to establish it by proof beyond a reasonable doubt.<sup>77</sup> Where, however, the use or sale is established the burden is upon the patentee to show that it was for experiment.<sup>78</sup>

**G. Abandonment of Invention** — 1. **IN GENERAL**. The abandonment of an invention is the relinquishment by the inventor of the inchoate right to secure a patent upon an invention made by him and the consequent dedication of that invention to the free and unlimited use of the public.<sup>79</sup> An invention may be abandoned at any time before or after application;<sup>80</sup> and the right once abandoned cannot be resumed.<sup>81</sup> The benefit of the abandonment, however, inures to

74. *Smith, etc., Mfg. Co. v. Mellon*, 58 Fed. 705, 7 C. C. A. 439; *Consolidated Fruit-Jar Co. v. Wright*, 6 Fed. Cas. No. 3,135, 1 Ban. & A. 320, 12 Blatchf. 149, 6 Off. Gaz. 327 [affirmed in 94 U. S. 92, 24 L. ed. 68].

75. *Swain v. Holyoke Mach. Co.*, 109 Fed. 154, 48 C. C. A. 265; *Delemater v. Heath*, 58 Fed. 414, 7 C. C. A. 279; *Henry v. Francetown Soapstone Co.*, 17 Off. Gaz. 569. *re Mills*, 117 Off. Gaz. 904.

76. *Newark Mach. Co. v. Hargett*, 28 Fed. 567; *Lyman v. Maypole*, 19 Fed. 735; *Graham v. McCormick*, 11 Fed. 859, 10 Biss. 39; *American Hide, etc., Co. v. American Tool, etc., Co.*, 1 Fed. Cas. No. 302, 4 Fish. Pat. Cas. 284, Holmes 503; *Henry v. Francetown Soapstone Co.*, 17 Off. Gaz. 569.

77. *Washburn, etc., Mfg. Co. v. Beat 'Em All Barbed-Wire Co.*, 143 U. S. 275, 12 S. Ct. 443, 36 L. ed. 154; *Albright v. Longfeld*, 131 Fed. 473; *Timolat v. Philadelphia Pneumatic Tool Co.*, 131 Fed. 257; *Durfee v. Bawo*, 118 Fed. 853; *Loew Filter Co. v. German-American Filter Co.*, 107 Fed. 949, 47 C. C. A. 94; *Brown v. Zaubitz*, 105 Fed. 242; *Flomerefelt v. Newwitter*, 88 Fed. 696; *Mast v. Dempster Mill Mfg. Co.*, 82 Fed. 327, 27 C. C. A. 191; *Kraatz v. Tieman*, 79 Fed. 322; *Dodge v. Post*, 76 Fed. 807; *Oval Wood Dish Co. v. Sandy Creek, N. Y. Wood Mfg. Co.*, 60 Fed. 285; *Converse v. Matthews*, 53 Fed. 246; *Francis v. Kirkpatrick*, 52 Fed. 824; *Wetherell v. Keith*, 27 Fed. 364; *Adams, etc., Mfg. Co. v. Rathbone*, 26 Fed. 262; *Dreyfus v. Schneider*, 25 Fed. 481; *Innis v. Oil City Boiler Works*, 22 Fed. 780; *Everest v. Buffalo Lubricating Oil Co.*, 20 Fed. 848; *Washburn, etc., Mfg. Co. v. Haish*, 4 Fed. 900, 10 Biss. 65; *American Hide, etc., Co. v. American Tool, etc., Co.*, 1 Fed. Cas. No. 302, 4 Fish. Pat. Cas. 284, Holmes 503; *Andrews v. Carmen*, 1 Fed. Cas. No. 371, 2 Ban. & A. 277, 13 Blatchf. 307, 9 Off. Gaz. 1011; *Brown v. Whittemore*, 4 Fed. Cas. No. 2,033, 5 Fish. Pat. Cas. 524, 2 Off. Gaz. 248; *Jones v. Sewall*, 13 Fed. Cas. No. 7,495, 3 Cliff. 563, 6 Fish. Pat. Cas. 343, 3 Off. Gaz. 630 [reversed on other grounds in 91 U. S. 171, 23

L. ed. 275]; *Parker v. Remhoff*, 18 Fed. Cas. No. 10,747, 3 Ban. & A. 550, 17 Blatchf. 206, 14 Off. Gaz. 601; *Pitts v. Hall*, 19 Fed. Cas. No. 11,192, 2 Blatchf. 229, Fish. Pat. Rep. 441.

For proof held insufficient see *Beedle v. Bennett*, 122 U. S. 71, 7 S. Ct. 1090, 30 L. ed. 1074; *Anderson v. Monroe*, 55 Fed. 396 [reversed on other grounds in 58 Fed. 398, 7 C. C. A. 272]; *Haughey v. Meyer*, 48 Fed. 679; *Zinsser v. Kremer*, 39 Fed. 111; *Adams, etc., Mfg. Co. v. Rathbone*, 26 Fed. 262.

78. *Smith, etc., Mfg. Co. v. Sprague*, 123 U. S. 249, 8 S. Ct. 122, 31 L. ed. 141; *Thomson-Houston Electric Co. v. Lorain Steel Co.*, 117 Fed. 249, 54 C. C. A. 281; *Swain v. Holyoke Mach. Co.*, 109 Fed. 154, 48 C. C. A. 265, 111 Fed. 408, 49 C. C. A. 419; *Lettelier v. Mann*, 91 Fed. 917; *In re Mills*, 117 Off. Gaz. 904; *Henry v. Francetown Soapstone Co.*, 17 Off. Gaz. 569.

Insufficient proof that use was for experiment see *Root v. Third Ave. R. Co.*, 146 U. S. 210, 13 S. Ct. 100, 36 L. ed. 946.

79. *U. S. Rifle, etc., Co. v. Whitney Arms Co.*, 118 U. S. 22, 6 S. Ct. 950, 30 L. ed. 53; *Woodbury Patent Planing Mach. Co. v. Keith*, 101 U. S. 479, 25 L. ed. 939; *Consolidated Fruit Jar Co. v. Wright*, 94 U. S. 92, 24 L. ed. 68; *Kendall v. Winsor*, 21 How. (U. S.) 322, 16 L. ed. 165; *Shaw v. Cooper*, 7 Pet. (U. S.) 292, 8 L. ed. 689.

80. *Woodbury Patent Planing Mach. Co. v. Keith*, 101 U. S. 479, 25 L. ed. 939; *American Hide, etc., Splitting, etc., Mach. Co. v. American Tool, etc., Co.*, 1 Fed. Cas. No. 302, 4 Fish. Pat. Cas. 284, Holmes 503; *Pitts v. Hall*, 19 Fed. Cas. No. 11,192, 2 Blatchf. 229, Fish. Pat. Rep. 441.

An invention may be abandoned within two years before application as well as prior to that time. *Mast v. Dempster Mill Mfg. Co.*, 71 Fed. 701; *Sanders v. Logan*, 21 Fed. Cas. No. 12,295, 2 Fish. Pat. Cas. 167, 2 Pittsb. (Pa.) 241.

81. *McCay v. Burr*, 6 Pa. St. 147, 47 Am. Dec. 441; *Gill v. U. S.*, 160 U. S. 426, 16 S. Ct. 322, 40 L. ed. 480; *Woodbury Patent*



the public and not to a later inventor.<sup>82</sup> Abandonment to the public is not confined to reissues, but statute applies to all patents.<sup>83</sup>

**2. QUESTION OF INTENT.** Abandonment involves a consideration of the inventor's intent, but the intent may be presumed from conduct as well as from words.<sup>84</sup>

**3. EXPRESS ABANDONMENT.** Declarations by the inventor manifesting an intent not to secure a patent upon his invention amounts to abandonment.<sup>85</sup>

**4. ABANDONMENT BY CONDUCT.** Where the inventor acquiesces in the use of his invention by others and his conduct is such as to lead the public to believe that he does not intend to secure a patent he has abandoned it.<sup>86</sup> So the acceptance of a patent with claims narrowed to exclude matter cited by the patent office as an anticipation is an abandonment thereof to the public;<sup>87</sup> and one who retires from an interference proceeding and withdraws his claim for the specific element forming the subject of the interference is thereafter precluded from claiming such element under his patent.<sup>88</sup> Publication is not abandonment,<sup>89</sup> and merely permitting others to use an invention before application for a patent does not amount to abandonment.<sup>90</sup> And mere delay in applying for a patent is not abandonment.<sup>91</sup>

*Planing Mach. Co. v. Keith*, 101 U. S. 479, 25 L. ed. 939; *Consolidated Fruit Jar Co. v. Wright*, 94 U. S. 92, 24 L. ed. 68; *Kendall v. Winsor*, 21 How. (U. S.) 322, 16 L. ed. 165; *Shaw v. Cooper*, 7 Pet. (U. S.) 292, 8 L. ed. 689; *Grant v. Raymond*, 6 Pet. (U. S.) 218, 8 L. ed. 376; *Pennock v. Dialogue*, 2 Pet. (U. S.) 1, 7 L. ed. 327; *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.*, 33 Fed. 254; *American Hide, etc., Splitting, etc., Mach. Co. v. American Tool, etc., Co.*, 1 Fed. Cas. No. 302, 4 Fish. Pat. Cas. 284, *Holmes* 503; *Batten v. Taggart*, 2 Fed. Cas. No. 1,107, 2 Wall. Jr. 101; *Colt v. Massachusetts Arms Co.*, 6 Fed. Cas. No. 3,030, 1 Fish. Pat. Cas. 108; *Mellus v. Silsbee*, 16 Fed. Cas. No. 9,404, 4 Mason 108, 1 Robb Pat. Cas. 506; *Ransom v. New York*, 20 Fed. Cas. No. 11,573, 1 Fish. Pat. Cas. 252; *Whipple v. Baldwin Mfg. Co.*, 29 Fed. Cas. No. 17,514, 4 Fish. Pat. Cas. 29; *White v. Allen*, 29 Fed. Cas. No. 17,535, 2 Cliff. 224, 2 Fish. Pat. Cas. 440; *Whittemore v. Cutter*, 29 Fed. Cas. No. 17,601, 1 Gall. 478, 1 Robb Pat. Cas. 40.

**Estoppel.**—Where an inventor has declared a purpose to abandon his invention and not to take out a patent, he will be estopped from afterward asserting his rights as against any person who has acted on the faith of such declaration. *Pitts v. Hall*, 19 Fed. Cas. No. 11,192, 2 Blatchf. 229, Fish. Pat. Rep. 441.

**82.** *Evans v. Eaton*, 8 Fed. Cas. No. 4,559, Pet. C. C. 322, 1 Robb Pat. Cas. 68; *Pickering v. McCullough*, 19 Fed. Cas. No. 11,121, 3 Ban. & A. 279, 6 Reporter 101, 13 Off. Gaz. 818 [affirmed in 104 U. S. 310, 26 L. ed. 749]; *Sturtevant v. Greenough*, 23 Fed. Cas. No. 13,579.

**83.** *Railway Register Mfg. Co. v. Broadway, etc., R. Co.*, 26 Fed. 522.

**84.** Must be declaration or act showing intent. *Beedle v. Bennett*, 122 U. S. 71, 7 S. Ct. 1090, 30 L. ed. 1074; *U. S. Rifle, etc., Co. v. Whitney Arms Co.*, 118 U. S. 22, 6 S. Ct. 950, 30 L. ed. 953; *Shaw v. Cooper*, 7 Pet. (U. S.) 292, 8 L. ed. 689; *Grant v. Raymond*, 6 Pet. (U. S.) 218, 8 L. ed. 376; *Burdon Wire, etc.,*

*Co. v. Williams*, 128 Fed. 927; *Johnsen v. Fassman*, 13 Fed. Cas. No. 7,365, 5 Fish. Pat. Cas. 471, 1 Woods 138, 2 Off. Gaz. 94; *Jones v. Sewall*, 13 Fed. Cas. No. 7,495, 3 Cliff. 563, 6 Fish. Pat. Cas. 343, 3 Off. Gaz. 630; *Pitts v. Hall*, 19 Fed. Cas. No. 11,192, 2 Blatchf. 229, Fish. Pat. Rep. 441; *Sayles v. Chicago, etc., R. Co.*, 21 Fed. Cas. No. 12,414, 1 Biss. 468, 2 Fish. Pat. Cas. 523.

**85.** *Woodbury Patent Planing Mach. Co. v. Keith*, 101 U. S. 479, 25 L. ed. 939; *Johnsen v. Fassman*, 13 Fed. Cas. No. 7,365, 5 Fish. Pat. Cas. 471, 1 Woods 138, 2 Off. Gaz. 94; *Sayles v. Chicago, etc., R. Co.*, 21 Fed. Cas. No. 12,414, 1 Biss. 468, 2 Fish. Pat. Cas. 523.

For declarations not amounting to abandonment see *Pitts v. Hall*, 19 Fed. Cas. No. 11,192, 2 Blatchf. 229, Fish. Pat. Rep. 441.

**86.** *Mast v. Dempster Mill Mfg. Co.*, 71 Fed. 701; *Craver v. Weyhrich*, 31 Fed. 607 [affirmed in 124 U. S. 196, 8 S. Ct. 459, 31 L. ed. 389]; *Carroll v. Gambrill*, 5 Fed. Cas. No. 2,454, *McArthur Pat. Cas.* 581; *U. S. Rifle, etc., Co. v. Whitney Arms Co.*, 28 Fed. Cas. No. 16,793, 2 Ban. & A. 493, 14 Blatchf. 94, 11 Off. Gaz. 373 [affirmed in 118 U. S. 22, 6 S. Ct. 950, 30 L. ed. 531]; *Wickersham v. Singer*, 29 Fed. Cas. No. 17,610, *McArthur Pat. Cas.* 645. And see *Universal Adding Mach. Co. v. Comptograph Co.*, 146 Fed. 981, 77 C. C. A. 227 [reversing 142 Fed. 539].

Acquiescence in public use may be abandonment. *Mellus v. Silsbee*, 16 Fed. Cas. No. 9,404, 1 Robb Pat. Cas. 506, 4 Mason 108; *Pennock v. Dialogue*, 19 Fed. Cas. No. 10,941, 1 Robb Pat. Cas. 466, 4 Wash. 538 [affirmed in 2 Pet. 1, 7 L. ed. 327].

**87.** *Maier v. Bloom*, 95 Fed. 159.

**88.** *Shoemaker v. Merrow*, 61 Fed. 945, 10 C. C. A. 181 [reversing 59 Fed. 120].

**89.** *Goodyear v. Day*, 10 Fed. Cas. No. 5,566.

**90.** *McCay v. Burr*, 6 Pa. St. 147, 47 Am. Dec. 441; *Mast v. Dempster Mill Mfg. Co.*, 82 Fed. 327, 27 C. C. A. 191 [reversing 71 Fed. 701]; *McCormick v. Seymour*, 15 Fed. Cas. No. 8,726, 2 Blatchf. 240 [reversed in part in 16 How. 480, 14 L. ed. 1024].

**91.** *Bates v. Coe*, 98 U. S. 31, 25 L. ed.



**5. NECESSITY OF DISCLOSURE TO PUBLIC.** There can be no abandonment to the public unless the complete invention has been disclosed to the public.<sup>92</sup>

**6. ABANDONED EXPERIMENTS.** An abandonment of experiments upon an incomplete and imperfect invention is not a dedication of that invention to the public.<sup>93</sup>

**7. FAILURE TO CLAIM IN PATENT.** What is disclosed in a patent and not claimed therein is presumed not novel or is dedicated to the public by the patentee.<sup>94</sup> The presumption, however, is rebutted if the patentee has another application pending in the patent office claiming it,<sup>95</sup> or if he files such application promptly.<sup>96</sup> Matter erased from one application and presented in a second after grant of a patent is not abandoned.<sup>97</sup>

**8. ABANDONMENT OF APPLICATION.** A party may abandon a particular application for patent without abandoning the intent to secure a patent at some time

68; *Appert v. Brownsville Plate Glass Co.*, 144 Fed. 115; *Eck v. Kutz*, 132 Fed. 758; *Western Electric Co. v. Sperry Electric Co.*, 58 Fed. 186, 7 C. C. A. 164; *U. S. Electric Lighting Co. v. Consolidated Electric Light Co.*, 33 Fed. 869; *Miller v. Smith*, 5 Fed. 359; *Birdsall v. McDonald*, 3 Fed. Cas. No. 1,434, 1 Ban. & A. 165, 6 Off. Gaz. 682; *Heath v. Hildreth*, 11 Fed. Cas. No. 6,309; *Knox v. Loweree*, 14 Fed. Cas. No. 7,910, 1 Ban. & A. 589, 6 Off. Gaz. 802; *Perry v. Cornell*, 19 Fed. Cas. No. 11,002, *McArthur Pat. Cas.* 68; *Russell, etc., Mfg. Co. v. Mallory*, 21 Fed. Cas. No. 12,166, 10 Blatchf. 140, 5 Fish. Pat. Cas. 632, 2 Off. Gaz. 495; *White v. Allen*, 29 Fed. Cas. No. 17,535, 2 Cliff. 224, 2 Fish. Pat. Cas. 440; *Yearsley v. Brookfield*, 30 Fed. Cas. No. 18,131, *McArthur Pat. Cas.* 193.

Date of application during experiment not abandonment. *Agawam Woolen Co. v. Jordan*, 7 Wall. (U. S.) 583, 19 L. ed. 177.

If action is taken within the time fixed by statute, delay in prosecution of application in patent office not abandonment. *Crown Cork, etc., Co. v. Aluminum Stopper Co.*, 108 Fed. 845, 48 C. C. A. 72; *Adams v. Jones*, 1 Fed. Cas. No. 57, 1 Fish. Pat. Cas. 527, 2 Pittsb. (Pa.) 73; *U. S. v. American Bell Tel. Co.*, 79 Off. Gaz. 1362.

Effect of intervening rights.—Long delay in applying for a patent where there are intervening rights is abandonment. *Fefel v. Stocker*, 17 App. Cas. (D. C.) 317; *In re Mower*, 15 App. Cas. (D. C.) 144; *Ransom v. New York*, 20 Fed. Cas. No. 11,573, 1 Fish. Pat. Cas. 252.

**92.** *Bates v. Coe*, 98 U. S. 31, 25 L. ed. 68; *Ross v. Montana Union R. Co.*, 45 Fed. 424; *Miller v. Smith*, 5 Fed. 359; *Babcock v. DeGENER*, 2 Fed. Cas. No. 698, *McArthur Pat. Cas.* 607.

**93.** *Crown Cork, etc., Co. v. Aluminum Stopper Co.*, 108 Fed. 845, 48 C. C. A. 72; *Western Electric Co. v. Sperry Electric Co.*, 58 Fed. 186, 7 C. C. A. 164; *Dederick v. Fox*, 56 Fed. 714. And see *supra*, III, C, 4, e.

**94.** *In re Millett*, 18 App. Cas. (D. C.) 186; *Richards v. Chase Elevator Co.*, 159 U. S. 477, 16 S. Ct. 53, 40 L. ed. 225; *Deering v. Winona Harvester Works*, 155 U. S. 286, 15 S. Ct. 118, 39 L. ed. 153; *McClain v. Ort-mayer*, 141 U. S. 419, 12 S. Ct. 76, 35 L. ed. 800; *Yale Lock Mfg. Co. v. Berkshire Nat.*

*Bank*, 135 U. S. 342, 10 S. Ct. 884, 34 L. ed. 168; *Parker, etc., Co. v. Yale Clock Co.*, 123 U. S. 87, 8 S. Ct. 38, 31 L. ed. 100; *Mahn v. Harwood*, 112 U. S. 354, 5 S. Ct. 174, 6 S. Ct. 451, 28 L. ed. 665; *Miller v. Bridgeport Brass Co.*, 104 U. S. 350, 26 L. ed. 783; *Ide v. Trorlicht, etc., Carpet Co.*, 115 Fed. 137, 53 C. C. A. 341; *Campbell v. H. T. Conde Implement Co.*, 74 Fed. 745; *McBride v. Kingman*, 72 Fed. 908; *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.*, 33 Fed. 254; *Swift v. Jenks*, 19 Fed. 641; *Batten v. Taggart*, 3 Fed. Cas. No. 1,107, 2 Wall. Jr. 101 [*reversed* on other grounds in 17 How. 74, 15 L. ed. 37].

A claim to a specific combination and a failure to claim other combinations apparent on the face of the patent is a dedication of them to the public. *Bantz v. Frantz*, 105 U. S. 160, 26 L. ed. 1013; *Miller v. Bridgeport Brass Co.*, 104 U. S. 350, 26 L. ed. 783; *Fassett v. Ewart Mfg. Co.*, 58 Fed. 360 [*affirmed* in 62 Fed. 404, 10 C. C. A. 441].

Claim to a combination is held to amount to a disclaimer of the separate elements. *Wells v. Curtis*, 66 Fed. 318, 13 C. C. A. 494; *Rowell v. Lindsay*, 6 Fed. 290, 10 Biss. 217 [*affirmed* in 113 U. S. 97, 5 S. Ct. 507, 28 L. ed. 906].

More disclosure without claim will not prevent subsequent patent. *Vermont Farm Mach. Co. v. Marble*, 19 Fed. 307; *Graham v. Geneva Lake Crawford Mfg. Co.*, 11 Fed. 138.

Description of process in machine patent is not abandonment. *Eastern Paper-Bag Co. v. Nixon*, 35 Fed. 752; *Eastern Paper-Bag Co. v. Standard Paper-Bag Co.*, 30 Fed. 63.

**95.** *Miller v. Eagle Mfg. Co.*, 151 U. S. 186, 14 S. Ct. 310, 38 L. ed. 121; *Suffolk Mfg. Co. v. Hayden*, 3 Wall. (U. S.) 315, 18 L. ed. 76; *Kinnear Mfg. Co. v. Wilson*, 142 Fed. 970, 74 C. C. A. 232; *Victor Talking Mach. Co. v. American Graphophone Co.*, 140 Fed. 860 [*affirmed* in 145 Fed. 350, 76 C. C. A. 180]; *Electrical Accumulator Co. v. Brush Electric Co.*, 52 Fed. 130, 2 C. C. A. 682; *Singer v. Braunsdorf*, 22 Fed. Cas. No. 12,897, 7 Blatchf. 521.

**96.** *Dederick v. Fox*, 56 Fed. 714; *Graham v. McCormick*, 11 Fed. 859, 10 Biss. 39.

**97.** *Sugar Apparatus Mfg. Co. v. Yaryan Mfg. Co.*, 43 Fed. 140.



and therefore without abandoning the invention claimed therein. He may file a subsequent application and secure a patent.<sup>93</sup> Nevertheless where an application for a patent has been filed and withdrawn, lapse of time is a fact which may give great point and force to testimony disclosing what was done in the interval.<sup>99</sup>

**9. EVIDENCE OF ABANDONMENT.** Abandonment is never presumed;<sup>1</sup> on the contrary the presumption is against abandonment and the burden is upon the one asserting it to prove it beyond a reasonable doubt.<sup>2</sup> The issue of letters patent is *prima facie* evidence that there has been no abandonment.<sup>3</sup> Where the evidence raises a presumption of abandonment, it may be rebutted by showing acts prosecuting or asserting the discovery, as the filing of drawings in the patent office.<sup>4</sup> Where the undisputed acts of an inventor furnish evidence of abandonment, his testimony that he did not intend to abandon his invention is not entitled to much weight.<sup>5</sup>

#### IV. PERSONS ENTITLED TO PATENTS.<sup>6</sup>

**A. Original and First Inventor<sup>7</sup>—1. IN GENERAL.** No valid patent can issue in the United States except upon the application of a person who made the invention by his own original thought,<sup>8</sup> or if he is dead upon the application of his executor or administrator.<sup>9</sup> As between two original inventors of the same thing, the one first to make it in this country or bring it to this country is

98. *Edison v. American Mutoscope Co.*, 110 Fed. 660 [*reversed* in 114 Fed. 926, 52 C. C. A. 546]; *Western Electric Co. v. Sperry Electric Co.*, 58 Fed. 186, 7 C. C. A. 164; *Dederick v. Fox*, 56 Fed. 714; *Lindsay v. Stein*, 10 Fed. 907, 20 Blatchf. 370.

Abandonment of application and at the same time filing a new application is not an abandonment of the invention. *Dederick v. Fox*, 56 Fed. 714.

99. *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.*, 27 Fed. 377.

1. *American Hide, etc., Splitting, etc., Mach. Co. v. American Tool, etc., Co.*, 1 Fed. Cas. No. 302, 4 Fish. Pat. Cas. 284, *Holmes* 503; *Johnsen v. Fassman*, 13 Fed. Cas. No. 7,365, 5 Fish. Pat. Cas. 471, 1 *Woods* 138, 2 Off. Gaz. 94.

2. *Computing Scale Co. v. Automatic Scale Co.*, 26 App. Cas. (D. C.) 238 [*affirmed* in 204 U. S. 609, 27 S. Ct. 307, 51 L. ed. 645]; *Ide v. Trorlicht, etc., Carpet Co.*, 115 Fed. 137, 53 C. C. A. 341; *Crown Cork, etc., Co. v. Aluminum Stopper Co.*, 108 Fed. 845, 48 C. C. A. 72; *Jones v. Sewall*, 13 Fed. Cas. No. 7,495, 3 *Cliff*. 563, 6 Fish. Pat. Cas. 343, 3 Off. Gaz. 630 [*reversed* on other grounds in 91 U. S. 171, 23 L. ed. 275]; *McCormick v. Seymour*, 15 Fed. Cas. No. 8,726, 2 Blatchf. 240; *McMillin v. Barclay*, 16 Fed. Cas. No. 8,902, 5 Fish. Pat. Cas. 189, 4 *Brewst.* (Pa.) 275. And see *Rolfe v. Hoffman*, 26 App. Cas. (D. C.) 336.

3. *Johnsen v. Fassman*, 13 Fed. Cas. No. 7,365, 5 Fish. Pat. Cas. 471, 1 *Woods* 138, 2 Off. Gaz. 94.

4. *Emerson v. Hogg*, 8 Fed. Cas. No. 4,440, 2 Blatchf. 1, 1 Fish. Pat. Rep. 77.

5. *Bevin v. East Hampton Bell Co.*, 3 Fed. Cas. No. 1,379, 9 Blatchf. 50, 5 Fish. Pat. Cas. 23.

6. Right to extension of patent see *infra*, VII, B.

Right to reissues see *infra*, VIII.

7. Competency of witnesses on issue of priority see WITNESSES.

Prior public use or sale in general see *supra*, III, F, 8.

8. U. S. Rev. St. (1878) § 4895 [U. S. Comp. St. (1901) p. 3385]; *Kennedy v. Hazelton*, 128 U. S. 667, 9 S. Ct. 202, 32 L. ed. 576; *Haselden v. Ogden*, 11 Fed. Cas. No. 6,190, 3 Fish. Pat. Cas. 378; *Stearns v. Davis*, 22 Fed. Cas. No. 13,338, *McArthur Pat. Cas.* 696.

**Introducer.**—Must be inventor not introducer. *Livingston v. Van Ingen*, 9 Johns. (N. Y.) 507; *American Sulphite Pulp Co. v. Howland Falls Pulp Co.*, 70 Fed. 986 [*reversed* on other grounds in 80 Fed. 395, 25 C. C. A. 500].

**User.**—Must be inventor and not mere user. *In re Honiball*, 9 Moore P. C. 378, 14 Eng. Reprint 340.

Contracts as to ownership cannot affect the question of inventorship. *Tyler v. Kelch*, 19 App. Cas. (D. C.) 180; *Hunt v. McCaslin*, 10 App. Cas. (D. C.) 527.

Abandonment of the right to a patent by the original inventor does not entitle another to a patent therefor. *Evans v. Eaton*, 8 Fed. Cas. No. 4,559, *Pet. C. C.* 322, 1 *Robb Pat. Cas.* 68; *Pickering v. McCullough*, 19 Fed. Cas. No. 11,121, 3 *Ban. & A.* 279, 6 *Reporter* 101, 13 Off. Gaz. 818 [*affirmed* in 104 U. S. 310, 26 L. ed. 749].

In Canada the applicant must be the original inventor. *Smith v. Goldie*, 9 Can. Sup. Ct. 46; *American Dunlop Tire Co. v. Goold Bicycle Co.*, 6 Can. Exch. 223.

9. U. S. Rev. St. (1878) § 4896; *De la Vergne Refrigerating Mach. Co. v. Featherstone*, 147 U. S. 209, 13 S. Ct. 283, 37 L. ed. 138; *Eagleton Mfg. Co. v. West Bradley, etc., Mfg. Co.*, 111 U. S. 490, 4 S. Ct. 593, 28 L. ed. 493.



entitled to the patent.<sup>10</sup> A patent granted upon the application of one who is not the inventor is void.<sup>11</sup>

**2. FIRST INVENTOR.** The first inventor is the one who first has a mental conception of the invention provided he exercises diligence thereafter in adapting and perfecting it, but as against a rival claimant who first reduced the invention to practice the burden is upon the first conceiver to show diligence.<sup>12</sup> The party first to reduce to practice is *prima facie* the first inventor;<sup>13</sup> but the man who first conceives and in a mental sense first invents a machine, art, or composition of matter may date his particular invention back to the time of its conception, if he connects the conception with its reduction to practice by reasonable diligence on his part so that they are substantially one continuous act.<sup>14</sup>

**3. ORIGINALITY OF INVENTION.** A person is not an original inventor unless the ideas embodied in the invention originated in the creative faculties of his mind. If he merely adapts and gives effect to the ideas of others he is not an original inventor and is not entitled to obtain a patent.<sup>15</sup>

10. *Allen v. Blunt*, 1 Fed. Cas. No. 217, 2 Robb Pat. Cas. 530, 2 Woodb. & M. 121; *Bedford v. Hunt*, 3 Fed. Cas. No. 1,217, 1 Mason 302, 1 Robb Pat. Cas. 148; *Eames v. Richards*, 8 Fed. Cas. No. 4,240; *Gibbs v. Johnson*, 10 Fed. Cas. No. 5,384; *Goodyear v. Day*, 10 Fed. Cas. No. 5,569, 2 Wall. Jr. 283; *Hayden v. Suffolk Mfg. Co.*, 11 Fed. Cas. No. 6,261, 4 Fish. Pat. Cas. 86 [affirmed in 3 Wall. 315, 18 L. ed. 76]; *Lowell v. Lewis*, 15 Fed. Cas. No. 8,568, 1 Mason 182, 1 Robb Pat. Cas. 131; *Reed v. Cutter*, 20 Fed. Cas. No. 11,645, 2 Robb Pat. Cas. 81, 1 Story 590; *Woodcock v. Parker*, 30 Fed. Cas. No. 17,971, 1 Gall. 438, 1 Robb Pat. Cas. 37; *Yearsley v. Brookfield*, 30 Fed. Cas. No. 18,131, McArthur Pat. Cas. 193. And see *infra*, V, C, 8, a.

**Agreement of parties.**—Rights cannot be changed by agreement between parties. *New Departure Bell Co. v. Corbin*, 88 Fed. 901.

**First inventor and not the first applicant** for a patent is the one entitled to the patent. *Pacific Cable R. Co. v. Butte City St. R. Co.*, 58 Fed. 420.

**Foreign inventors** applying for a patent here, and who are placed in interference, are entitled under the law to claim the date they communicated their invention here as the date of their conception, and the date of the filing of their application here as the date of their constructive reduction to practice. *Harris v. Stern*, 22 App. Cas. (D. C.) 164.

**In England** the first to secure a patent is the first inventor, although the last to file application. *Ex p. Bates*, L. R. 4 Ch. 577, 38 L. J. Ch. 501, 21 L. T. Rep. N. S. 410, 17 Wkly. Rep. 900.

11. *Kennedy v. Hazelton*, 128 U. S. 667, 9 S. Ct. 202, 32 L. ed. 576.

12. U. S. Rev. St. (1878) § 4920; *Hillard v. Brooks*, 23 App. Cas. (D. C.) 526; *Lieberman v. Williams*, 23 App. Cas. (D. C.) 223; *Paul v. Johnson*, 23 App. Cas. (D. C.) 187; *Funk v. Haines*, 20 App. Cas. (D. C.) 285; *Silverman v. Dendrickson*, 19 App. Cas. (D. C.) 381; *Yates v. Huson*, 8 App. Cas. (D. C.) 93; *Westinghouse Electric, etc., Co. v. Roberts*, 125 Fed. 6; *Christie v. Seybold*, 55 Fed. 69, 5 C. C. A. 33; *Electric R. Signal Co. v. Hall R. Signal Co.*, 6 Fed. 603 [affirmed in 114 U. S. 87, 5 S. Ct. 1069, 29 L. ed. 96];

*Kneeland v. Sheriff*, 2 Fed. 901; *Chandler v. Ladd*, 5 Fed. Cas. No. 2,593, McArthur Pat. Cas. 493; *Davidson v. Lewis*, 7 Fed. Cas. No. 3,606, McArthur Pat. Cas. 599; *Draper v. Potomska Mills Corp.*, 7 Fed. Cas. No. 4,072, 3 Ban. & A. 214, 13 Off. Gaz. 276; *Heath v. Hildreth*, 11 Fed. Cas. No. 6,309, Cranch Pat. Dec. 96, 132, McArthur Pat. Cas. 12; *Hicks v. Shaver*, 12 Fed. Cas. No. 6,462; *Hill v. Dunklee*, 12 Fed. Cas. No. 6,489, McArthur Pat. Cas. 475; *Marshall v. Mee*, 16 Fed. Cas. No. 9,129, McArthur Pat. Cas. 229; *Mix v. Perkins*, 17 Fed. Cas. No. 9,677; *Reed v. Cutter*, 20 Fed. Cas. No. 11,645, 2 Robb Pat. Cas. 81, 1 Story 590; *Stephens v. Salisbury*, 22 Fed. Cas. No. 13,369, McArthur Pat. Cas. 379; *Taylor v. Archer*, 23 Fed. Cas. No. 13,778, 18 Blatchf. 315, 4 Fish. Pat. Cas. 449; *White v. Allen*, 29 Fed. Cas. No. 17,535, 2 Cliff. 224, 2 Fish. Pat. Cas. 440. And see *infra*, IV, A, 6.

13. *Standard Cartridge Co. v. Peters Cartridge Co.*, 77 Fed. 630, 23 C. C. A. 367 [affirming 69 Fed. 408]; *Warner v. Goodyear*, 29 Fed. Cas. No. 17,183, Cranch Pat. Dec. 125, McArthur Pat. Cas. 60.

14. *Christie v. Seybold*, 55 Fed. 69, 5 C. C. A. 33; *Reed v. Cutter*, 20 Fed. Cas. No. 11,645, 2 Robb Pat. Cas. 81, 1 Story 590. And see cases cited *supra*, note 12.

15. *Greenwood v. Dover*, 23 App. Cas. (D. C.) 251; *Soley v. Hebbard*, 5 App. Cas. (D. C.) 99; *Standard Cartridge Co. v. Peters Cartridge Co.*, 77 Fed. 630, 23 C. C. A. 367; *Alden v. Dewey*, 1 Fed. Cas. No. 153, 2 Robb Pat. Cas. 17, 1 Story 336; *Burrows v. Wetherill*, 4 Fed. Cas. No. 2,208, McArthur Pat. Cas. 315; *Stearns v. Davis*, 22 Fed. Cas. No. 13,338, McArthur Pat. Cas. 696.

**Suggestion of result** but not means does not constitute invention. *Streat v. White*, 35 Fed. 426; *Bell v. Daniels*, 3 Fed. Cas. No. 1,247, 1 Bond 212, 1 Fish. Pat. Cas. 372; *Judson v. Moore*, 14 Fed. Cas. No. 7,569, 1 Bond 285, 1 Fish. Pat. Cas. 544.

**Suggestion of some features** by another than the patentee will not invalidate the patent. *Corser v. Brattleboro Overall Co.*, 93 Fed. 807; *Pitts v. Hall*, 19 Fed. Cas. No. 11,192, 2 Blatchf. 229, Fish. Pat. Rep. 441.



**4. CITIZENSHIP OF INVENTOR.** In the United States there is no limitation as to the residence, citizenship, or age of the patentee, since any and all persons from any and all countries may secure patents upon exactly the same conditions,<sup>16</sup> and the same rule obtains in England.<sup>17</sup>

**5. REDUCTION TO PRACTICE—*a.* In General.** An invention is reduced to practice when a mechanical embodiment of it is made in such form and so far perfected as to be capable of practical and successful use.<sup>18</sup> Mechanical perfection

The true test to determine whether suggestions made to an inventor should deprive him of the claim to originality in the invention is to inquire whether enough has been communicated to enable him to apply it without the exercise of invention. *Watson v. Belfield*, 26 Fed. 536.

Where the patentee learned of the invention abroad he is not an original inventor. *American Sulphite Pulp Co. v. Howland Falls Pulp Co.*, 70 Fed. 986 [*reversed* on other grounds in 80 Fed. 395, 25 C. C. A. 500].

16. U. S. Rev. St. (1878) § 4886.

17. Act (1883), § 34, 46 & 47 Vict. c. 57.

18. *Sherwood v. Drewson*, 29 App. Cas. (D. C.) 161; *Hillard v. Brooks*, 23 App. Cas. (D. C.) 526; *Herman v. Fullman*, 23 App. Cas. (D. C.) 259; *Howard v. Hey*, 18 App. Cas. (D. C.) 142; *Latham v. Armat*, 17 App. Cas. (D. C.) 345; *Christie v. Seybold*, 55 Fed. 69, 5 C. C. A. 33; *Chandler v. Ladd*, 5 Fed. Cas. No. 2,593, *McArthur Pat. Cas.* 493; *Farley v. National Steam-Gauge Co.*, 8 Fed. Cas. No. 4,648, *McArthur Pat. Cas.* 618; *Heath v. Hildreth*, 11 Fed. Cas. No. 6,309, *Cranch Pat. Cas.* 96, 132, *McArthur Pat. Cas.* 12; *Lyman Ventilating, etc., Co. v. Chamberlain*, 15 Fed. Cas. No. 8,631, 2 Ban. & A. 433, 10 Off. Gaz. 588; *Lyman Ventilating, etc., Co. v. Lalor*, 15 Fed. Cas. No. 8,632, 1 Ban. & A. 403, 12 Blatchf. 303, 6 Off. Gaz. 642; *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 18 Fed. Cas. No. 10,337, 1 Ban. & A. 77, 6 Off. Gaz. 34, 10 Phila. (Pa.) 227; *Roberts v. Reed Torpedo Co.*, 20 Fed. Cas. No. 11,910, 3 Fish. Pat. Cas. 629, 3 Brewst. (Pa.) 558; *Smith v. Prior*, 22 Fed. Cas. No. 13,095, 4 Fish. Pat. Cas. 469, 2 Sawy. 461, 4 Off. Gaz. 633.

The rules of law as to what constitutes a prior use and what constitutes a reduction to practice are the same. *Gilman v. Hinson*, 26 App. Cas. (D. C.) 409.

The device constructed must be fashioned out of a material capable of actual use for the intended purpose in order to constitute a reduction to practice. *Gilman v. Hinson*, 26 App. Cas. (D. C.) 409.

**Models and drawings.**—A model is not a reduction to practice (*Howell v. Hess*, 30 App. Cas. (D. C.) 194; *Hunter v. Stikeman*, 13 App. Cas. (D. C.) 214; *Mason v. Hepburn*, 13 App. Cas. (D. C.) 86; *Porter v. Loudon*, 7 App. Cas. (D. C.) 64; *Stainthorp v. Humiston*, 22 Fed. Cas. No. 13,281, 4 Fish. Pat. Cas. 107), unless the invention belongs to that class of simple inventions which require no other proof of their practicability than the construction of a model (*O'Connell v. Schmidt*, 27 App. Cas. (D. C.) 77). Models and drawings constituted a reduction to practice under

the act of 1836. *Heath v. Hildreth*, 11 Fed. Cas. No. 6,309, *Cranch Pat. Dec.* 96, 132, *McArthur Pat. Cas.* 12; *Perry v. Cornell*, 19 Fed. Cas. No. 11,002, *Cranch Pat. Cas.* 132, *McArthur Pat. Cas.* 68.

**Sketches and drawings** are not a reduction to practice. *Christie v. Seybold*, 55 Fed. 69, 5 C. C. A. 33. See also *supra*, III, C, 4, f.

**Unsuccessful machine** is not a reduction to practice. *Pelton v. Waters*, 19 Fed. Cas. No. 10,913, 1 Ban. & A. 599, 7 Off. Gaz. 425. See also *supra*, III, C, 4, e.

**Proof of various experiments** in search of a particular process, and an approximation to that process, does not sufficiently show a reduction to practice. *Bourn v. Hill*, 27 App. Cas. (D. C.) 291.

**Voting machine** must work with accuracy. *McKenzie v. Cummings*, 24 App. Cas. (D. C.) 137.

**Process.**—A process is reduced to practice only when used. *Croskey v. Atterbury*, 9 App. Cas. (D. C.) 207.

**Later manufacture on larger scale.**—If an experimental machine completely embodies the invention, and is capable of testing its efficiency to the full extent of its power, the mere fact that later manufactures to fill orders may be on a larger scale cannot impair its effect as constituting reduction to practice. *Robinson v. Thresher*, 28 App. Cas. (D. C.) 22.

**Long delay in making use of an invention** claimed to have been reduced to practice, or in applying for a patent, is a potent circumstance tending to show that the alleged reduction to practice was nothing more than an unsatisfactory or abandoned experiment; and this is especially the case where, in the meantime, the inventor has been engaged in the prosecution of similar inventions. *Gilman v. Hinson*, 26 App. Cas. (D. C.) 409.

Where the inventor is already engaged in disposing of a large stock of devices manufactured under former patents relating to the same subject-matter, of which the new invention is an improvement, a failure immediately to manufacture and put on the market the newly invented device does not afford any reasonable foundation for denying the date claimed for its conception. *Laas v. Scott*, 26 App. Cas. (D. C.) 354.

**The dismantling of an experimental machine** by a large and prosperous company has more weight as showing the lack of success of the trial than it would have if done by a poor inventor whose necessities compel him to utilize the parts for other purposes. *Robinson v. Thresher*, 28 App. Cas. (D. C.) 22.

**Delay in filing application** as effective weight of proof of actual reduction to prac-



is not necessary.<sup>19</sup> A perfect invention does not necessarily mean a perfectly constructed machine, but one so constructed as to embody all the essential elements of the invention in a form that would make them practical and operative, so as to accomplish the result in a practical way.<sup>20</sup> Demonstration of the success by actual use is usually necessary,<sup>21</sup> although some devices are so simple that the mere construction without use is sufficient.<sup>22</sup> The same act, or set of acts, may or may not constitute a reduction to practice, modified, as they may be, by the special circumstances of the particular case.<sup>23</sup> The reduction to practice must be by the applicant himself, or by his authorized agent, and not by some other third party.<sup>24</sup> It is not enough to entitle an applicant to a patent that someone else has shown the practicability of the invention by reducing it to practice. The work of such third party will not be taken as sufficient to relieve the applicant of the consequences of his own want of diligence.<sup>25</sup>

**b. Constructive Reduction to Practice.** The filing of an allowable application for a patent is a constructive reduction to practice of the invention at the date when it was filed.<sup>26</sup> So also is a description of the invention in a foreign patent

tice see *Seeberger v. Russel*, 26 App. Cas. (D. C.) 344.

**Reduction to practice of device for protecting low-tension telephone circuits** see *Rolfe v. Hoffman*, 26 App. Cas. (D. C.) 336.

**Evidence of reduction to practice** see *Seeberger v. Russel*, 26 App. Cas. (D. C.) 344.

19. *Lowrie v. Taylor*, 27 App. Cas. (D. C.) 522; *Coffee v. Guerrant*, 3 App. Cas. (D. C.) 497; *Brunswick-Balke-Collender Co. v. Backus Automatic Pin Setter Co.*, 153 Fed. 288; *Rogers Typograph Co. v. Mergenthaler Linotype Co.*, 64 Fed. 799, 12 C. C. A. 422; *Mergenthaler Linotype Co. v. Press Pub. Co.*, 57 Fed. 502; *Jenner v. Dickinson*, 117 Off. Gaz. 600; *Hope v. Voight*, 115 Off. Gaz. 1585; *Gallagher v. Hien*, 115 Off. Gaz. 1330; *National Cash Register Co. v. Lamson Consol. Store Service Co.*, 67 Off. Gaz. 680.

**Later improvements.**—Success is not negated by later improvements. *Wyman v. Donnelly*, 21 App. Cas. (D. C.) 81; *Hien v. Buhoup*, 11 App. Cas. (D. C.) 293.

20. *Burson v. Vogel*, 29 App. Cas. (D. C.) 388; *Coffee v. Guerrant*, 3 App. Cas. (D. C.) 497; *American Hide, etc., Splitting, etc., Mach. Co. v. American Tool, etc., Co.*, 1 Fed. Cas. No. 302, 4 Fish. Pat. Cas. 284, *Holmes* 503.

21. *Wickers v. McKee*, 29 App. Cas. (D. C.) 4; *Macdonald v. Edison*, 21 App. Cas. (D. C.) 527; *Latham v. Armat*, 17 App. Cas. (D. C.) 345; *Kelly v. Fynn*, 16 App. Cas. (D. C.) 573; *Appert v. Schmertz*, 13 App. Cas. (D. C.) 117; *Ocuppaugh v. Norton*, 115 Off. Gaz. 1850; *Paul v. Hess*, 115 Off. Gaz. 251.

**A shop test is sufficient.**—Demonstration need not be in commercial use. *Wyman v. Donnelly*, 21 App. Cas. (D. C.) 81; *Wurts v. Harrington*, 10 App. Cas. (D. C.) 149.

22. *Rolfe v. Hoffman*, 26 App. Cas. (D. C.) 336; *Couch v. Barnett*, 23 App. Cas. (D. C.) 446; *Loomis v. Hauser*, 19 App. Cas. (D. C.) 401; *Lindemeyr v. Hoffman*, 18 App. Cas. (D. C.) 1; *Mason v. Hepburn*, 13 App. Cas. (D. C.) 86.

23. *Andrews v. Nilson*, 27 App. Cas. (D. C.) 451; *Rolfe v. Hoffman*, 26 App. Cas. (D. C.) 336.

24. *Robinson v. McCormick*, 29 App. Cas. (D. C.) 98; *Hunter v. Stikeman*, 13 App. Cas. (D. C.) 214; *Burgess v. Wetmore*, 16 Off. Gaz. 765.

25. *Hunter v. Stikeman*, 13 App. Cas. (D. C.) 214.

26. *Davis v. Garrett*, 28 App. Cas. (D. C.) 9; *Cobb v. Goebel*, 23 App. Cas. (D. C.) 75; *Dashiell v. Tasker*, 21 App. Cas. (D. C.) 64; *Lindemeyr v. Hoffman*, 18 App. Cas. (D. C.) 1; *Hulett v. Long*, 15 App. Cas. (D. C.) 284; *McCormick v. Cleal*, 12 App. Cas. (D. C.) 335; *Dodge v. Fowler*, 11 App. Cas. (D. C.) 592; *Croskey v. Atterbury*, 9 App. Cas. (D. C.) 207; *Porter v. Loudon*, 7 App. Cas. (D. C.) 64; *Dane v. Chicago Mfg. Co.*, 6 Fed. Cas. No. 3,557, 3 Biss. 380, 6 Fish. Pat. Cas. 130, 2 Off. Gaz. 677; *Johnsen v. Fassman*, 13 Fed. Cas. No. 7,365, 5 Fish. Pat. Cas. 471, 1 Woods 138, 2 Off. Gaz. 94; *Johnson v. Root*, 13 Fed. Cas. No. 7,409, 2 Cliff. 108, 2 Fish. Pat. Cas. 291; *New England Screw Co. v. Sloan*, 18 Fed. Cas. No. 10,158, *McArthur Pat. Cas.* 210; *Wheeler v. Clipper, Mower, etc., Co.*, 29 Fed. Cas. No. 17,493, 10 Blatchf. 181, 6 Fish. Pat. Cas. 1, 2 Off. Gaz. 442.

**Where application fails to disclose invention sufficiently** it is not a reduction to practice. *Stevens v. Seher*, 11 App. Cas. (D. C.) 245.

**Caveat** is not a reduction to practice. *American Bell Tel. Co. v. National Tel. Mfg. Co.*, 109 Fed. 976.

**Renewal of application** takes date of original. *Lotterhand v. Hanson*, 23 App. Cas. (D. C.) 372; *Cain v. Park*, 14 App. Cas. (D. C.) 42.

**Forfeited application** cannot defeat a patent regularly granted. *Christensen v. Noyes*, 15 App. Cas. (D. C.) 94.

**Divisional application** takes date of original. *Hillard v. Brooks*, 23 App. Cas. (D. C.) 526.

**Reissue application** dates from original and applicant is entitled to date of original as date of constructive reduction to practice. *Austin v. Johnson*, 18 App. Cas. (D. C.) 83.

**In England** the patent bears date of appli-



or a printed publication.<sup>27</sup> Where an application for a patent is first made abroad in a country having the requisite treaty relations with this country, the date of the application, if within twelve months before the application here, controls.<sup>28</sup> In case of designs the foreign application must be within four months.

**6. DILIGENCE.**<sup>29</sup> The person who is first to conceive the invention but later than his rival in reducing it to practice is not regarded as the first inventor unless he exercised due diligence in efforts to perfect the invention,<sup>30</sup> at and continuously after the time that his rival entered the field against him.<sup>31</sup> Knowledge of the entry of the rival in the field is not necessary in order to impose the duty of diligence.<sup>32</sup> The question of due diligence is not a matter of comparative diligence as between the two parties,<sup>33</sup> but it is merely required that the last to reduce to practice shall show that he was exercising reasonable diligence under all of the surrounding circumstances.<sup>34</sup>

cation and is effective from that date. *Ex p.* Bailey, L. R. 8 Ch. 60, 42 L. J. Ch. 264, 27 L. T. Rep. N. S. 430, 21 Wkly. Rep. 31; *Holste v. Robertson*, 4 Ch. D. 9, 46 L. J. Ch. 1, 35 L. T. Rep. N. S. 457, 25 Wkly. Rep. 35; *Saxby v. Hennett*, L. R. 8 Exch. 210, 42 L. J. Exch. 137, 28 L. T. Rep. N. S. 639, 22 Wkly. Rep. 16; *Ex p.* Henry, L. R. 8 Ch. 167, 42 L. J. Ch. 363, 21 Wkly. Rep. 233. The patent, however, bars the grant of a subsequent patent even upon an earlier application. *Lee v. Walker*, L. R. 7 C. P. 121, 41 L. J. C. P. 91, 26 L. T. Rep. N. S. 70. Where two applications were filed on the same date both patents were granted. *In re Dering*, 13 Ch. D. 393, 42 L. T. Rep. N. S. 634, 28 Wkly. Rep. 710.

27. *Parker v. Appert*, 75 Off. Gaz. 1201.

Foreign patent is effective only from the date of issue. *Rousseau v. Brown*, 21 App. Cas. (D. C.) 73.

Acts abroad not considered unless in form of patent or publication. *Electrical Accumulator Co. v. Julien Electric Co.*, 38 Fed. 117.

28. This applies only to applications filed after March 3, 1903. 32 U. S. St. at L. 1225, c. 1019.

Foreign application was ineffective under the old law. *Rousseau v. Brown*, 21 App. Cas. (D. C.) 73.

29. Abandonment of invention in general see *supra*, III, G.

30. *Moore v. Hewitt*, 31 App. Cas. (D. C.) 577; *Rose v. Clifford*, 31 App. Cas. (D. C.) 195; *Gordon v. Wentworth*, 31 App. Cas. (D. C.) 150; *Feinberg v. Cowan*, 29 App. Cas. (D. C.) 80; *Parkes v. Lewis*, 28 App. Cas. (D. C.) 1; *Fowler v. Boyce*, 27 App. Cas. (D. C.) 48; *Fowler v. McBerty*, 27 App. Cas. (D. C.) 41; *Laas v. Scott*, 26 App. Cas. (D. C.) 354; *Dashiell v. Tasker*, 21 App. Cas. (D. C.) 64; *Oliver v. Felbel*, 20 App. Cas. (D. C.) 255; *Marvel v. Decker*, 13 App. Cas. (D. C.) 562; *Platt v. Shipley*, 11 App. Cas. (D. C.) 576; *Yates v. Huson*, 8 App. Cas. (D. C.) 93; *Standard Cartridge Co. v. Peters Cartridge Co.*, 77 Fed. 630, 23 C. C. A. 367; *Ecaubert v. Appleton*, 67 Fed. 917, 15 C. C. A. 73; *Christie v. Seybold*, 55 Fed. 69, 5 C. C. A. 33; *Hubel v. Dick*, 28 Fed. 132; *Cox v. Griggs*, 6 Fed. Cas. No. 3,302, 1 Biss. 362, 2 Fish. Pat. Cas. 174; *Ellithorp v. Robertson*, 8 Fed. Cas. No. 4,409, *McArthur Pat. Cas.* 585;

*Reeves v. Keystone Bridge Co.*, 20 Fed. Cas. No. 11,660, 5 Fish. Pat. Cas. 456, 1 Off. Gaz. 466, 9 Phila. (Pa.) 368.

Nature of diligence required.—The diligence required of an inventor is diligence rather in the reduction of his invention to practice than in application to the patent office, or in manufacturing his device for public use. *Woods v. Poor*, 29 App. Cas. (D. C.) 397; *Rolfe v. Hoffman*, 26 App. Cas. (D. C.) 336.

Constructive reductions to practice.—Diligence in applying for patent is effective. *Newton v. Woodward*, 17 App. Cas. (D. C.) 34; *Odell v. Stout*, 22 Fed. 159; *Jones v. Cooke*, 117 Off. Gaz. 1493.

Lack of diligence in prosecuting application after it is filed is of no consequence. *Miehle v. Read*, 18 App. Cas. (D. C.) 128.

Filing caveat will not excuse diligence. *Johnson v. Root*, 13 Fed. Cas. No. 7,411, 1 Fish. Pat. Cas. 351.

Work on other inventions is not diligence. *Bliss v. McElroy*, 29 App. Cas. (D. C.) 120; *Lotterhand v. Hanson*, 23 App. Cas. (D. C.) 372; *Croskey v. Atterbury*, 9 App. Cas. (D. C.) 207.

Diligence must be in testing and perfecting the invention and not merely in exploiting it commercially. *Howell v. Hess*, 30 App. Cas. (D. C.) 194; *Laas v. Scott*, 26 App. Cas. (D. C.) 354; *Seeberger v. Dodge*, 114 Off. Gaz. 2382.

31. Effective diligence must commence before rival entered the field and continue thereafter. It need not commence with conception. *McArthur v. Mygatt*, 31 App. Cas. (D. C.) 514; *De Wallace v. Scott*, 15 App. Cas. (D. C.) 157; *Griffin v. Swenson*, 15 App. Cas. (D. C.) 135; *Platt v. Shipley*, 11 App. Cas. (D. C.) 576; *Yates v. Huson*, 8 App. Cas. (D. C.) 93; *Christie v. Seybold*, 55 Fed. 69, 5 C. C. A. 33; *Reed v. Cutter*, 20 Fed. Cas. No. 11,645, 2 Robb Pat. Cas. 81, 1 Story 590.

32. *Platt v. Shipley*, 11 App. Cas. (D. C.) 576.

33. Not a race of diligence.—*Paul v. Johnson*, 23 App. Cas. (D. C.) 187; *Christie v. Seybold*, 55 Fed. 69, 5 C. C. A. 33; *Electric R. Signal Co. v. Hall R. Signal Co.*, 6 Fed. 603 [affirmed in 114 U. S. 87, 5 S. Ct. 1069, 29 L. ed. 96].

34. Diligence cannot be determined by any



**7. MODELS, DRAWINGS, AND DESCRIPTION.** Models, unpublished drawings, and verbal or unpublished description of an invention do not constitute proof of priority.<sup>35</sup> They must be followed by diligence in reduction to practice.<sup>36</sup>

**8. ASSISTANCE BY OTHERS.** The inventor who furnishes the ideas to produce the result is entitled to avail himself of the mechanical skill or scientific knowledge of others in carrying those ideas into effect and he does not thereby forfeit the right to a patent.<sup>37</sup>

general rule but depends upon the special circumstances of the particular case. *Mead v. Davis*, 31 App. Cas. (D. C.) 590; *Woods v. Poor*, 29 App. Cas. (D. C.) 397; *O'Connell v. Schmidt*, 27 App. Cas. (D. C.) 77; *De Wallace v. Scott*, 15 App. Cas. (D. C.) 157; *McCormick v. Cleal*, 12 App. Cas. (D. C.) 335.

Only such diligence as is reasonable is required. *Mead v. Davis*, 31 App. Cas. (D. C.) 590; *Garrels v. Freeman*, 21 App. Cas. (D. C.) 207.

**Experiments.**—Reasonable time is allowed for experiments. *De Wallace v. Scott*, 15 App. Cas. (D. C.) 157; *Dietz v. Wade*, 7 Fed. Cas. No. 3,903.

**Making drawings only** is not diligence. *Watson v. Thomas*, 23 App. Cas. (D. C.) 65.

**Poverty and illness** will not excuse in indefinite delays. *Griffin v. Swenson*, 15 App. Cas. (D. C.) 135.

**Mistake in supposing invention covered by a prior patent** is no excuse for delay. *Platt v. Shipley*, 11 App. Cas. (D. C.) 576.

**Resumption after abandonment.**—An inventor of a complicated device, who attempts to construct a completed machine with his own hands during a period of over a year, and finally abandons the effort from lack of time and money, and immediately makes a model and drawings, is exercising due diligence. *Davis v. Garrett*, 28 App. Cas. (D. C.) 9.

For cases in which the particular facts were held to show diligence see *Howard v. Bones*, 31 App. Cas. (D. C.) 619; *Davis v. Horton*, 31 App. Cas. (D. C.) 601; *Mead v. Davis*, 31 App. Cas. (D. C.) 590; *O'Connell v. Schmidt*, 27 App. Cas. (D. C.) 77; *Roe v. Hanson*, 19 App. Cas. (D. C.) 559; *Christensen v. Ellis*, 17 App. Cas. (D. C.) 498; *Newton v. Woodward*, 17 App. Cas. (D. C.) 34; *Shellabarger v. Sommer*, 8 App. Cas. (D. C.) 3; *McCormick Harvesting Mach. Co. v. Minneapolis Harvester Works*, 42 Fed. 152; *Hubel v. Dick*, 28 Fed. 132; *Appleton v. Chambers*, 1 Fed. Cas. No. 497a; *Mix v. Perkins*, 17 Fed. Cas. No. 9,677; *New England Screw Co. v. Sloan*, 18 Fed. Cas. No. 10,158; *McArthur Pat. Cas.* 210; *Phelps v. Brown*, 19 Fed. Cas. No. 11,072, 4 Blatchf. 362, 1 Fish. Pat. Cas. 479.

For cases in which the particular facts were held to show lack of diligence see *Kinsman v. Kentner*, 31 App. Cas. (D. C.) 293; *Gordon v. Wentworth*, 31 App. Cas. (D. C.) 150; *Bliss v. McElroy*, 29 App. Cas. (D. C.) 120; *Parkes v. Lewis*, 28 App. Cas. (D. C.) 1; *Turnbull v. Curtis*, 27 App. Cas. (D. C.) 567; *Anderson v. Wells*, 27 App. Cas. (D. C.) 115; *Liberman v. Williams*, 23 App. Cas. (D. C.) 223;

*Paul v. Johnson*, 23 App. Cas. (D. C.) 187; *Harris v. Stern*, 22 App. Cas. (D. C.) 164; *Wyman v. Donnelly*, 21 App. Cas. (D. C.) 81; *Hallwood v. Lalor*, 21 App. Cas. (D. C.) 61; *Petrie v. De Schweinitz*, 19 App. Cas. (D. C.) 386; *Stapleton v. Kinney*, 18 App. Cas. (D. C.) 394; *Miehle v. Read*, 18 App. Cas. (D. C.) 128; *Austin v. Johnson*, 18 App. Cas. (D. C.) 83; *Locke v. Boch*, 17 App. Cas. (D. C.) 75; *Darnell v. Grant*, 16 App. Cas. (D. C.) 589; *Jackson v. Getz*, 16 App. Cas. (D. C.) 343; *Jackson v. Knapp*, 16 App. Cas. (D. C.) 338; *Marvel v. Decker*, 13 App. Cas. (D. C.) 562; *Dodge v. Fowler*, 11 App. Cas. (D. C.) 592; *Arnold v. Tyler*, 10 App. Cas. (D. C.) 175; *Porter v. Loudon*, 7 App. Cas. (D. C.) 64; *Wright v. Postel*, 44 Fed. 352; *Pennsylvania Diamond Drill Co. v. Simpson*, 29 Fed. 288; *Johnson v. Root*, 13 Fed. Cas. No. 7,409, 2 Cliff. 108, 2 Fish. Pat. Cas. 291; *Reeves v. Keystone Bridge Co.*, 20 Fed. Cas. No. 11,660, 5 Fish. Pat. Cas. 456, 1 Off. Gaz. 466, 9 Phila. (Pa.) 368; *Savary v. Lauth*, 21 Fed. Cas. No. 12,389, *McArthur Pat. Cas.* 691; *Gallagher v. Hien*, 115 Off. Gaz. 1330; *Paul v. Hess*, 115 Off. Gaz. 251; *Seeberger v. Dodge*, 114 Off. Gaz. 2382.

**35.** *Howell v. Hess*, 30 App. Cas. (D. C.) 194; *Guilbert v. Killinger*, 13 App. Cas. (D. C.) 107; *McCormick v. Cleal*, 12 App. Cas. (D. C.) 355; *Porter v. Loudon*, 7 App. Cas. (D. C.) 64; *Standard Cartridge Co. v. Peters Cartridge Co.*, 77 Fed. 630, 23 C. C. A. 367; *Christie v. Seybold*, 55 Fed. 69, 5 C. C. A. 33; *Uhlman v. Bartholomae*, etc., *Brewing Co.*, 41 Fed. 132; *Reeves v. Keystone Bridge Co.*, 20 Fed. Cas. No. 11,660, 5 Fish. Pat. Cas. 456, 1 Off. Gaz. 466, 9 Phila. (Pa.) 368; *Stillwell*, etc., *Mfg. Co. v. Cincinnati Gas-light*, etc., *Co.*, 23 Fed. Cas. No. 13,453, 1 Ban. & A. 610, 7 Off. Gaz. 829; *Hammond v. Basch*, 115 Off. Gaz. 804.

Small size of machine will not prevent reduction to practice. *Gallagher v. Hien*, 115 Off. Gaz. 1330.

**36.** See *supra*, IV, A, 6.

**37.** *McKelloy v. Fetzner*, 31 App. Cas. (D. C.) 586; *Huebel v. Bernard*, 15 App. Cas. (D. C.) 510; *Agawam Woolen Co. v. Jordan*, 7 Wall. (U. S.) 583, 19 L. ed. 177; *O'Reilly v. Morse*, 15 How. (U. S.) 62, 14 L. ed. 601; *Smith v. Stewart*, 55 Fed. 481 [affirmed in 58 Fed. 580, 7 C. C. A. 380]; *Eclipse Mfg. Co. v. Adkins*, 44 Fed. 280; *Yoder v. Mills*, 25 Fed. 821; *National Feather Duster Co. v. Hibbard*, 9 Fed. 553, 11 Biss. 76; *Blandy v. Griffith*, 3 Fed. Cas. No. 1,529, 3 Fish. Pat. Cas. 609; *Pennock v. Dialogue*, 19 Fed. Cas. No. 10,941, 1 Robb Pat. Cas. 466, 4 Wash. 538 [affirmed in 2 Pet. 1, 7 L. ed. 327];



**9. INVENTION MADE ABROAD.** Acts performed abroad, whether by a citizen of this country or a foreigner, are not pertinent to the question of his right to a patent, since under the statute knowledge or use of the invention abroad is no bar to the grant of a patent to an original inventor who firsts makes or discloses the invention here.<sup>38</sup>

**10. EVIDENCE AS TO ORIGINALITY AND PRIORITY**<sup>39</sup> — **a. Presumptions and Burden of Proof.** The presumption is that the person who obtained the patent was the first and original inventor,<sup>40</sup> and the burden is upon the person seeking to show the contrary to prove it beyond a reasonable doubt.<sup>41</sup>

**b. Admissibility and Sufficiency.** The admissibility of evidence in actions to establish priority between inventors is governed by the rules applicable in civil

Sparkman v. Higgins, 22 Fed. Cas. No. 13,208, 1 Blatchf. 205, Fish. Pat. Rep. 110, 5 N. Y. Leg. Obs. 122; Watson v. Bladen, 29 Fed. Cas. No. 17,277, 1 Robb Pat. Cas. 510, 4 Wash. 580; Allen v. Rawson, 1 C. B. 551, 50 E. C. L. 551; Milligan v. Marsh, 2 Jur. N. S. 1083; Steadman v. Marsh, 2 Jur. N. S. 391. And see *infra*, IV, C, 2.

38. U. S. Rev. St. (1878) § 4923 [U. S. Comp. St. (1901) p. 3396]. And see *supra*, III, B, 5.

Unless in the form of a patent or publication acts abroad are not pertinent. Electric Accumulator Co. v. Brush, 52 Fed. 130, 2 C. C. A. 682.

In Canada a foreign inventor who was first to conceive but who did not make public or use is not entitled to the patent. Reg. v. La Force, 4 Can. Exch. 14.

As against an infringer, date of invention abroad may be shown. Welsbach Light Co. v. American Incandescent Lamp Co., 98 Fed. 613, 39 C. C. A. 185; Hanifen v. Price, 96 Fed. 435 [reversed on other grounds in 102 Fed. 509, 42 C. C. A. 484]; Hanifen v. E. H. Godshalk Co., 78 Fed. 811.

**39. Conclusiveness and effect of decision of patent office** see *infra*, VI, C, 15, d.

40. Lewis v. Cronmeyer, 29 App. Cas. (D. C.) 174; Bader v. Vajen, 14 App. Cas. (D. C.) 241; Dodge v. Fowler, 11 App. Cas. (D. C.) 592; Croskey v. Atterbury, 9 App. Cas. (D. C.) 207; Soley v. Hebbard, 5 App. Cas. (D. C.) 99; Elizabeth v. American Nicholson Pavement Co., 97 U. S. 126, 24 L. ed. 1000; Seymour v. Osborne, 11 Wall. (U. S.) 516, 20 L. ed. 33; Agawam Woolen Co. v. Jordan, 7 Wall. (U. S.) 583, 19 L. ed. 177; Gayler v. Wilder, 10 How. (U. S.) 477, 13 L. ed. 504; Merrimac Mattress Mfg. Co. v. Feldman, 133 Fed. 64; Standard Cartridge Co. v. Peters Cartridge Co., 77 Fed. 630, 23 C. C. A. 367 [affirming 69 Fed. 408]; Front Rank Furnace Co. v. Wrought Iron Range Co., 63 Fed. 995; Green v. French, 11 Fed. 591; Albright v. Celluloid Harness Trimming Co., 1 Fed. Cas. No. 147, 2 Ban. & A. 629, 12 Off. Gaz. 227; Carter v. Carter, 5 Fed. Cas. No. 2,475, McArthur Pat. Cas. 388; Cook v. Ernest, 6 Fed. Cas. No. 3,155, 5 Fish. Pat. Cas. 396, 1 Woods 195, 2 Off. Gaz. 89; Crouch v. Speer, 6 Fed. Cas. No. 3,438, 1 Ban. & A. 145, 6 Off. Gaz. 187; Foote v. Silsby, 9 Fed. Cas. No. 4,916, 1 Blatchf. 445, Fish. Pat. Rep. 268 [affirmed in 14 How. 218, 14 L. ed. 394]; Goodyear v. Day, 10 Fed. Cas. No. 5,569, 2

Wall. Jr. 283; Hoffheins v. Brandt, 12 Fed. Cas. No. 6,575, 3 Fish. Pat. Cas. 218; Howes v. Nute, 12 Fed. Cas. No. 6,790, 4 Cliff. 173, 4 Fish. Pat. Cas. 263; Matthews v. Skates, 16 Fed. Cas. No. 9,291, 1 Fish. Pat. Cas. 602; Putnam v. Yerrington, 20 Fed. Cas. No. 11,486, 2 Ban. & A. 237, 9 Off. Gaz. 689; Reed v. Cutter, 20 Fed. Cas. No. 11,645, 2 Robb Pat. Cas. 81, 1 Story 590; Reeves v. Keystone Bridge Co., 20 Fed. Cas. No. 11,660, 5 Fish. Pat. Cas. 456, 1 Off. Gaz. 466, 9 Phila. (Pa.) 368; Sickels v. Borden, 22 Fed. Cas. No. 12,832, 3 Blatchf. 535; Washburn v. Gould, 29 Fed. Cas. No. 17,214, 2 Robb Pat. Cas. 206, 3 Story 122; Winans v. New York, etc., R. Co., 30 Fed. Cas. No. 17,864, 4 Fish. Pat. Cas. 1.

To what time presumption extends.—The presumption of originality arising from the grant of a patent only extends back to the time when the application was filed in the patent office. Johnson v. Root, 13 Fed. Cas. No. 7,409, 2 Cliff. 108, 2 Fish. Pat. Cas. 291; Johnson v. Root, 13 Fed. Cas. No. 7,410, 2 Cliff. 637; Jones v. Sewall, 13 Fed. Cas. No. 7,495, 3 Cliff. 563, 6 Fish. Pat. Cas. 343, 3 Off. Gaz. 630 [reversed on other grounds in 91 U. S. 171, 23 L. ed. 275]; Union Sugar Refinery v. Matthiesson, 24 Fed. Cas. No. 14,399, 3 Cliff. 639, 2 Fish. Pat. Cas. 600; Webster Loom Co. v. Higgins, 29 Fed. Cas. No. 17,342, 4 Ban. & A. 88, 15 Blatchf. 446, 16 Off. Gaz. 675; White v. Allen, 29 Fed. Cas. No. 17,535, 2 Cliff. 224, 2 Fish. Pat. Cas. 440; Wing v. Richardson, 30 Fed. Cas. No. 17,869, 2 Cliff. 449, 2 Fish. Pat. Cas. 535.

41. Gibbons v. Peller, 28 App. Cas. (D. C.) 530; Larkin v. Richardson, 28 App. Cas. (D. C.) 471; Washburn, etc., Mfg. Co. v. Beat 'Em All Barbed-Wire Co., 143 U. S. 275, 12 S. Ct. 443, 36 L. ed. 154; Hall Signal Co. v. Union Switch, etc., Co., 115 Fed. 638; Cohansey Glass Mfg. Co. v. Wharton, 28 Fed. 189; Donoughe v. Hubbard, 27 Fed. 712; Duffy v. Reynolds, 24 Fed. 855; Rogers v. Beecher, 3 Fed. 639; Campbell v. James, 4 Fed. Cas. No. 2,361, 4 Ban. & A. 456, 17 Blatchf. 42, 8 Reporter 455, 18 Off. Gaz. 979; Cox v. Griggs, 6 Fed. Cas. No. 3,302, 1 Biss. 362, 2 Fish. Pat. Cas. 174; Fisk v. Church, 9 Fed. Cas. No. 4,826, 5 Fish. Pat. Cas. 540, 1 Off. Gaz. 634; Hawes v. Antisdell, 11 Fed. Cas. No. 6,234, 2 Ban. & A. 10, 8 Off. Gaz. 685; Konold v. Klein, 14 Fed. Cas. No. 7,925, 3 Ban. & A. 226, 5 Reporter 427.



actions generally.<sup>42</sup> The weight and sufficiency of the evidence in actions to establish priority between inventors is governed by the rules applicable in civil cases generally.<sup>43</sup>

**B. Joint Inventors — 1. IN GENERAL.** Two or more parties may by mutual contributions or suggestions so aid in developing the idea of each as to produce an invention which must be regarded as the result of the joint mental efforts of both, and not as the separate invention of either, and in such case they must apply for and receive the patent jointly.<sup>44</sup>

**2. JOINDER IN GRANT.** A patent issued to two parties as joint inventors is invalid where it appears that one of them is the sole inventor,<sup>45</sup> or where different

42. See, generally, EVIDENCE.

Verbal declarations of a person that he has made an invention, coupled with a description of the nature and objects of the invention, are a part of the *res gestæ*, and admissible to prove priority of invention (Philadelphia, etc., R. Co. v. Stimpson, 14 Pet. (U. S.) 448, 10 L. ed. 535; Gibbs v. Johnson, 10 Fed. Cas. No. 5,384; Stephens v. Salisbury, 22 Fed. Cas. No. 13,369, McArthur Pat. Cas. 379) and such verbal descriptions, without drawing or model, are admissible for the purpose of proving priority of invention, when the invention is of great simplicity and the time is not so long as to make the recollection improbable (Stephens v. Salisbury, *supra*). But it seems that conversations and declarations by one of the parties describing a device by which he has already constructed a model is inadmissible, if such model is not produced or its non-production accounted for (Richardson v. Hicks, 20 Fed. Cas. No. 11,783, McArthur Pat. Cas. 335); and it has been held error to allow a witness testifying to such conversations and declarations to testify that a model shown to him and not claimed to be the one that the inventor had then constructed corresponds to the description given, and that he could have made it from such description (Richardson v. Hicks, *supra*).

A certificate of a commissioner of patents of the correctness of a copy or translation from a French volume in the patent office is inadmissible to prove the existence of an invention prior to plaintiff's patent, as the book itself, or a duly proved translation, is the only way its contents can be shown. Gaylord v. Case, 5 Ohio Dec. (Reprint) 413, 4 Am. L. Rec. 494.

43. See, generally, EVIDENCE.

Evidence held sufficient see National Co. v. Belcher, 71 Fed. 876, 18 C. C. A. 375; Uhlman v. Arnholdt, etc., Brewing Co., 53 Fed. 485; Bliss v. Merrill, 33 Fed. 39; Atkinson v. Boardman, 2 Fed. Cas. No. 608, Cranch Pat. Dec. 139, McArthur Pat. Cas. 80; Babcock v. Degener, 2 Fed. Cas. No. 698, McArthur Pat. Cas. 607; Collins v. White, 6 Fed. Cas. No. 3,019; Jillson v. Winsor, 13 Fed. Cas. No. 7,321, McArthur Pat. Cas. 136; Sherwood v. Sherman, 21 Fed. Cas. No. 12,780.

Evidence held insufficient see Gibbons v. Pellar, 23 App. Cas. (D. C.) 530; Shuman v. Beall, 27 App. Cas. (D. C.) 324; Henry v. Doble, 27 App. Cas. (D. C.) 33; Gillette v. Sendelbach, 146 Fed. 758, 77 C. C. A. 55; Ashe v. Mutual Lasting Co., 42 Fed. 840;

Lamson Cash R. Co. v. Osgood Cash Car Co., 29 Fed. 210; Hutchinson v. Everett, 26 Fed. 531; Beach v. Tucker, 2 Fed. Cas. No. 1,153; Carter v. Carter, 5 Fed. Cas. No. 2,475, McArthur Pat. Cas. 388; Clarke v. Cramer, 5 Fed. Cas. No. 2,848, McArthur Pat. Cas. 473; Cornell v. Hyatt, 6 Fed. Cas. No. 3,237, McArthur Pat. Cas. 423; Warner v. Goodyear, 29 Fed. Cas. No. 17,183, Cranch Pat. Dec. 125, McArthur Pat. Cas. 60.

On testimony which is vague and wanting in precision in respect to the essential features of the device for which priority is claimed, priority of invention will not be adjudged. Cornell v. Hyatt, 6 Fed. Cas. No. 3,237, McArthur Pat. Cas. 423.

**Acknowledgment or admission of priority.** — On a question of priority between two inventors, the fact that one of them participated in the application of the other would seem to constitute a conclusive acknowledgment of priority. National Co. v. Belcher, 71 Fed. 876, 18 C. C. A. 375. But the fact that one who claims to be the first and original inventor of a device has taken into partnership with himself the assignees of another, who also claim to be the original inventor, instead of litigating with them the question of priority, is not to be regarded as an admission by the former patentee of the validity of the patent claimed by the latter, if the arrangement was induced either directly or indirectly by fraud or misrepresentation. Sloat v. Spring, 22 Fed. Cas. No. 12,948a.

44. Consolidated Bunting Apparatus Co. v. Woerle, 29 Fed. 449; Worden v. Fisher, 11 Fed. 505; Gottfried v. Phillip Best Brewing Co., 10 Fed. Cas. No. 5,633, 5 Ban. & A. 4, 17 Off. Gaz. 675.

Where each has invented a distinct improvement on the same machine, the object sought to be attained being a unit, a joint patent may be issued. Wilson v. Singer, 30 Fed. Cas. No. 17,835.

Mutual suggestions and improvements are sufficient to constitute a joint invention. Worden v. Fisher, 11 Fed. 505.

Filing a sale caveat is no estoppel to secure joint patent. Hoe v. Kahler, 25 Fed. 271, 23 Blatchf. 354, 12 Fed. 111, 20 Blatchf. 430.

When a claim covers a series of steps or a number of elements in a combination, the invention may well be joint, although some of the steps or some of the elements may have come as the thought of one. Quincey Min. Co. v. Krause, 151 Fed. 1012, 81 C. C. A. 290.

45. Bannerman v. Sanford, 99 Fed. 294, 39



improvements on the same machine were invented by each separately without the participation or knowledge of the other,<sup>46</sup> and a patent issued to a party as sole inventor is invalid where it appears that he made the invention jointly with another.<sup>47</sup> One of two joint inventors cannot make application and secure the patent upon assignment from the other. Both must join.<sup>48</sup> In an action for the infringement of a patent, the burden of showing as a defense that the patentee was a joint inventor with some other person, of the thing invented, is upon the patentee.<sup>49</sup> The issuance of a patent to two persons as joint inventors constitutes *prima facie* proof that the invention was joint.<sup>50</sup> And to invalidate a patent granted to two jointly the evidence must be clear and convincing.<sup>51</sup>

**C. Employer and Employee**<sup>52</sup>—1. **IN GENERAL.** The statutes of the United States require that the patent issue upon the application of and in the name of the real inventor, although he was employed and paid to make it for the benefit of the one employing him.<sup>53</sup> In such case the employer may be entitled to the ownership of the patent and may compel its transfer by assignment, but this depends upon the nature of the agreement between them.<sup>54</sup> A company that employs a skilled workman to make improvements on its machinery is not entitled to a conveyance of the patents secured by the workman on improvements so made in the absence of agreement to that effect.<sup>55</sup> An employee, performing all the duties assigned to him in his department of service, may exercise his inventive faculties in any direction he chooses, with the assurance that whatever

C. C. A. 534; *Stewart v. Tenk*, 32 Fed. 665; *Welsbach Light Co. v. Cosmopolitan Incandescent Gaslight Co.*, 100 Fed. 648; *Royer v. Coupe*, 29 Fed. 358; *Hotchkiss v. Greenwood*, 12 Fed. Cas. No. 6,718, 4 McLean 456, 2 Robb Pat. Cas. 730 [affirmed in 11 How. 248, 13 L. ed. 683]; *Ransom v. New York*, 20 Fed. Cas. No. 11,573, 1 Fish. Pat. Cas. 252; Act (1885), § 5, 48 & 49 Vict. c. 63.

46. *De Laval Separator Co. v. Vermont Farm Mach. Co.*, 126 Fed. 536 [affirmed in 135 Fed. 772, 68 C. C. A. 474].

47. *Arnold v. Bishop*, 1 Fed. Cas. Nos. 552, 553, *McArthur Pat. Cas.* 27, 36; *Thomas v. Weeks*, 23 Fed. Cas. No. 13,914, *Fish. Pat. Rep.* 5, 2 Paine 92.

Evidence held insufficient to show joint invention see *Ashcroft v. Cutter*, 2 Fed. Cas. No. 578, 6 Blatchf. 511.

48. 2 Op. Atty.-Gen. 571.

49. *Ashcroft v. Cutter*, 2 Fed. Cas. No. 578, 6 Blatchf. 511.

50. *Page Woven Wire Fence Co. v. Land*, 49 Fed. 936.

51. *Page Woven Wire Fence Co. v. Land*, 49 Fed. 936; *Schlicht, etc., Co. v. Chicago, Sewing-Mach. Co.*, 36 Fed. 585; *Consolidated Bunting Apparatus Co. v. Woerle*, 29 Fed. 449; *Gottfried v. Phillip Best Brewing Co.*, 10 Fed. Cas. No. 5,633, 5 Ban. & A. 4, 17 Off. Gaz. 675.

Testimony of one of joint patentees insufficient to invalidate patent. *Priestly v. Montague*, 47 Fed. 650.

52. See MASTER AND SERVANT, 26 Cyc. 1021.

53. U. S. Rev. St. (1878) § 4895 [U. S. Comp. St. (1901) p. 3385]; *Tyler v. Kelch*, 19 App. Cas. (D. C.) 180; *Hunt v. McCaslin*, 10 App. Cas. (D. C.) 527, 79 Off. Gaz. 861; *Green v. Willard Improved Barrel Co.*, 1 Mo. App. 202; *Damon v. Eastwick*, 14 Fed. 40.

In England, where a servant or employee

makes an invention the patent is granted to him. *Ex p. Scott*, L. R. 6 Ch. 274, 19 Wkly. Rep. 425; *Bloxam v. Elsee*, 6 B. & C. 169, 13 E. C. L. 88, 1 C. & P. 558, 12 E. C. L. 320, 9 D. & R. 215, 5 L. J. K. B. O. S. 104, R. & M. 187, 30 Rev. Rep. 275; *Matter of Russell*, 2 De G. & J. 130, 6 Wkly. Rep. 95, 59 Eng. Ch. 104, 45 Eng. Reprint 937.

54. *Hunt v. McCaslin*, 10 App. Cas. (D. C.) 527.

Circumstances showing title in employer see *Baldwin v. Von Micheroux*, 83 Hun (N. Y.) 43, 31 N. Y. Suppl. 696 [affirming 5 Misc. 386, 25 N. Y. Suppl. 857]; *Annin v. Wren*, 44 Hun (N. Y.) 352; *Bonsack Mach. Co. v. Hulse*, 57 Fed. 519 [affirmed in 65 Fed. 864, 13 C. C. A. 180].

Insufficient proof of agreement.—*Dalzell v. Dueber Watch-Case Mfg. Co.*, 149 U. S. 315, 13 S. Ct. 886, 37 L. ed. 749 [reversing 38 Fed. 597].

Securing patent at expense of company by employee will not give company title. *Deane v. Hodge*, 35 Minn. 146, 27 N. W. 917, 59 Am. Rep. 321.

55. *Sendelbach v. Gillette*, 22 App. Cas. (D. C.) 168; *Burr v. De la Vergne*, 102 N. Y. 415, 7 N. E. 366; *Burden v. Burden Iron Co.*, 39 Misc. (N. Y.) 559, 80 N. Y. Suppl. 390; *Gill v. U. S.*, 160 U. S. 426, 16 S. Ct. 322, 40 L. ed. 480; *Dalzell v. Dueber Watch-Case Mfg. Co.*, 149 U. S. 315, 13 S. Ct. 886, 37 L. ed. 749; *Hapgood v. Hewitt*, 119 U. S. 226, 7 S. Ct. 193, 30 L. ed. 369; *Barber v. National Carbon Co.*, 129 Fed. 370, 64 C. C. A. 40, 5 L. R. A. N. S. 1154; *Pressed Steel Car Co. v. Hansen*, 128 Fed. 444 [affirmed in 137 Fed. 403, 71 C. C. A. 207, 2 L. R. A. N. S. 1172]; *Taylor v. Wood*, 23 Fed. Cas. No. 13,808, 1 Ban. & A. 270, 12 Blatchf. 110, 8 Off. Gaz. 90; *Whiting v. Graves*, 29 Fed. Cas. No. 17,577, 3 Ban. & A. 222, 13 Off. Gaz. 455. And see *infra*, IV, D.



invention he may thus conceive and perfect is his individual property.<sup>56</sup> The company, however, has an implied license to make, use, and sell the invention.<sup>57</sup>

**2. PERFECTION OF EMPLOYER'S IDEAS.** Where the employer has a preconceived plan of an invention, and while engaged in experiments to perfect it the employee makes suggestions ancillary to the plan and preconceived ideas of the employer, the invention as a whole including the improvements is to be regarded as the invention of the employer.<sup>58</sup> It is otherwise, however, if the suggestions of the employee amount to a new method or arrangement which is in itself a complete invention. To enable the employer to claim the invention he must have, not merely the idea of the end or result to be accomplished, but a definite idea of the means which the employee amplifies or improves in details.<sup>59</sup>

**3. PRESUMPTIONS AS TO INVENTORSHIP.** Where a party employs another to assist in giving practical effect to his ideas, the presumption is that the employer is the inventor of the thing produced by their joint effort, and the burden is upon the employee to show clearly that he made the invention.<sup>60</sup> On the other hand where a party is employed to exercise his inventive skill because of his supposed ability as an inventor, the presumption is in favor of the employee.<sup>61</sup>

**D. Government Employees.** Government employees in general may secure patents upon inventions made by them during their employment and are entitled to own the patents upon the same conditions as other employees.<sup>62</sup> The government may have an implied license to use the invention, but has no title to the patent except by express agreement.<sup>63</sup> Employees of the patent office cannot receive or own a patent except by inheritance or bequest;<sup>64</sup> but after their employment ceases they may secure a patent upon an invention made during their employment.<sup>65</sup>

**Agreement not against public policy.**—An agreement by an employee to assign an interest in all inventions made by him to the employer, in consideration of the employment, is not against public policy. *Wright v. Vocalion Organ Co.*, 148 Fed. 209, 78 C. C. A. 183.

**Construction of contract for interest in future inventions** see *Wright v. Vocalion Organ Co.*, 148 Fed. 209, 78 C. C. A. 183.

**Improvements made after expiration of agreement** do not belong to employer. *Appleton v. Bacon*, 2 Black (U. S.) 699, 17 L. ed. 338.

56. *Solomons v. U. S.*, 137 U. S. 342, 11 S. Ct. 88, 34 L. ed. 667.

57. *Gill v. U. S.*, 160 U. S. 426, 16 S. Ct. 322, 40 L. ed. 480; *Keyes v. Eureka Consol. Min. Co.*, 158 U. S. 150, 15 S. Ct. 772, 39 L. ed. 929; *Lane, etc., Co. v. Locke*, 150 U. S. 193, 14 S. Ct. 78, 37 L. ed. 1049; *Solomons v. U. S.*, 137 U. S. 342, 11 S. Ct. 88, 34 L. ed. 667; *Hapgood v. Hewitt*, 119 U. S. 226, 7 S. Ct. 193, 30 L. ed. 369; *Blauvelt v. Interior Conduit, etc., Co.*, 80 Fed. 906, 26 C. C. A. 243; *Whiting v. Graves*, 29 Fed. Cas. No. 17,577, 3 Ban. & A. 222, 13 Off. Gaz. 455. And see *Bonathan v. Bowmanville Furniture Mfg. Co.*, 31 U. C. Q. B. 413.

58. *McKelloy v. Fetzner*, 31 App. Cas. (D. C.) 586; *Larkin v. Richardson*, 28 App. Cas. (D. C.) 471; *Kreag v. Green*, 28 App. Cas. (D. C.) 437; *Oreutt v. McDonald*, 27 App. Cas. (D. C.) 228; *Gallagher v. Hastings*, 21 App. Cas. (D. C.) 88; *Gedge v. Cromwell*, 19 App. Cas. (D. C.) 192; *Hunt v. McCaslin*, 10 App. Cas. (D. C.) 527; *Milton v. Kingsley*, 7 App. Cas. (D. C.) 531; *Agawam Woolen*

*Co. v. Jordan*, 7 Wall. (U. S.) 583, 19 L. ed. 177; *Dental Vulcanite Co. v. Wetherbee*, 7 Fed. Cas. No. 3,810, 2 Cliff. 555, 3 Fish. Pat. Cas. 87; *Goodyear v. Day*, 10 Fed. Cas. No. 5,566; *King v. Gedney*, 14 Fed. Cas. No. 7,795, *McArthur Pat. Cas.* 443; *Wellman v. Blood*, 29 Fed. Cas. No. 17,385, *McArthur Pat. Cas.* 432; *Huebel v. Bernard*, 90 Off. Gaz. 751.

**Lack of mechanical skill and employment of another to construct a machine** does not forfeit the right to an invention. *United Shirt, etc., Co. v. Beattie*, 149 Fed. 736, 79 C. C. A. 442 [*affirming* 138 Fed. 136].

59. *Sendelbach v. Gillette*, 22 App. Cas. (D. C.) 168; *Streat v. Simpson*, 53 Fed. 358.

60. *Whitney v. Howard*, 21 App. Cas. (D. C.) 218; *Flather v. Weber*, 21 App. Cas. (D. C.) 179; *Gallagher v. Hastings*, 21 App. Cas. (D. C.) 88; *Slaughter v. Halle*, 21 App. Cas. (D. C.) 19; *Gedge v. Cromwell*, 19 App. Cas. (D. C.) 192; *Miller v. Kelly*, 18 App. Cas. (D. C.) 163; *Milton v. Kingsley*, 7 App. Cas. (D. C.) 531; *Goodyear v. Day*, 10 Fed. Cas. No. 5,566; *Thibodeau v. Hildreth*, 117 Off. Gaz. 601; *Corsy v. McDermott*, 117 Off. Gaz. 279.

61. See *supra*, IV, C, 1.

62. *Gill v. U. S.*, 160 U. S. 426, 16 S. Ct. 322, 40 L. ed. 480; *Solomons v. U. S.*, 137 U. S. 342, 11 S. Ct. 88, 34 L. ed. 667.

63. *Gill v. U. S.*, 160 U. S. 426; *McAleer v. U. S.*, 150 U. S. 424, 14 S. Ct. 160, 37 L. ed. 1130; *Solomons v. U. S.*, 137 U. S. 342.

64. U. S. Rev. St. (1878) § 480 [U. S. Comp. St. (1901) p. 271].

65. *Page v. Holmes Burglar Alarm Tel. Co.*, 1 Fed. 304, 17 Blatchf. 485; *Foot v.*



**E. Assignees.** Patents may be issued and reissued to assignees upon applications made by the inventors.<sup>66</sup> It is not necessary, however, for the patent to issue in the name of the assignee in order that he shall acquire title, since it vests in him by operation of law when the instrument of transfer is made.<sup>67</sup> Assignees as well as inventors may transfer title to patents owned by them since the right of transfer is unlimited.<sup>68</sup>

**F. Personal Representatives.** Upon the death of the inventor before issue of patent, the right of applying for and obtaining the patent devolves upon the executor or administrator.<sup>69</sup> The personal representatives take the patent with other property in trust for the heirs.<sup>70</sup> A foreign executor or administrator may apply for and receive the patent, but his authority must be proved by a certificate of a diplomatic or consular officer of the United States.<sup>71</sup>

**G. Heirs.** If after applying for a patent the inventor dies and the patent issues in his name after his death, it goes by operation of law to the heirs.<sup>72</sup>

**H. Guardian of Insane Person.** Where an inventor becomes insane before securing a patent, his legally appointed guardian, conservator, or representative may apply for and obtain the patent in trust for him.<sup>73</sup>

## V. APPLICATION AND PROCEEDINGS THEREON.<sup>74</sup>

**A. In General.** The application for a patent must be made to the commissioner of patents,<sup>75</sup> and the statutory requirements must be complied with in making application and in the proceedings thereon or the patent is void.<sup>76</sup> The proceedings upon applications are governed by rules adopted by the commissioner of patents with the approval of the secretary of the interior under section 483 of the Revised Statutes.

**B. Requisites of Application — 1. IN GENERAL.** An application for patent in the United States comprises a petition, specification, claims, oath, fee of fifteen dollars, drawings if the nature of the inventions admits of illustration, and a model if required by the patent office.<sup>77</sup> Models are seldom required and are

Frost, 9 Fed. Cas. No. 4,910, 3 Ban. & A. 607, 14 Off. Gaz. 860.

66. U. S. Rev. St. (1878) § 4895 [U. S. Comp. St. (1901) p. 3385]; *Hendrie v. Sayles*, 98 U. S. 546, 25 L. ed. 176.

Copartnership may issue to copartnership as assignee. *Wright v. Randel*, 8 Fed. 591, 19 Blatchf. 495; *Harrison v. Morton*, 76 Off. Gaz. 1275.

67. *Gayler v. Wilder*, 10 How. (U. S.) 477, 13 L. ed. 504; *Consolidated Electric Light Co. v. McKeesport Light Co.*, 34 Fed. 335; *Consolidated Electric Light Co. v. Edison Electric Light Co.*, 25 Fed. 719, 23 Blatchf. 412.

Record in the patent office is delivery of possession. *Waterman v. MacKenzie*, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923.

68. U. S. Rev. St. (1878) § 4398 [U. S. Comp. St. (1901) p. 3002]; *Selden v. Stockwell Self-Lighting Gas-Burner Co.*, 9 Fed. 390, 19 Blatchf. 544.

69. U. S. Rev. St. (1878) § 4896; *De la Vergne Refrigerating Mach. Co. v. Featherstone*, 147 U. S. 209, 13 S. Ct. 283, 37 L. ed. 138; *Eagleton Mfg. Co. v. West Bradley, etc.*, Mfg. Co., 111 U. S. 490, 4 S. Ct. 593, 28 L. ed. 493; *Stimpson v. Rogers*, 23 Fed. Cas. No. 13,457, 4 Blatchf. 333.

In England the executor or administrator must apply for patent within six months. Act (1883), § 34, 46 & 47 Vict. c. 57.

70. *Providence Rubber Co. v. Goodyear*, 9

Wall. (U. S.) 788, 19 L. ed. 566; *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 18 Fed. Cas. No. 10,337, 1 Ban. & A. 177, 10 Phila. (Pa.) 227, 6 Off. Gaz. 34.

71. U. S. Rev. St. (1878) § 4896, as amended March 3, 1903, 32 U. S. St. at L. 1227.

72. *De la Vergne Refrigerating Mach. Co. v. Featherstone*, 147 U. S. 209, 13 S. Ct. 283, 37 L. ed. 138.

73. The above is embodied in the act of Feb. 26, 1899, c. 227, 30 U. S. St. at L. 915 [U. S. Comp. St. (1901) p. 3386], but through obvious clerical error does not appear in U. S. Rev. St. (1878) § 4896, as rewritten in the act of March 3, 1903, c. 1019, § 3, 32 U. S. St. at L. 1226 [U. S. Comp. St. Suppl. (1905) p. 665].

Patent to guardian is valid.—*Whitcomb v. Spring Valley Coal Co.*, 47 Fed. 652.

74. Application for extension of patent see *infra*, VII, B.

Application for reissue see *infra*, VIII, E.

75. U. S. Rev. St. (1878) § 4888 [U. S. Comp. St. (1901) p. 3383].

76. *Kennedy v. Hazelton*, 128 U. S. 667, 9 S. Ct. 202, 32 L. ed. 576; *Roemer v. Simon*, 95 U. S. 214, 24 L. ed. 384. And see *supra*, I, A, 4.

77. U. S. Rev. St. (1878) §§ 4888, 4889, 4891, 4892, 4934 [U. S. Comp. St. (1901) pp. 3383, 3384, 3400].



never necessary as a prerequisite to the entry of the application as complete.<sup>78</sup> All parts save the model must be filed in the patent office before the application will be given a filing date.<sup>79</sup> The application must be signed by the inventor if alive and two witnesses.<sup>80</sup> Copies of the specification, claims, and drawings are attached to the patent and form a part thereof.<sup>81</sup>

**2. SPECIFICATION OR DESCRIPTION—**a. **In General.** The word "specification," when used separately from the word "claim," as used in the statute, means the written description of the invention and of the manner and process of making, constructing, compounding, and using it and the claims made.<sup>82</sup> While it is said that courts are reluctant to declare patents void for insufficient description,<sup>83</sup> the applicant must nevertheless describe not merely the principle of his invention, but the best mode in which he contemplates applying the principle and must describe the means to be employed in such full, clear, and exact terms as will enable those skilled in the art without other aid to make and use the invention.<sup>84</sup> If this is not done the patent is void.<sup>85</sup> It has been decided that nothing should be left to

**78. Pract. Rule 56.**

A model is no part of patent. *Barry v. Guenheim*, 2 Fed. Cas. No. 1,061, 5 Fish. Pat. Cas. 452, 1 Off. Gaz. 382.

**Necessity for specimens.**—The patent office determines whether specimens are necessary. *Badische Anilin, etc., Fabrik v. Cochrane*, 2 Fed. Cas. No. 719, 4 Ban. & A. 215, 16 Blatchf. 155 [reversed on other grounds in 111 U. S. 293, 4 S. Ct. 45, 28 L. ed. 433].

**79. Pract. Rule 31.**

**80. U. S. Rev. St. (1878) § 4888** [U. S. Comp. St. (1901) p. 3383].

**81. U. S. Rev. St. (1878) § 4889** [U. S. Comp. St. (1901) p. 3383].

**82. *Wilson v. Coon***, 6 Fed. 611, 18 Blatchf. 332.

**83. *Adams v. Joliet Mfg. Co.***, 1 Fed. Cas. No. 56, 3 Ban. & A. 1, 12 Off. Gaz. 93; *Swift v. Whisen*, 23 Fed. Cas. No. 13,700, 2 Bond 115, 3 Fish. Pat. Cas. 343.

**84. U. S. Rev. St. (1878) § 4888** [U. S. Comp. St. (1901) p. 3383]; *Parks v. Booth*, 102 U. S. 96, 26 L. ed. 54; *Gill v. Wells*, 22 Wall. (U. S.) 1, 22 L. ed. 699; *Grier v. Castle*, 17 Fed. 523; *Allen v. Hunter*, 1 Fed. Cas. No. 225, 6 McLean 303; *Burr v. Cowperthwait*, 4 Fed. Cas. No. 2,188, 4 Blatchf. 163; *Forbes v. Barstow Stove Co.*, 9 Fed. Cas. No. 4,923, 2 Cliff. 379; *Judson v. Moore*, 14 Fed. Cas. No. 7,569, 1 Bond 285, 1 Fish. Pat. Cas. 544; *Mabie v. Haskell*, 15 Fed. Cas. No. 8,653, 2 Cliff. 507; *Page v. Ferry*, 18 Fed. Cas. No. 10,662, 1 Fish. Pat. Cas. 298; *Sullivan v. Redfield*, 23 Fed. Cas. No. 13,597, *Pivane* 441, 1 Robb Pat. Cas. 477; *Swift v. Whisen*, 23 Fed. Cas. No. 13,700, 2 Bond 115, 3 Fish. Pat. Cas. 343; *Teese v. Phelps*, 23 Fed. Cas. No. 13,819, *McAllister* 48; *Tucker v. Tucker Mfg. Co.*, 24 Fed. Cas. No. 14,227, 2 Ban. & A. 401, 4 Cliff. 397, 10 Off. Gaz. 464; *Vogler v. Semple*, 28 Fed. Cas. No. 16,987, 2 Ban. & A. 556, 7 Biss. 382, 11 Off. Gaz. 923; *Wayne v. Holmes*, 29 Fed. Cas. No. 17,303, 1 Bond 27, 2 Fish. Pat. Cas. 20; *Whitney v. Emmett*, 29 Fed. Cas. No. 17,585, *Baldw.* 303, 1 Robb Pat. Cas. 567; *Whitney v. Mowry*, 29 Fed. Cas. No. 17,592, 2 Bond 45, 3 Fish. Pat. Cas. 157; *Wintermute v. Redington*, 30 Fed. Cas. No. 17,896, 1 Fish. Pat. Cas. 239; *Wyeth v. Stone*,

30 Fed. Cas. No. 18,107, 2 Robb Pat. Cas. 23, 1 Story 273.

**Reasons for rule.**—Exactitude in the description of an invention is required in order that the government may know what they have granted, and what will become public property when the patent expires; that licensees may know how to use and practice the invention during the term of the patent; and that subsequent inventors may know what portion of the field of an invention is unoccupied. *Judson v. Moore*, 14 Fed. Cas. No. 7,569, 1 Bond 285, 1 Fish. Pat. Cas. 544; *Tucker v. Tucker Mfg. Co.*, 24 Fed. Cas. No. 14,227, 2 Ban. & A. 401, 4 Cliff. 397, 10 Off. Gaz. 464; *Wayne v. Holmes*, 29 Fed. Cas. No. 17,303, 1 Bond 27, 2 Fish. Pat. Cas. 20.

**Construction of phrase "mounted on"** see *In re Duncan*, 28 App. Cas. (D. C.) 457.

In England provisional specification need describe the invention only roughly and not in detail. *Murray v. Clayton*, L. R. 7 Ch. 570, 20 Wkly. Rep. 649; *Stoner v. Todd*, 4 Ch. D. 58, 46 L. J. Ch. 32, 35 L. T. Rep. N. S. 661, 25 Wkly. Rep. 38; *Daw v. Eley*, L. R. 3 Eq. 496, 36 L. J. Ch. 482, 15 L. T. Rep. N. S. 559; *In re Newall*, 4 C. B. N. S. 269, 4 Jur. N. S. 562, 27 L. J. C. P. 357, 93 E. C. L. 269; *Pneumatic Tyre Co. v. East London Rubber Co.*, 75 L. T. Rep. N. S. 488. When provisional specification is allowed by the law officer of the crown it cannot be impeached as insufficient. *Penn v. Bibby*, L. R. 2 Ch. 127, 36 L. J. Ch. 455, 15 L. T. Rep. N. S. 399, 15 Wkly. Rep. 208.

**85. *Ames v. Howard***, 1 Fed. Cas. No. 326, 1 Robb Pat. Cas. 689, 1 Sumn. 482; *Emerson v. Hogg*, 8 Fed. Cas. No. 4,440, 2 Blatchf. 1, Fish. Pat. Rep. 77; *Evans v. Hettick*, 8 Fed. Cas. No. 4,562, 1 Robb Pat. Cas. 166, 3 Wash. 408 [affirmed in 7 Wheat. 453, 5 L. ed. 496]; *Lippincott v. Kelly*, 15 Fed. Cas. No. 8,381; *Lowell v. Lewis*, 15 Fed. Cas. No. 8,568, 1 Mason 182, 1 Robb Pat. Cas. 131; *Parker v. Stiles*, 18 Fed. Cas. No. 10,749, Fish. Pat. Rep. 319, 5 McLean 44.

**For descriptions held insufficient** see *Miller v. Mawhinney Last Co.*, 105 Fed. 523, 44 C. C. A. 581; *Davis v. Parkman*, 71 Fed. 961, 18 C. C. A. 398; *Schneider v. Thill*, 21 Fed. Cas. No. 12,470a, 5 Ban. & A. 565; *Sullivan v.*



experiment.<sup>86</sup> A specification is sufficient, if a mechanic skilled in the art can from the descriptions and drawings make and use the invention;<sup>87</sup> and sufficiency is to be determined by knowledge possessed at the time of the grant.<sup>88</sup> By "skilled in the art" is meant those of ordinary skill and not the very expert.<sup>89</sup> Whether the description is so full, clear, and exact as to enable any one skilled in the art to make and use it is a question for the jury to determine<sup>90</sup> upon the evidence of persons skilled in the art to which the patent appertains.<sup>91</sup>

**b. Matters of Common Knowledge.** It is not necessary to describe matters of common knowledge which those skilled in the art would understand without description.<sup>92</sup>

**c. Uses of Invention.** It is not necessary to describe all uses to which the invention may be put, but it is necessary to describe some intended use.<sup>93</sup> The inventor is entitled to all uses of his invention whether he foresaw them or not.<sup>94</sup>

Redfield, 23 Fed. Cas. No. 13,597, 1 Paine 441, 1 Robb Pat. Cas. 477; Webster Loom Co. v. Higgins, 29 Fed. Cas. No. 17,342, 4 Ban. & A. 88, 15 Blatchf. 446, 16 Off. Gaz. 675.

For cases in which allegations of insufficiency of description were overruled see *Seabury v. Am Ende*, 152 U. S. 561, 14 S. Ct. 683, 38 L. ed. 553; *Lawther v. Hamilton*, 124 U. S. 1, 8 S. Ct. 342, 31 L. ed. 325; *Consolidated Safety-Valve Co. v. Crosby Steam Gauge, etc., Co.*, 113 U. S. 157, 5 S. Ct. 513, 28 L. ed. 939; *Mowry v. Whitney*, 14 Wall. (U. S.) 620, 20 L. ed. 860; *Wood v. Underhill*, 5 How. (U. S.) 1, 12 L. ed. 23; *De Lamar v. De Lamar Min. Co.*, 110 Fed. 538 [affirmed in 117 Fed. 240, 54 C. C. A. 272]; *Hensel-Colladay Co. v. Rosenau*, 105 Fed. 963; *Edison Electric Light Co. v. U. S. Electric Lighting Co.*, 52 Fed. 300, 3 C. C. A. 83; *Burrows v. Wetherill*, 4 Fed. Cas. No. 2,208, *McArthur Pat. Cas.* 315; *Goodyear v. Wait*, 10 Fed. Cas. No. 5,587, 5 Blatchf. 468, 3 Fish. Pat. Cas. 242; *Wayne v. Holmes*, 29 Fed. Cas. No. 17,303, 1 Bond 27, 2 Fish. Pat. Cas. 20; *Wilbur v. Beecher*, 29 Fed. Cas. No. 17,634, 2 Blatchf. 182, *Fish. Pat. Rep.* 401.

**Stating proportions.**—A claim for a compound is not void because the exact proportions are not stated, where proportions may be varied. *Klein v. Russell*, 19 Wall. (U. S.) 433, 22 L. ed. 116.

**Stating dimensions.**—When the novelty of an invention consists in the dimensions or the material of the new thing devised, the patentee must specify the particular dimensions or the particular material his invention contemplates. *Bullock Electric Mfg. Co. v. General Electric Co.*, 149 Fed. 409, 79 C. C. A. 229 [reversing 146 Fed. 549].

86. *Head v. Stevens*, 19 Wend. (N. Y.) 411; *Tyler v. Boston*, 7 Wall. (U. S.) 327, 19 L. ed. 93; *Wood v. Underhill*, 5 How. (U. S.) 1, 12 L. ed. 23; *Matheson v. Campbell*, 78 Fed. 910, 24 C. C. A. 384.

**Patent for chemical process** must disclose materials and proportions with such clearness that no experiment is necessary. *Béné v. Jeantet*, 129 U. S. 683, 9 S. Ct. 428, 32 L. ed. 803; *Matheson v. Campbell*, 78 Fed. 910, 24 C. C. A. 384.

87. *Webster Loom Co. v. Higgins*, 105 U. S. 580, 26 L. ed. 1177; *Am Ende v. Seabury*, 36 Fed. 593; *Dorsey Harvester Revolving Rake Co. v. Marsh*, 7 Fed. Cas. No. 4,014,

6 Fish. Pat. Cas. 387, 9 Phila. (Pa.) 395; *St. Louis Stamping Co. v. Quinby*, 21 Fed. Cas. No. 12,240, 4 Ban. & A. 192, 16 Off. Gaz. 135; *Stanley v. Whipple*, 22 Fed. Cas. No. 13,286, 2 McLean 35, 2 Robb Pat. Cas. 1; *Stephens v. Salisbury*, 22 Fed. Cas. No. 13,369, *McArthur Pat. Cas.* 379.

88. *Matheson v. Campbell*, 69 Fed. 597 [affirmed in 78 Fed. 910, 24 C. C. A. 384].

89. *Matheson v. Campbell*, 78 Fed. 910, 24 C. C. A. 384; *Tannage Patent Co. v. Zahn*, 66 Fed. 986 [reversed on other grounds in 70 Fed. 1003, 17 C. C. A. 552].

90. *Wood v. Underhill*, 5 Wall. (U. S.) 1, 12 L. ed. 23; *Hogg v. Emerson*, 11 How. (U. S.) 587, 13 L. ed. 824; *Brooks v. Jenkins*, 4 Fed. Cas. No. 1,953, *Fish. Pat. Rep.* 41, 3 McLean 432; *Carver v. Braintree Mfg. Co.*, 5 Fed. Cas. No. 2,485, 2 Robb Pat. Cas. 141, 2 Story 432; *Davis v. Palmer*, 7 Fed. Cas. No. 3,645, 2 Brock. 298, 1 Robb Pat. Cas. 518; *Page v. Ferry*, 18 Fed. Cas. No. 10,662, 1 Fish. Pat. Cas. 298.

91. *Wood v. Underhill*, 5 How. (U. S.) 1, 12 L. ed. 23.

92. *American Delinter Co. v. American Mach., etc., Co.*, 128 Fed. 709, 63 C. C. A. 307; *Brooks v. Bicknell*, 4 Fed. Cas. No. 1,944, 3 McLean 250, 2 Robb Pat. Cas. 118; *Carr v. Rice*, 5 Fed. Cas. No. 2,440, 1 Fish. Pat. Cas. 198; *Davis v. Palmer*, 7 Fed. Cas. No. 3,645, 2 Brock. 298, 1 Robb Pat. Cas. 518; *Kneass v. Schuylkill Bank*, 14 Fed. Cas. No. 7,875, 1 Robb Pat. Cas. 303, 4 Wash. 9; *Tompkins v. Gage*, 24 Fed. Cas. No. 14,038, 5 Blatchf. 268, 2 Fish. Pat. Cas. 577; *Union Paper-Bag Co. v. Nixon*, 24 Fed. Cas. No. 14,386, 6 Fish. Pat. Cas. 402, 4 Off. Gaz. 31.

**For description of old features** reference may be made to a prior patent. *Parkes v. Stevens*, L. R. 5 Ch. 36, 22 L. T. Rep. N. S. 635, 18 Wkly. Rep. 233.

93. *Tilghman v. Proctor*, 102 U. S. 707, 26 L. ed. 279; *Blanchard v. Eldridge*, 3 Fed. Cas. No. 1,509; *Pike v. Potter*, 19 Fed. Cas. No. 11,162, 3 Fish. Pat. Cas. 55; *Macnamara v. Hulse*, C. & M. 471, 41 E. C. L. 258; *Derosne v. Fairie*, 2 C. M. & R. 476, 1 Gale 109, 5 Tyrw. 393.

94. *Stow v. Chicago*, 104 U. S. 547, 26 L. ed. 816; *Roberts v. Ryer*, 91 U. S. 150, 23 L. ed. 267; *Tucker v. Spalding*, 13 Wall. (U. S.) 453, 20 L. ed. 515; *Goshen Sweeper Co. v. Bissell Carpet-Sweeper Co.*, 72 Fed. 67,



d. **Philosophical Principles.** If the inventor does not know the philosophical principles upon which his invention works or what takes place during its operation, the failure to describe them does not render the patent void so long as the description is sufficient to enable those skilled in the art to practice the invention and get the results desired.<sup>95</sup>

e. **Improvements.** The general rule governing description of the thing for which a patent is asked<sup>96</sup> applies in the case of improvements.<sup>97</sup> The description should show clearly in what the improvement consists.<sup>98</sup> It should be confined to the specific improvement and such parts of the old mechanism as necessarily cooperate with it.<sup>99</sup> It should distinguish between the old and the new.<sup>1</sup> If this is not done the only mode of obviating the difficulty is either by an amended specification or a new patent.<sup>2</sup> It is usually unnecessary to describe the old machine,<sup>3</sup> a general reference thereto being sufficient,<sup>4</sup> unless a description of the whole machine as it operates with the improvement is essential to make the description understood by a person of the trade to which it belongs.<sup>5</sup> A description in a patent for an improvement is sufficient if a practical mechanic acquainted with the construction of the old machine in which the improvement is made, can, with the aid of the patent and diagram, adopt the improvement.<sup>6</sup>

f. **Concealment and Deception.** Where the inventor in his patent intentionally conceals facts about his invention or attempts to deceive or mislead the public in regard to it, the patent is void.<sup>7</sup> An untrue statement of a material fact invalidates a patent, although a skilled workman might avoid it.<sup>8</sup> Mere defects in the description not intended to deceive will not invalidate a patent;<sup>9</sup> and if fraud is charged it must be proved.<sup>10</sup>

19 C. C. A. 13; *Stearns v. Russell*, 84 Off. Gaz. 1434.

95. *National Meter Co. v. Thomson Meter Co.*, 106 Fed. 531; *Emerson Co. v. Nimocks*, 99 Fed. 737, 40 C. C. A. 87; *Knickerbocker Co. v. Rogers*, 61 Fed. 297; *Dixon-Woods Co. v. Pfeifer*, 55 Fed. 390, 5 C. C. A. 148; *Haffke v. Clark*, 46 Fed. 770; *Andrews v. Cross*, 8 Fed. 269, 19 Blatchf. 294; *St. Louis Stamping Co. v. Quinby*, 21 Fed. Cas. No. 12,240, 4 Ban. & A. 192, 16 Off. Gaz. 135. And see *supra*, II, B, 7.

96. See *supra*, V, A, 2.

97. *Brooks v. Bicknell*, 4 Fed. Cas. No. 1,944, 3 McLean 250, 2 Robb Pat. Cas. 118.

98. *Barrett v. Hall*, 2 Fed. Cas. No. 1,047, 1 Mason 447, 1 Robb Pat. Cas. 207; *Dixon v. Moyer*, 7 Fed. Cas. No. 3,931, 4 Wash. 68, 1 Robb Pat. Cas. 324.

99. *Pract. Rule 31*; *Cross v. Huntly*, 13 Wend. (N. Y.) 385; *Barrett v. Hall*, 2 Fed. Cas. No. 1,047, 1 Mason 447, 1 Robb Pat. Cas. 207; *Sargent v. Carter*, 21 Fed. Cas. No. 12,362, 1 Fish. Pat. Cas. 277; *Sullivan v. Redfield*, 23 Fed. Cas. No. 13,597, 1 Paine 441, 1 Robb Pat. Cas. 477; *Wintermute v. Redington*, 30 Fed. Cas. No. 17,896, 1 Fish. Pat. Cas. 239.

1. *Gill v. Wells*, 22 Wall. (U. S.) 1, 22 L. ed. 699; *Cerealine Mfg. Co. v. Bates*, 101 Fed. 272, 41 C. C. A. 341; *Alexandria Bank v. Wilson*, 2 Fed. Cas. No. 856, 2 Cranch C. C. 5; *Barrett v. Hall*, 2 Fed. Cas. No. 1,047, 1 Mason 447, 1 Robb Pat. Cas. 207; *Dixon v. Moyer*, 7 Fed. Cas. No. 3,931, 4 Wash. 68, 1 Robb Pat. Cas. 324; *Hovey v. Stevens*, 12 Fed. Cas. No. 6,746, 2 Robb Pat. Cas. 567, 3 Woodb. & M. 17; *Lowell v. Lewis*, 15 Fed. Cas. No. 8,568, 1 Mason 182, 1 Robb Pat. Cas. 131; *Clark v. Adie*, 2 App. Cas. 315, 46 L. J. Ch. 585, 36 L. T. Rep. N. S. 923; *Foxwell v.*

*Bostock*, 4 De G. J. & S. 298, 10 L. T. Rep. N. S. 144, 12 Wkly. Rep. 723, 69 Eng. Ch. 231, 46 Eng. Reprint 934; *Macfarlane v. Price*, 1 Stark. 199, 18 Rev. Rep. 760, 2 E. C. L. 82.

2. *Hovey v. Stevens*, 12 Fed. Cas. No. 6,746, 2 Robb Pat. Cas. 567, 3 Woodb. & M. 17.

3. *Webster Loom Co. v. Higgins*, 105 U. S. 580, 26 L. ed. 1177; *Ives v. Hamilton*, 92 U. S. 426, 23 L. ed. 494; *Brooks v. Bicknell*, 4 Fed. Cas. No. 1,944, 3 McLean 250, 2 Robb Pat. Cas. 118; *Emerson v. Hogg*, 8 Fed. Cas. No. 4,440, 2 Blatchf. 1, Fish. Pat. Rep. 77; *Gibbs v. Ellithorp*, 10 Fed. Cas. No. 5,383, *McArthur Pat. Cas.* 702; *Winans v. New York, etc., R. Co.*, 30 Fed. Cas. No. 17,863, 1 Fish. Pat. Cas. 213 [*affirmed* in 21 How. 88, 16 L. ed. 68].

4. *Brooks v. Bicknell*, 4 Fed. Cas. No. 1,944, 3 McLean 250, 2 Robb Pat. Cas. 118.

5. *Wintermute v. Redington*, 30 Fed. Cas. No. 17,896, 1 Fish. Pat. Cas. 239.

6. *Ives v. Hamilton*, 92 U. S. 426, 23 L. ed. 494.

7. U. S. Rev. St. (1878) § 4920; *Davis v. Bell*, 8 N. H. 500, 31 Am. Dec. 202; *Carlton v. Bokee*, 17 Wall. (U. S.) 463, 21 L. ed. 517; *Mowry v. Whitney*, 14 Wall. (U. S.) 620, 20 L. ed. 860; *Evans v. Eaton*, 7 Wheat. (U. S.) 356, 5 L. ed. 472; *Gray v. James*, 10 Fed. Cas. No. 5,718, *Pet. C. C.* 304, 1 Robb Pat. Cas. 120; *Ex p. Sanders*, 21 Fed. Cas. No. 12,292.

8. *Simpson v. Holliday*, L. R. 1 H. L. 315, 35 L. J. Ch. 811; *Beard v. Egerton*, 8 C. B. 165, 13 Jur. 1004, 19 L. J. C. P. 36, 65 E. C. L. 165; *Neilson v. Harford*, 11 L. J. Exch. 20, 8 M. & W. 806.

9. *Lowell v. Lewis*, 15 Fed. Cas. No. 8,568, 1 Mason 182, 1 Robb Pat. Cas. 131.

10. *Goodyear v. Day*, 10 Fed. Cas. No. 5,567.



**3. CLAIMS<sup>11</sup>—a. In General.** The specification must conclude with a definite and distinct claim or claims pointing out the feature or features of the device disclosed which the applicant regards as his invention or discovery.<sup>12</sup> The claims fix the extent of the protection furnished by the patent.<sup>13</sup> The protection afforded by the patent does not extend to all that is shown but only to what is set forth in the claim.<sup>14</sup> While the specification may be referred to to limit the claim, it can never be made available to expand it.<sup>15</sup> The claims are essential parts which the public are to look to and scrutinize to ascertain their rights, and must control;<sup>16</sup> and the courts should be careful not to enlarge by construction the claim which the patent office has admitted, and which the patentee has acquiesced in, beyond the fair interpretation of its terms.<sup>17</sup> If a patentee describe and claim a part only of his patent he is presumed to have abandoned the residue to the public.<sup>18</sup>

**b. Vague, Indefinite, and Inaccurate Claims.** The claim must be definite and clear so as to inform the public with certainty just what it is that the patent secures as a monopoly,<sup>19</sup> and it must be accurate.<sup>20</sup> If it is vague and indefinite it is void.<sup>21</sup>

**c. Must State Means, Not Function or Result.** The claim must state the physical structure or elements of mechanism by which the function desired is attained or the end or result produced,<sup>22</sup> and is not valid if it merely states the function, end, or result.<sup>23</sup>

**d. Breadth of Claim.** While the claim should include such elements as are

11. Correction and amendment of claims on reissue see *infra*, VIII.

Excessive claims as affecting validity of patent see *infra*, VI, B, 7, b.

12. U. S. Rev. St. (1878) § 4888 [U. S. Comp. St. (1901) p. 3383]; *Roemer v. Neumann*, 132 U. S. 103, 10 S. Ct. 12, 33 L. ed. 277; *Calkins v. Bertrand*, 4 Fed. Cas. No. 2,317, 2 Ban. & A. 215, 6 Biss. 494, 9 Off. Gaz. 795.

If the claim be for an improvement, it must distinguish the new from the old so that it may not cover any parts that are old. *Blake v. Sperry*, 3 Fed. Cas. No. 1,503, 2 N. Y. Leg. Obs. 251.

Old elements shown need not be included. *Goshen Sweeper Co. v. Bissell Carpet-Sweeper Co.*, 72 Fed. 67, 19 C. C. A. 13; *Hancock Inspirator Co. v. Jenks*, 21 Fed. 911; *Forbush v. Cook*, 9 Fed. Cas. No. 4,931, 2 Fish. Pat. Cas. 668.

Omission of essential element is fatal. *Doubleday v. Beatty*, 11 Fed. 729.

Claim not supported by description is void. *Knox v. Quicksilver Min. Co.*, 4 Fed. 809; *Huggins v. Hubby*, 12 Fed. Cas. No. 6,839.

In designs a claim to "the design shown" is sufficient. *Dobson v. Dorman*, 118 U. S. 10, 6 S. Ct. 946, 30 L. ed. 63.

The object of the claim is to eliminate or disclaim what is old. *Plimpton v. Spiller*, 6 Ch. D. 412, 47 L. J. Ch. 211, 7 L. T. Rep. N. S. 56, 26 Wkly. Rep. 285; *Hinks v. Safety Lighting Co.*, 4 Ch. D. 607, 46 L. J. Ch. 185, 36 L. T. Rep. N. S. 391.

13. *McClain v. Ortmyer*, 141 U. S. 419, 12 S. Ct. 76, 35 L. ed. 800; *Sutter v. Robinson*, 119 U. S. 530, 7 S. Ct. 376, 30 L. ed. 492; *Burns v. Meyer*, 100 U. S. 671, 25 L. ed. 738; *Merrill v. Yeomans*, 94 U. S. 568, 24 L. ed. 235; *Untermeyer v. Jeannot*, 20 Fed. 503; *Cimiotti Unhairing Co. v. American Fur Refining Co.*, 116 Off. Gaz. 1452; *Lehigh Valley*

*R. Co. v. Mellon*, 20 Off. Gaz. 1891; *Masury v. Anderson*, 4 Off. Gaz. 55.

14. *In re Seabury*, 23 App. Cas. (D. C.) 377; *U. S. Peg-Wood, etc., Co. v. B. F. Sturtevant Co.*, 122 Fed. 470 [affirmed in 125 Fed. 378, 60 C. C. A. 244]; *Ingham v. Pierce*, 31 Fed. 822; *Toohy v. Harding*, 1 Fed. 174, 4 Hughes 253; *Blake v. Stafford*, 3 Fed. Cas. No. 1,504, 6 Blatchf. 195, 3 Fish. Pat. Cas. 294; *Ex p. Tillman*, 23 Fed. Cas. No. 14,050.

15. *McClain v. Ortmyer*, 141 U. S. 419, 12 S. Ct. 76, 35 L. ed. 800.

16. *Untermeyer v. Jeannot*, 20 Fed. 503.

17. *Burns v. Meyer*, 100 U. S. 671, 25 L. ed. 738.

18. *McClain v. Ortmyer*, 141 U. S. 419, 12 S. Ct. 76, 35 L. ed. 800; *Keystone Bridge Co. v. Phenix Iron Co.*, 95 U. S. 274, 24 L. ed. 344.

19. *O'Reilly v. Morse*, 15 How. (U. S.) 62, 14 L. ed. 601; *Swift v. Whisen*, 23 Fed. Cas. No. 13,700, 2 Bond 115, 3 Fish. Pat. Cas. 343; *In re Creveling*, 117 Off. Gaz. 1161; *In re Dilg*, 115 Off. Gaz. 1067.

20. *In re Creveling*, 117 Off. Gaz. 1167.

21. *Consolidated Electric Light Co. v. McKeesport Light Co.*, 159 U. S. 465, 16 S. Ct. 75, 40 L. ed. 221; *Brickill v. Baltimore*, 50 Fed. 274; *Brickill v. Hartford*, 49 Fed. 372; *Edgerton v. Furst, etc., Mfg. Co.*, 9 Fed. 450, 10 Biss. 402; *Blake v. Stafford*, 3 Fed. Cas. No. 1,504, 6 Blatchf. 195, 3 Fish. Pat. Cas. 294.

22. *O'Reilly v. Morse*, 15 How. (U. S.) 62, 14 L. ed. 601; *Canda v. Michigan Mal-leable Iron Co.*, 124 Fed. 486, 61 C. C. A. 194; *National Meter Co. v. Neptune Meter Co.*, 122 Fed. 82 [affirmed in 129 Fed. 124, 63 C. C. A. 626]; *In re Creveling*, 117 Off. Gaz. 1161.

23. *Diamond Match Co. v. Ruby Match Co.*, 127 Fed. 341; *Boyden Power-Brake Co. v. Westinghouse*, 70 Fed. 816, 17 C. C. A. 430 [affirmed in 83 Off. Gaz. 1067]. And see *supra*, II, A, 4; II, B, 4.



necessary to produce the desired result,<sup>24</sup> it is not necessary that the claim specify in detail mechanism which constitutes the invention;<sup>25</sup> but it may refer to the elements of mechanism by broad terms of description which will include equivalent mechanism for the purpose.<sup>26</sup> The inventor may make a generic claim including many specific forms.<sup>27</sup>

**e. Alternative Claims.** Claims should not seek to include two elements by referring to them in the alternative but should use some broad term of description applicable to both.<sup>28</sup>

**f. Multiplicity of Claims.** While a number of claims may be made in a single patent,<sup>29</sup> they should contain material differences and should not consist of mere repetitions in varying phraseology of the same thing.<sup>30</sup> A needless multiplicity of claims calls for a limited construction of them,<sup>31</sup> and the patent may be invalid because of ambiguity.<sup>32</sup>

**4. DRAWINGS.** The drawings must be referred to in the specifications<sup>33</sup> and

24. *In re Creveling*, 117 Off. Gaz. 1167.

Omission of understood element will not invalidate. *Chicago Wooden Ware Co. v. Miller Ladder Co.*, 133 Fed. 541, 66 C. C. A. 517.

25. *Schroeder v. Brammer*, 98 Fed. 880; *Taylor v. Sawyer Spindle Co.*, 75 Fed. 301, 22 C. C. A. 203. And see *General Electric Co. v. Bullock Electric Mfg. Co.*, 152 Fed. 427, 81 C. C. A. 569 [reversing 146 Fed. 552].

**Limiting claims.**—Where there are many devices on the market which closely resemble each other in appearance and structure, it is necessary for an applicant for a patent for a similar device to carefully limit and differentiate his claims in his application. *In re Hoey*, 28 App. Cas. (D. C.) 416.

26. *Rosell v. Allen*, 16 App. Cas. (D. C.) 559; *Hill v. Hodge*, 12 App. Cas. (D. C.) 528; *Dolbear v. American Bell Tel. Co.*, 126 U. S. 1, 8 S. Ct. 778, 31 L. ed. 863; *Carver v. Braintray Mfg. Co.*, 5 Fed. Cas. No. 2,485, 2 Robb Pat. Cas. 141, 2 Story 432; *Merrill v. Yeomans*, 17 Fed. Cas. No. 9,472, 1 Ban. & A. 47, *Holmes* 331, 5 Off. Gaz. 268 [affirmed in 94 U. S. 568, 24 L. ed. 235]; *American Sulphite Pulp Co. v. Howland Falls Pulp Co.*, 80 Off. Gaz. 515.

27. *Bowers v. Pacific Coast Dredging, etc.*, Co., 99 Fed. 745; *Brickill v. New York*, 98 Fed. 113; *Wilcox, etc., Sewing-Mach. Co. v. Merrow Mach. Co.*, 93 Fed. 206, 35 C. C. A. 269, 85 Off. Gaz. 1078; *Von Schmidt v. Bowers*, 80 Fed. 121, 25 C. C. A. 323. And see *Macnamara v. Hulse, C. & M.* 471, 41 E. C. L. 258; *Thomas v. Foxwell*, 5 Jur. N. S. 37 [affirmed in 6 Jur. N. S. 271].

**Claim may be in broad terms which apply to the means shown and to equivalents see** *In re Green*, 20 D. C. 237; *Tilghman v. Proctor*, 102 U. S. 707, 26 L. ed. 279; *Manhattan Gen. Constr. Co. v. Helios-Upton Co.*, 135 Fed. 785; *Electric Smelting Co. v. Carborundum Co.*, 102 Fed. 618, 42 C. C. A. 537; *Pittsburgh Reduction Co. v. Cowles Electric Smelting, etc., Co.*, 55 Fed. 301; *Brush Electric Co. v. Electric Imp. Co.*, 52 Fed. 965; *Poppenhusen v. Falke*, 19 Fed. Cas. No. 11,280, 5 Blatchf. 46, 2 Fish. Pat. Cas. 213; *Poppenhusen v. New York Gutta Percha Comb Co.*, 19 Fed. Cas. No. 11,283, 2 Fish. Pat. Cas. 62; *Union Paper-Bag Mach. Co. v. Nixon*, 24 Fed. Cas.

No. 14,391, 2 Ban. & A. 244, 1 Flipp. 491, 9 Off. Gaz. 691; *Union Paper Collar Co. v. White*, 24 Fed. Cas. No. 14,396, 2 Ban. & A. 60, 7 Off. Gaz. 698, 877, 11 Phila. (Pa.) 479, 1 Wkly. Notes Cas. (Pa.) 363.

**Terms covering forms not yet invented may be used.** *U. S. Glass Co. v. Atlas Glass Co.*, 88 Fed. 493.

**Omission of elements which would be understood is not fatal.** *Taylor v. Sawyer Spindle Co.*, 75 Fed. 301, 22 C. C. A. 203 [affirming 69 Fed. 837]; *American Automaton Weighing Mach. Co. v. Blauvelt*, 50 Fed. 213; *Wells v. Jacques*, 29 Fed. Cas. No. 17,398, 1 Ban. & A. 60, 5 Off. Gaz. 364.

**Sub-combination in machine not useful alone may be claimed.** *Roberts v. H. P. Nail Co.*, 53 Fed. 916; *Wells v. Jacques*, 29 Fed. Cas. No. 17,398, 1 Ban. & A. 60, 5 Off. Gaz. 364.

28. *Burr v. Smith*, 4 Fed. Cas. No. 2,196; *Union Paper-Bag Co. v. Nixon*, 24 Fed. Cas. No. 14,386, 6 Fish. Pat. Cas. 402, 4 Off. Gaz. 31; *Wheeler v. Simpson*, 29 Fed. Cas. No. 17,500, 1 Ban. & A. 420, 6 Off. Gaz. 435.

29. *In re Carpenter*, 24 App. Cas. (D. C.) 110; *Carlton v. Bokee*, 17 Wall. (U. S.) 463, 21 L. ed. 517; *Thomson-Houston Electric Co. v. Elmira, etc., R. Co.*, 69 Fed. 257; *Britton v. White Mfg. Co.*, 61 Fed. 93; *Brush Electric Co. v. Electrical Accumulator Co.*, 47 Fed. 48; *Tompkins v. Gage*, 24 Fed. Cas. No. 14,088, 5 Blatchf. 268, 2 Fish. Pat. Cas. 577; *Computing Scale Co. v. Automatic Scale Co.*, 119 Off. Gaz. 1586.

30. *Thomson-Houston Electric Co. v. Elmira, etc., R. Co.*, 69 Fed. 257 [reversed on other grounds in 71 Fed. 396, 18 C. C. A. 145].

31. *Carlton v. Bokee*, 17 Wall. (U. S.) 463, 21 L. ed. 517.

32. *Carlton v. Bokee*, 17 Wall. (U. S.) 463, 21 L. ed. 517.

33. Pract. Rule 38.

**Drawings considered in connection with claims and specifications see** *Cutler-Hammer Mfg. Co. v. Union Electric Mfg. Co.*, 147 Fed. 266.

**That drawings are part of the patent see** *Hogg v. Emerson*, 11 How. (U. S.) 587, 13 L. ed. 824; *Brammer v. Schroeder*, 106 Fed. 918, 46 C. C. A. 41; *Hoves v. Nute*, 12 Fed.



must clearly show the invention.<sup>34</sup> They are not required to be working drawings or made to an exact scale, but it is sufficient if they disclose the inventor's idea so that one skilled in the art may make it.<sup>35</sup> They may be signed by the applicant or his attorney, but there must be two witnesses to the signature.<sup>36</sup>

**5. OATH — a. Necessity.** It is provided by statute that the applicant must make oath that he believes himself to be the original and first inventor of the thing for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used and shall state of what country he is a citizen.<sup>37</sup> In construing this statute it has been held that the taking of the oath is but a prerequisite to the granting of the patent and in no sense essential to its validity.<sup>38</sup> The patent office also requires that he shall state that the invention has not been in public use or on sale in this country or described in a printed publication in this country or abroad more than two years before the application was filed and shall give the date of foreign patents granted upon the invention.<sup>39</sup>

**b. By and Before Whom Made.** The oath must be made by the inventor if living and sane,<sup>40</sup> and if dead, by the executor or administrator.<sup>41</sup> It may be made in the United States before any officer authorized to administer oaths; and if made abroad before any diplomatic or consular officer of the United States or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths<sup>42</sup> the authority of the foreign officer shall be proved by a certificate of a diplomatic or consular officer of the United States.<sup>43</sup>

**c. Absence of Written Oath.** A patent is not invalid merely because no written oath appears among the papers of the record, since it is to be presumed that an oath was taken.<sup>44</sup>

Cas. No. 6,790, 4 Cliff. 173, 4 Fish. Pat. Cas. 263; *Swift v. Whisen*, 23 Fed. Cas. No. 13,700, 2 Bond 115, 3 Fish. Pat. Cas. 343.

**Designs.**—Reference to a drawing fully showing the design is sufficient. *In re Freeman*, 23 App. Cas. (D. C.) 226; *Dobson v. Dornan*, 118 U. S. 10, 6 S. Ct. 946, 30 L. ed. 63. *Compare In re Mygatt*, 26 App. Cas. (D. C.) 366. In an application for a design patent for a font of type, it is sufficient to furnish the conventional drawing accepted for years by the patent office, and it is not necessary, under the patent office rules relating to designs, to show or describe the type themselves. *In re Schraubstadter*, 26 App. Cas. (D. C.) 331.

34. Pract. Rule 50.

One of several forms shown in drawings.—Where a skilled mechanic could construct the three forms of buffers described from the specifications and drawings, the specification in that respect is sufficient, although but one form is shown in the drawings. *Pullman Palace-Car Co. v. Wagner Palace-Car Co.*, 38 Fed. 416.

35. *Dashiell v. Grosvenor*, 162 U. S. 425, 16 S. Ct. 805, 40 L. ed. 1025; *Crown Cork, etc., Co. v. Aluminum Stopper Co.*, 108 Fed. 485, 48 C. C. A. 72; *American Hide, etc., Splitting, etc., Mach. Co. v. American Tool, etc., Co.*, 1 Fed. Cas. No. 302, 4 Fish. Pat. Cas. 284, *Holmes* 503; *Johnston v. Woodbury*, 97 Off. Gaz. 402.

36. U. S. Rev. St. (1878) § 4889 [U. S. Comp. St. (1901) p. 3383]; *In re Henry*, 11 Fed. Cas. No. 6,371, *McArthur Pat. Cas.* 467.

37. U. S. Rev. St. (1878) § 4892 [U. S. Comp. St. (1901) p. 3384].

Date of oath.—The burden is on the party

questioning the correctness of the date given at the date of the oath to an application for a patent. *O'Connell v. Schmidt*, 27 App. Cas. (D. C.) 77.

38. *Kennedy v. Hazelton*, 128 U. S. 667, 9 S. Ct. 202, 32 L. ed. 576; *Child v. Adams*, 5 Fed. Cas. No. 2,673, 1 Fish. Pat. Cas. 189, 3 Wall. Jr. 20; *Crompton v. Belknap Mills*, 6 Fed. Cas. No. 3,406, 3 Fish. Pat. Cas. 536; *Whittemore v. Cutter*, 29 Fed. Cas. No. 17,600, 1 Gall. 429, 1 Robb Pat. Cas. 28.

Oath of executor to support proper amendment after inventor's death is not necessary. *De la Vergne Refrigerating Mach. Co. v. Featherstone*, 147 U. S. 209, 13 S. Ct. 283, 37 L. ed. 138.

The statute is directory to the officer who superintends the issuing of letters patent, but is not a condition to the validity of the patent. *Dyer v. Rich*, 1 Mete. (Mass.) 180.

Innocent mistake as to citizenship in oath is not fatal. *Tondeur v. Chambers*, 37 Fed. 333.

39. Pract. Rule 46.

40. U. S. Rev. St. (1878) § 4895 [U. S. Comp. St. (1901) p. 3385].

41. U. S. Rev. St. (1878) § 4896.

42. Jurat need not be dated. *French v. Rogers*, 9 Fed. Cas. No. 5,103, 1 Fish. Pat. Cas. 133.

43. U. S. Rev. St. (1878) § 4892 [U. S. Comp. St. (1901) p. 3384]; U. S. Rev. St. (1878) § 4896, as amended March 3, 1903, 32 U. S. St. at L. 1226 [U. S. Comp. St. Suppl. (1905) p. 665].

44. *Holmes Burglar Alarm Tel. Co. v. Domestic Tel., etc., Co.*, 42 Fed. 220, 51 Off. Gaz. 2083; *Hancock Inspirator Co. v. Jenks*, 21 Fed. 911; *Hartshorn v. Eagle Shade Roller*



**6. FEES.** In the United States the first fee of fifteen dollars must be paid upon filing the application;<sup>45</sup> and the final fee of twenty dollars must be paid within six months after the application is passed and allowed by the patent office.<sup>46</sup> This means six calendar months.<sup>47</sup> The patent, however, is not subject to collateral attack upon the ground that the fee was not paid.<sup>49</sup>

**7. SUBJECT-MATTER OR SCOPE.** An application for a patent should relate to a single subject and should claim only one invention, or if more than one only such as are related and dependent. The application cannot include independent inventions,<sup>49</sup> although it may include related inventions.<sup>50</sup> The doctrine of the patent office that applications for patents shall not be severable except on structural lines must be held to mean upon physical lines which actually divide the machine into separate parts,<sup>51</sup> but his decision is not conclusive and may be passed upon by the courts.<sup>52</sup>

**C. Examination and Proceedings in Patent Office — 1. IN GENERAL.** The commissioner of patents is required by law to make or cause to be made by the primary examiner an examination for each application for patent and to determine whether the applicant has complied with the law and discloses a new invention which is sufficiently useful and important to warrant the grant of a patent.<sup>53</sup>

Co., 18 Fed. 90; Crompton v. Belknap Mills, 6 Fed. Cas. 3,406, 3 Fish. Pat. Cas. 536; De Florez v. Reynolds, 7 Fed. Cas. No. 3,742, 4 Ban. & A. 331, 16 Blatchf. 397; Whittemore v. Cutter, 29 Fed. Cas. No. 17,600, 1 Gall. 429, 1 Robb Pat. Cas. 28; Crompton v. Belknap Mills, 30 Fed. Cas. No. 18,285, 3 Fish. Pat. Cas. 536.

Recitals in letters patent in the absence of fraud are conclusive evidence that the necessary oaths were taken before the patent was granted. *Seymour v. Osborne*, 10 Wall. (U. S.) 516, 20 L. ed. 33.

45. U. S. Rev. St. (1878) §§ 4893, 4934 [U. S. Comp. St. (1901) pp. 3384, 3400].

46. U. S. Rev. St. (1878) § 4885 [U. S. Comp. St. (1901) p. 3382].

47. *Economy Feed Water-Heater Co. v. Lamprey Boiler Furnace-Mouth Protector Co.*, 65 Fed. 1000, 13 C. C. A. 271 [affirmed 62 Fed. 590]; Crompton v. Belknap Mills, 30 Fed. Cas. No. 18,285, 3 Fish. Pat. Cas. 536.

48. In Canada the fee when application is filed is sixty dollars for eighteen years, forty dollars for twelve years, and twenty dollars for six years. Pat. Act, 56 Vict. c. 34, § 4.

49. *Sessions v. Romadka*, 145 U. S. 29, 12 S. Ct. 799, 36 L. ed. 609 [reversing 21 Fed. 124]; *Gage v. Kellogg*, 23 Fed. 891; *McKay v. Dibert*, 5 Fed. 587; *Barrett v. Hall*, 2 Fed. Cas. No. 1,047, 1 Mason 447, 1 Robb Pat. Cas. 207; *Root v. Ball*, 20 Fed. Cas. No. 12,035, 4 McLean 177, 2 Robb Pat. Cas. 513; *Wyeth v. Stone*, 30 Fed. Cas. No. 18,107, 2 Robb Pat. Cas. 23, 1 Story 273.

50. U. S. v. Allen, 192 U. S. 543, 24 S. Ct. 416, 48 L. ed. 555, 109 Off. Gaz. 549; *Hogg v. Emerson*, 11 How. (U. S.) 587, 13 L. ed. 824; *Maxheimer v. Meyer*, 9 Fed. 460, 20 Blatchf. 17; *Adams v. Jones*, 1 Fed. Cas. No. 57, 1 Fish. Pat. Cas. 527, 2 Pittsb. (Pa.) 73; *American Nicholson Pavement Co. v. Elizabeth*, 1 Fed. Cas. No. 311, 6 Fish. Pat. Cas. 424, 3 Off. Gaz. 522 [modified in 97 U. S. 126, 24 L. ed. 1000]; *Densmore v. Schofield*, 7 Fed. Cas. No. 3,809, 4 Fish. Pat. Cas. 148; *Hayden v. James*, 11 Fed. Cas. No. 6,260; *Lee v.*

*Blandy*, 15 Fed. Cas. No. 8,182, 1 Bond 361, 2 Fish. Pat. Cas. 89; *McComb v. Brodie*, 15 Fed. Cas. No. 8,708, 5 Fish. Pat. Cas. 384, 1 Woods 153, 2 Off. Gaz. 117; *Morris v. Barrett*, 17 Fed. Cas. No. 9,827, 1 Bond 254, 1 Fish. Pat. Cas. 461; *Stevens v. Pritchard*, 23 Fed. Cas. No. 13,407, 2 Ban. & A. 390, 4 Cliff. 417, 10 Off. Gaz. 505; *Welling v. Rubber-Coated Harness Trimming Co.*, 29 Fed. Cas. No. 17,383, 2 Ban. & A. 1, 7 Off. Gaz. 608. And see Act England (1883), § 33, 46 & 47 Vict. c. 57.

Process and product may be included in one patent. *Welling v. Rubber-Coated Harness Trimming Co.*, 29 Fed. Cas. No. 17,383, 2 Ban. & A. 1, 7 Off. Gaz. 608.

A rule of the patent office requiring division between process and apparatus in all cases is invalid because arbitrary. *U. S. v. Allen*, 192 U. S. 543, 24 S. Ct. 416, 48 L. ed. 555, 109 Off. Gaz. 549.

51. *Fassett v. Ewart Mfg. Co.*, 58 Fed. 360 [affirmed in 62 Fed. 404, 10 C. C. A. 441]. Whether an invention or improvement shall be embraced in one or in several patents is a question as to which some discretion must be left to the head of the patent office. *U. S. v. Allen*, 192 U. S. 543, 24 S. Ct. 416, 48 L. ed. 555; *Bennett v. Fowler*, 8 Wall. (U. S.) 445, 19 L. ed. 431; *In re Fraseh*, 27 App. Cas. (D. C.) 25.

52. *Fassett v. Ewart Mfg. Co.*, 58 Fed. 360 [affirmed in 62 Fed. 404, 10 C. C. A. 441].

53. *Holloway v. Whiteley*, 4 Wall. (U. S.) 522, 18 L. ed. 335; *Burr v. Durvee*, 1 Wall. (U. S.) 531, 17 L. ed. 650, 660, 661; *Corning v. Burden*, 15 How. (U. S.) 252, 14 L. ed. 683; *In re Aiken*, 1 Fed. Cas. No. 107, McArthur Pat. Cas. 126; *In re Cushman*, 6 Fed. Cas. No. 3,513, McArthur Pat. Cas. 569.

English practice.—The application is referred by the controller to an examiner to determine its sufficiency. Act (1883), § 6. If complete application is accepted it is advertised (Act (1883), § 10) and any one may oppose the grant within two months after publication. Act (1883), § 11. The grant may



The statutory requirement that he shall give the applicant such reasons and suggestions as will enable him to judge of the experience of abandoning or modifying his application is directory merely and his action in the premises is not reviewable.<sup>54</sup> He should decide not only questions of law, but also of fact,<sup>55</sup> and his action in awarding or refusing a patent is judicial.<sup>56</sup> The decision of the examiner or board of examiners is not conclusive upon him, and he may refuse a patent allowed by the examiner.<sup>57</sup> So it is his duty, if there be within his knowledge or cognizance any substantial or reasonable ground why a patent should not issue, to refuse the patent, whether the specific objection be raised and acted upon by the examiners or not.<sup>58</sup> The applicant being given the right of appeal, the commissioner will not determine doubtful questions in his favor.<sup>59</sup>

**2. REJECTION.** If upon such examination it appears that the applicant is not entitled to a patent as claimed the application will be rejected and the reasons therefor will be stated.<sup>60</sup> The application may be rejected for want of diligence and abandonment.<sup>61</sup> The rejection will be reconsidered upon request supported by proper argument pointing out the supposed errors therein.<sup>62</sup>

**3. EVIDENCE AT HEARING.** The patent office is not confined to technical evidence in rejecting applications but may base its action upon anything which shows the facts with reasonable certainty.<sup>63</sup> The burden is on the applicant to

be opposed by one interested but not refused where there is doubt. *Ex p. Sheffield*, L. R. 8 Ch. 237, 42 L. J. Ch. 356, 21 Wkly. Rep. 233; *In re Bailey*, L. R. 8 Ch. 60, 42 L. J. Ch. 264, 27 L. T. Rep. N. S. 430, 21 Wkly. Rep. 31; *In re Vincent*, L. R. 2 Ch. 341, 15 Wkly. Rep. 524; *Matter of Spence*, 3 De G. & J. 523, 7 Wkly. Rep. 157, 60 Eng. Ch. 406, 44 Eng. Reprint 1370; *Matter of Russell*, 2 De G. & J. 130, 6 Wkly. Rep. 95, 59 Eng. Ch. 104, 45 Eng. Reprint 937; *Tolson's Patent*, 6 De G. M. & G. 422, 4 Wkly. Rep. 518, 55 Eng. Ch. 329, 43 Eng. Reprint 1297; *In re Lowe*, 25 L. J. Ch. 454, 4 Wkly. Rep. 429; *Ex p. Daly*, Vern. & S. 499; *Re Tolhausen*, 14 Wkly. Rep. 551; *In re Stoll*, 1 Wkly. Rep. 472, 483. Caveat against sealing must be with leave of the lord chancellor. *Re Heathorn*, 10 Jur. N. S. 810, 10 L. T. Rep. N. S. 802, 12 Wkly. Rep. 1068. Opposition referred to law officer to determine if patent should issue. *Ex p. Manceaux*, L. R. 5 Ch. 518, 18 Wkly. Rep. 854; *Ex p. Yates*, L. R. 5 Ch. 1, 21 L. T. Rep. N. S. 663, 18 Wkly. Rep. 1, 153. Law officer must decide between rival claimants and not seal both patents. *Ex p. Henry*, L. R. 8 Ch. 167, 42 L. J. Ch. 363, 21 Wkly. Rep. 233. May order sealing on conditions. *In re Daine*, 26 L. J. Ch. 298, 4 Wkly. Rep. 155. May oppose before law officer and if he orders sealing may oppose before lord chancellor. *In re Mitchell*, L. R. 2 Ch. 343; *In re Vincent*, L. R. 2 Ch. 341, 15 Wkly. Rep. 524; *Matter of Brennard*, 3 De G. F. & J. 695, 7 Jur. N. S. 690, 4 L. T. Rep. N. S. 456, 64 Eng. Ch. 543, 45 Eng. Reprint 1048. Ruling of law officer not overruled except for fraud or new evidence. *In re Vincent*, L. R. 2 Ch. 341, 15 Wkly. Rep. 524. On application for sealing, witnesses can be examined *viva voce*. *In re Gething*, L. R. 9 Ch. 633. Time for application for sealing may be extended. *In re Hersee*, L. R. 1 Ch. 518, 14 L. T. Rep. N. S. 842; *In re Somerset*, 15 Ch. D. 397, 42 L. T. Rep. N. S. 635, 28 Wkly. Rep. 709; *In re Mackintosh*, 2 Jur. N. S. 1242, 5 Wkly. Rep. 194. Where opposition

withdrawn opposer pays costs. *In re Cobley*, 8 Jur. N. S. 106, 31 L. J. Ch. 333, 5 L. T. Rep. N. S. 387; *Re Ashenhurst*, 2 Wkly. Rep. 3.

**54.** *Ex p. Spence*, 22 Fed. Cas. No. 13,228. And see *Ex p. Munson*, 17 Fed. Cas. No. 9,933.

**55.** *Hunt v. Howe*, 12 Fed. Cas. No. 6,891, McArthur Pat. Cas. 366 (abandonment); *Marcy v. Trotter*, 16 Fed. Cas. No. 9,063 (abandonment); *Wickersham v. Singer*, 29 Fed. Cas. No. 17,610, McArthur Pat. Cas. 645 (abandonment).

Public use or sale.—He may investigate and determine public use or sale. *Mowry v. Barber*, 17 Fed. Cas. No. 9,892, McArthur Pat. Cas. 563.

**56.** *Butterworth v. U. S.*, 112 U. S. 50, 5 S. Ct. 25, 28 L. ed. 656; *U. S. v. Duell*, 86 Off. Gaz. 995.

**57.** *Hull v. Patent Com'r*, 2 MacArthur (D. C.) 90.

**58.** *In re Drawbaugh*, 9 App. Cas. (D. C.) 219.

**59.** *In re Kemper*, 14 Fed. Cas. No. 7,687, Cranch Pat. Dec. 89, McArthur Pat. Cas. 1.

**60.** U. S. Rev. St. (1878) § 4903 [U. S. Comp. St. (1901) p. 3389]; *In re Wagner*, 29 Fed. Cas. No. 17,038, McArthur Pat. Cas. 510.

In England the crown may refuse patent at any time before sealing. *In re Schlumberger*, 2 Eq. Rep. 36, 9 Moore P. C. 1, 14 Eng. Reprint 197. Sealing not refused for formal defects. *In re Wirth*, 12 Ch. D. 303, 28 Wkly. Rep. 329.

**61.** *Hunt v. Howe*, 12 Fed. Cas. No. 6,891, McArthur Pat. Cas. 366; *Marcy v. Trotter*, 16 Fed. Cas. No. 9,063; *Wickersham v. Singer*, 29 Fed. Cas. No. 17,610, McArthur Pat. Cas. 645.

**62.** U. S. Rev. St. (1878) § 4903 [U. S. Comp. St. (1901) p. 3389].

**63.** *In re Drawbaugh*, 9 App. Cas. (D. C.) 219.

Microscope may be used as basis for con-



show the patentability of the thing claimed as an invention.<sup>64</sup> The oath of the applicant is *prima facie* evidence of the novelty, but the commissioner has power and it is his duty to resort to any circumstances legitimately in his possession for the purpose of repelling the presumption.<sup>65</sup>

**4. AMENDMENT—*a. In General.*** Where objection is made to the form of the application, amendment may be made by the applicant or his attorney to correct the error,<sup>66</sup> and where a claim is rejected the applicant or his attorney may amend it to avoid the references cited or reasons for rejection given.<sup>67</sup> He may amend at any time prior to the entry by the primary examiner of a final order of rejection.<sup>68</sup>

***b. New Matter.*** All amendments must be within the scope of the original disclosure and must not introduce new matter.<sup>69</sup> An improvement upon the invention disclosed must be claimed in a separate application.<sup>70</sup> A claim made by amendment to matter not disclosed in the application as originally filed is invalid.<sup>71</sup> The description of the functions, operation, or advantages of the invention may be changed so long as there is no change in the disclosure of the invention itself.<sup>72</sup>

***c. Delay in Amending.*** Under express statutory provisions amendment or other responsive action must be made within one year from the date of the pre-

clusion. *Flora v. Powrie*, 23 App. Cas. (D. C.) 195.

**Commissioner's records.**—Commissioner may take judicial notice of his own records. *Cain v. Park*, 14 App. Cas. (D. C.) 42.

**Ex parte affidavits.**—Cannot reject upon *ex parte* affidavits. *In re Altenek*, *MacArthur & M.* (D. C.) 353.

**Exhibition of experiments.**—Commissioner is not compelled to submit to an exhibition of experiments at the discretion of applicant. *Ex p. Spence*, 22 Fed. Cas. No. 13,288.

**64.** *In re Drawbaugh*, 9 App. Cas. (D. C.) 219; *Durham v. Seymour*, 71 Off. Gaz. 601.

**65.** *In re Wagner*, 29 Fed. Cas. No. 17,038, *McArthur Pat. Cas.* 510.

**66.** *Bowers v. Von Schmidt*, 63 Fed. 572.

**67.** U. S. Rev. St. (1878) § 4903 [U. S. Comp. St. (1901) p. 3389]; *McBerty v. Cook*, 16 App. Cas. (D. C.) 133; *Croskey v. Atterbury*, 9 App. Cas. (D. C.) 207; *Edison v. American Mutoscope Co.*, 110 Fed. 660 [*reversed* on other grounds in 114 Fed. 926, 52 C. C. A. 546]; *Hillborn v. Hale*, etc., *Mfg. Co.*, 69 Fed. 958, 16 C. C. A. 569; *Railway Register Mfg. Co. v. North Hudson Co. R. Co.*, 24 Fed. 793; *Collins v. White*, 6 Fed. Cas. No. 3,019; *Ostergren v. Tripler*, 95 Off. Gaz. 837.

**68.** *Pract. Rule 63*; *Singer v. Braunsdorf*, 22 Fed. Cas. No. 12,897, 7 *Blatchf.* 521; *In re Dilg*, 115 Off. Gaz. 1067.

**69.** *Luger v. Browning*, 21 App. Cas. (D. C.) 201; *Hobbs v. Beach*, 180 U. S. 383, 21 S. Ct. 409, 45 L. ed. 586; *Eagleton Mfg. Co. v. West Bradley*, etc., *Mfg. Co.*, 111 U. S. 490, 4 S. Ct. 593, 28 L. ed. 493; *Chicago*, etc., *R. Co. v. Sayles*, 97 U. S. 554, 24 L. ed. 1053; *Long v. Pope Mfg. Co.*, 75 Fed. 835, 21 C. C. A. 533; *Michigan Cent. R. Co. v. Consolidated Car-Heating Co.*, 67 Fed. 121, 14 C. C. A. 232; *Electrical Accumulator Co. v. Brush Electric Co.*, 52 Fed. 130, 2 C. C. A. 682; *Consolidated Electric Light Co. v. McKeesport Light Co.*, 40 Fed. 21 [*affirmed* in

73 Off. Gaz. 1289]; *Globe Nail Co. v. Superior Nail Co.*, 27 Fed. 450; *Milligan v. Lalance*, etc., *Mfg. Co.*, 21 Fed. 570; *In re Scott*, 117 Off. Gaz. 278; *In re Dilg*, 115 Off. Gaz. 1067; *Miehle v. Read*, 96 Off. Gaz. 426.

**The settled limitation upon the amendment of applications** in respect of claims is that there must be a basis for them in the description and specifications of the application as originally filed. *In re Duncan*, 28 App. Cas. (D. C.) 457.

**In England** complete specification may amplify but cannot change invention disclosed in provisional specification. *Vickers v. Siddell*, 15 App. Cas. 496, 60 L. J. Ch. 105, 63 L. T. Rep. N. S. 590, 39 *Wkly. Rep.* 385; *Bailey v. Robertson*, 3 App. Cas. 1055, 38 L. T. Rep. N. S. 854, 27 *Wkly. Rep.* 17; *Penn v. Bibby*, L. R. 2 Ch. 127, 36 L. J. Ch. 455, 15 L. T. Rep. N. S. 399, 15 *Wkly. Rep.* 208; *Lane Fox v. Kensington Electric Lighting Co.*, [1892] 3 Ch. 424, 67 L. T. Rep. N. S. 440; *Nuttall v. Hargreaves*, [1892] 1 Ch. 23, 61 L. J. Ch. 94, 65 L. T. Rep. N. S. 597, 40 *Wkly. Rep.* 200; *United Tel. Co. v. Harrison*, 21 Ch. D. 720, 51 L. J. Ch. 705, 46 L. T. Rep. N. S. 620, 30 *Wkly. Rep.* 724; *Hills v. London Gaslight Co.*, 5 H. & N. 312, 29 L. J. Exch. 409; *Gadd v. Manchester*, 67 L. T. Rep. N. S. 569. Complete specification may include additional details not departing from the general nature of the invention. *Siddell v. Vickers*, 30 Ch. D. 92, 59 L. T. Rep. N. S. 575 [*affirmed* in 15 App. Cas. 496, 60 L. J. Ch. 105, 63 L. T. Rep. N. S. 590, 39 *Wkly. Rep.* 385]; *Thomas v. Welch*, L. R. 1 C. P. 192, 12 *Jur.* N. S. 316, 35 L. J. C. P. 200; *Moseley v. Victoria Rubber Co.*, 57 L. T. Rep. N. S. 142; *Woodward v. Sansum*, 56 L. T. Rep. N. S. 347.

**70.** See note *supra*, 69.

**71.** See note *supra*, 69.

**72.** *Cleveland Foundry Co. v. Detroit Vapor Stove Co.*, 131 Fed. 853, 68 C. C. A. 233; *Western Electric Co. v. Sperry Electric Co.*,



ceding action by the patent office. Further delay works an abandonment of the application unless shown to the satisfaction of the commissioner to have been unavoidable.<sup>73</sup>

d. **Oath.** An amendment which is within the scope of the original specification does not require a new oath.<sup>74</sup> Otherwise, however, where the specification as well as the claim is enlarged so as to include an invention not before described.<sup>75</sup>

5. **ALLOWANCE.** If the invention is found to be patentable the application must be passed and allowed.<sup>76</sup> The applicant must pay the final fee within six months thereafter and the patent must issue within three months after the payment of the final fee or the application is forfeited.<sup>77</sup>

6. **FORFEITURE AND RENEWAL.** A case forfeited by failure to pay the final fee within six months after allowance may be renewed by any one having an interest in the invention at any time within two years after the original notice of allowance.<sup>78</sup> The right of renewal, whether more than one renewal be asked, must be exercised within the two years.<sup>79</sup> The original papers may be used in the renewal application but a new fee is required.<sup>80</sup>

7. **ABANDONMENT.** Upon the failure of the applicant to complete his application and prepare it for examination within one year after the filing of the petition, and upon his failure to take proper action in prosecution of it within one year after action by the patent office, the application is abandoned unless it be shown to the satisfaction of the commissioner that the delay was unavoidable.<sup>81</sup> The commissioner's ruling upon the question of abandonment of an application is final and conclusive.<sup>82</sup>

8. **INTERFERENCE** <sup>83</sup> — a. **In General.** Where two parties make application for

58 Fed. 186, 7 C. C. A. 164; *Beach v. Inman Mfg. Co.*, 74 Off. Gaz. 379.

Changing "cement" to "hydraulic cement" is not new matter. *National Conduit Mfg. Co. v. Connecticut Pipe Mfg. Co.*, 75 Off. Gaz. 1361.

Where invention resides in operation, operation cannot be changed. *American Bell Tel. Co. v. Century Tel. Co.*, 109 Fed. 976.

73. U. S. Rev. St. (1878) § 4894. Decision of commissioner is final. *Western Electric Co. v. Sperry Electric Co.*, 53 Fed. 186, 7 C. C. A. 164.

74. *Phillips v. Sensenich*, 31 App. Cas. (D. C.) 159; *Cutler-Hammer Mfg. Co. v. Union Electric Mfg. Co.*, 147 Fed. 266; *De la Vergne Refrigerating Mach. Co. v. Featherstone*, 147 U. S. 209, 13 S. Ct. 283, 37 L. ed. 138; *John R. Williams Co. v. Miller, etc.*, Mfg. Co., 107 Fed. 290. And see *Wirt v. Hicks*, 45 Fed. 256, holding that where an application for a patent is made by the inventor in his lifetime by attorney the fact that changes were made by the attorney in the specifications and claims without new oaths will not invalidate the patent, since a discretion as to the allowance of such amendment is vested in the commissioner.

The changing of claims for inventions described in the specifications does not enlarge the scope of the application and seems to be well within the authority of attorneys to prosecute it. *John R. Williams Co. v. Miller, etc.*, Mfg. Co., 107 Fed. 290.

75. *Eagleton Mfg. Co. v. West, etc.*, Mfg. Co., 111 U. S. 490, 4 S. Ct. 593, 28 L. ed. 493.

76. U. S. Rev. St. (1878) § 4893 [U. S. Comp. St. (1901) p. 3384]; *Butterworth v. U. S.*, 112 U. S. 50, 5 S. Ct. 25, 28 L. ed.

656; *In re Seely*, 21 Fed. Cas. No. 12,632, *McArthur Pat. Cas.* 248; *In re Wagner*, 28 Fed. Cas. No. 17,038, *McArthur Pat. Cas.* 510.

77. U. S. Rev. St. (1878) § 4885, as amended May 23, 1908, *Public No.* 133.

78. U. S. Rev. St. (1878) § 4897 [U. S. Comp. St. (1901) p. 3386]; *Christensen v. Noyes*, 15 App. Cas. (D. C.) 94; *Bowers v. San Francisco Bridge Co.*, 69 Fed. 640.

79. *Weston Electrical Instrument Co. v. Empire Electrical Instrument Co.*, 131 Fed. 90 [affirmed in 136 Fed. 599, 69 C. C. A. 329]; *In re Atty.-Gen.*, 70 Off. Gaz. 493.

80. *Pract. Rule* 176.

81. U. S. Rev. St. (1878) § 4894, as amended March 3, 1897, 29 U. S. St. at L. 692 [U. S. Comp. St. (1901) p. 3384]. Two years were allowed by statute upon applications filed before Jan. 1, 1898.

Delay caused by patent office does not work abandonment. *Dolbear v. American Bell Tel. Co.*, 126 U. S. 1, 8 S. Ct. 778, 31 L. ed. 863; *Adams v. Jones*, 1 Fed. Cas. No. 57, 1 Fish. Pat. Cas. 527, 2 Pittsb. (Pa.) 73; *Crown Cork, etc., Co. v. Aluminum Stopper Co.*, 96 Off. Gaz. 2573.

Negligence of attorney is no excuse for delay. *Lay v. Indianapolis Brush, etc., Mfg. Co.*, 120 Fed. 831, 57 C. C. A. 313.

In England complete specification must be filed within nine months after provisional specification and unless accepted in twelve months is void. *Act* (1883), § 8.

82. *Western Electric Co. v. Sperry Electric Co.*, 58 Fed. 186, 7 C. C. A. 164; *McMillin v. Barclay*, 16 Fed. Cas. No. 8,902, 5 Fish. Pat. Cas. 189, 4 Brewst. (Pa.) 275, 3 Pittsb. (Pa.) 377.

83. Interfering patents see *infra*, VI, D.



a patent upon substantially the same patentable invention an interference is declared to exist, and the parties are permitted to present proofs in support of their claims.<sup>84</sup> The question to be determined is that of priority of invention.<sup>85</sup> Priority is ordinarily the only thing at issue.<sup>86</sup> The right of one of the parties to make a claim may be considered as an ancillary question.<sup>86a</sup> The question of patentability is not involved.<sup>87</sup> The proceedings are conducted under rules established by the commissioner,<sup>88</sup> but are analogous to proceedings in equity and the same rules of evidence are applicable.<sup>89</sup> The issue is construed in accordance with the specification of the party who first made the claim.<sup>90</sup>

**b. Between Applicants and Patentees.** An interference must always involve an application for a patent, but may be declared between an application and a patent previously granted to another for the same thing, for, although the patent office cannot cancel the patent already issued, it may issue a second patent to the real inventor.<sup>91</sup>

84. U. S. Rev. St. (1878) § 4904 [U. S. Comp. St. (1901) p. 3389].

There must be two claimants for the same invention or the interference fails. *Cushman v. Lines*, 10 App. Cas. (D. C.) 156; *Tyson v. Rankin*, 24 Fed. Cas. No. 14,320, *McArthur Pat. Cas.* 262; *Lattig v. Dean*, 117 Off. Gaz. 1793.

Failure to move to dissolve an interference on the ground that an accepted amendment to one of the applications involves new matter is an acquiescence in the allowance of the amendment. *Croskey v. Atterbury*, 9 App. Cas. (D. C.) 207.

Interference in fact.—*Christie v. Seybold*, 55 Fed. 69, 5 C. C. A. 33; *Bain v. Morse*, 2 Fed. Cas. No. 754, *McArthur Pat. Cas.* 90; *Nichols v. Harris*, 18 Fed. Cas. No. 10,244, *McArthur Pat. Cas.* 362; *Stephenson v. Hoyt*, 22 Fed. Cas. No. 13,373, *McArthur Pat. Cas.* 292. Interference in fact not determined by admissions. *Hutchinson v. Meyer*, 12 Fed. Cas. No. 6,957.

Lack of interference see *Podlesak v. McInnerney*, 26 App. Cas. (D. C.) 399, 120 Off. Gaz. 2127; *O'Reilly v. Smith*, 18 Fed. Cas. No. 10,566, *McArthur Pat. Cas.* 218; *Tyson v. Rankin*, 24 Fed. Cas. No. 14,320, *McArthur Pat. Cas.* 262; *Lallig v. Dean*, 117 Off. Gaz. 1796.

In Canada three arbitrators are appointed to determine. Each party appoints one, and the commissioner of patents appoints the third. *Pat. Act*, 35 Vict. c. 26, § 43; *Faller v. Ayley*, 8 Ont. L. Rep. 70, per Anglin, J.

85. U. S. Rev. St. (1878) § 4904 [U. S. Comp. St. (1901) p. 3389].

The question whether the disclosure in a party's application is sufficient is not in issue. *Bechman v. Southgate*, 28 App. Cas. (D. C.) 405; *Lotterhand v. Hanson*, 23 App. Cas. (D. C.) 372; *Schüpphaus v. Stevens*, 95 Off. Gaz. 1452; *Ostergren v. Tripler*, 95 Off. Gaz. 837; *Dodge v. Fowler*, 82 Off. Gaz. 595.

86. *Swihart v. Mauldin*, 19 App. Cas. (D. C.) 570; *Austin v. Johnson*, 18 App. Cas. (D. C.) 83; *Hisey v. Peters*, 6 App. Cas. (D. C.) 68, 71 Off. Gaz. 892; *Bechman v. Wood*, 89 Off. Gaz. 2462; *Hulett v. Long*, 89 Off. Gaz. 1141; *Cross v. Phillips*, 87 Off. Gaz. 1399; *Cushman v. Lines*, 78 Off. Gaz. 2051; *Westinghouse v. Duncan*, 66 Off. Gaz. 1009.

86a. *Podlesak v. McInnerney*, 26 App. Cas. (D. C.) 399; *Lindmark v. Hodgkinson*, 31 App. Cas. (D. C.) 612; *MacMulkin v. Bollee*, 30 App. Cas. (D. C.) 112; *U. S. Co. v. Moore*, 30 App. Cas. (D. C.) 464.

87. *Mell v. Midgley*, 31 App. Cas. (D. C.) 534; *Sobey v. Holsclaw*, 28 App. Cas. (D. C.) 65; *Johnson v. Mueser*, 29 App. Cas. (D. C.) 61; *Dunbar v. Schellenger*, 29 App. Cas. (D. C.) 129; *Slaughter v. Halle*, 21 App. Cas. (D. C.) 19; *Newton v. Woodward*, 16 App. Cas. (D. C.) 568; *McBerty v. Cook*, 16 App. Cas. (D. C.) 133; *Hill v. Hodge*, 12 App. Cas. (D. C.) 528, 83 Off. Gaz. 1211; *Doyle v. McRoberts*, 10 App. Cas. (D. C.) 445, 79 Off. Gaz. 1029; *Hisey v. Peters*, 6 App. Cas. (D. C.) 68, 71 Off. Gaz. 892; *Latham v. Armat*, 95 Off. Gaz. 232; *Hulett v. Long*, 89 Off. Gaz. 1141.

*Res judicata.*—Patentability is *res judicata*. *Herman v. Fullman*, 23 App. Cas. (D. C.) 259; *Chandler v. Ladd*, 5 Fed. Cas. No. 2,593, *McArthur Pat. Cas.* 493.

There must be an adjudication of patentability final to all ordinary intent and purposes before the court can be called upon to determine the right of ownership as between rival claimants. *Oliver v. Felbel*, 20 App. Cas. (D. C.) 255.

88. U. S. Rev. St. (1878) §§ 483, 4905 [U. S. Comp. St. (1901) pp. 272, 3390]; *Spears v. Abbott*, 22 Fed. Cas. No. 13,222; *Jones v. Starr*, 117 Off. Gaz. 1495; *Ross v. Loewer*, 77 Off. Gaz. 2141.

Time for taking testimony is within the discretion of commissioner of patents. *Hopkins v. Lewis*, 12 Fed. Cas. No. 6,688; *O'Reilly v. Smith*, 18 Fed. Cas. No. 10,566, *McArthur Pat. Cas.* 218; *Wellman v. Blood*, 29 Fed. Cas. No. 17,385, *McArthur Pat. Cas.* 432.

89. *Pract. Rule* 159; *Blackford v. Wilder*, 104 Off. Gaz. 580; *Nielson v. Bradshaw*, 91 Off. Gaz. 644.

90. *Podlesak v. McInnerney*, 26 App. Cas. (D. C.) 399, 120 Off. Gaz. 2127; *Tracy v. Leslie*, 14 App. Cas. (D. C.) 126, 87 Off. Gaz. 891; *Ruete v. Elwell*, 87 Off. Gaz. 2119. And see *Sobey v. Holsclaw*, 28 App. Cas. (D. C.) 65.

91. U. S. Rev. St. (1878) § 4904 [U. S. Comp. St. (1901) p. 3389]; *Pract. Rule* 93.



c. Evidence — (1) *BURDEN OF PROOF*. The burden of proof in an interference case is upon the party last to file his application,<sup>92</sup> and where his opponent has a patent granted before that filing date he must prove his case beyond a reasonable doubt.<sup>93</sup> But a preponderance of evidence will be sufficient where the question involved is to which one of the two parties making separate applications for patent does the right of original invention or discovery of the subject-matter in issue belong,<sup>94</sup> or where the application of the junior party was pending when a patent was granted to his adversary.<sup>95</sup> Where each of two parties to an interference claims a disclosure to the other, the presumption is in favor of the one who has a practical knowledge of the art, and against the one who has not such knowledge.<sup>96</sup>

92. *Duff v. Latshaw*, 31 App. Cas. (D. C.) 235; *Goolman v. Hobart*, 31 App. Cas. (D. C.) 286; *Smith v. Smith*, 31 App. Cas. (D. C.) 518; *Braunstein v. Holmes*, 30 App. Cas. (D. C.) 328; *Weeks v. Dale*, 30 App. Cas. (D. C.) 498; *Gibbons v. Peller*, 28 App. Cas. (D. C.) 530; *Lowrie v. Taylor*, 27 App. Cas. (D. C.) 522; *Cleveland v. Wilkin*, 27 App. Cas. (D. C.) 311; *Bourn v. Hill*, 27 App. Cas. (D. C.) 291; *Orcutt v. McDonald*, 27 App. Cas. (D. C.) 228; *Fowler v. Dyson*, 27 App. Cas. (D. C.) 52; *Ball v. Flora*, 26 App. Cas. (D. C.) 394; *Herman v. Fullman*, 23 App. Cas. (D. C.) 259; *Flora v. Powrie*, 23 App. Cas. (D. C.) 195; *McKnight v. Pohle*, 22 App. Cas. (D. C.) 219; *Flather v. Weber*, 21 App. Cas. (D. C.) 179; *Tyler v. Kelch*, 19 App. Cas. (D. C.) 180. And see *supra*, IV, A, 5.

**Priority of invention and reasonable diligence.**—He must show not only priority of invention, but also reasonable diligence in adapting and perfecting his invention. *Fowler v. Dyson*, 27 App. Cas. (D. C.) 52; *Ball v. Flora*, 26 App. Cas. (D. C.) 394; *Funk v. Haines*, 20 App. Cas. (D. C.) 285; *Hunter v. Stikeman*, 13 App. Cas. (D. C.) 214; *McCormack v. Cleal*, 12 App. Cas. (D. C.) 335.

**When burden of proof increased.**—The burden imposed upon an applicant in interference with a patentee is increased by adverse decisions of all the patent office tribunals. *Johnson v. Mueser*, 29 App. Cas. (D. C.) 61; *Parkes v. Lewis*, 28 App. Cas. (D. C.) 1; *Orcutt v. McDonald*, 27 App. Cas. (D. C.) 228; *Bauer v. Crone*, 26 App. Cas. (D. C.) 352; *Macdonald v. Edison*, 21 App. Cas. (D. C.) 527; *Hallwood v. Lalor*, 21 App. Cas. (D. C.) 61; *Swihart v. Mauldin*, 19 App. Cas. (D. C.) 570; *Gedge v. Cromwell*, 19 App. Cas. (D. C.) 192; *Howard v. Hey*, 18 App. Cas. (D. C.) 142.

**When burden shifts.**—Where the junior party to an interference shows by his evidence a disclosure and reduction to practice prior to the filing date of the senior party's application, the burden of proof is shifted to the senior party to establish a date of invention and reduction to practice prior to that of the junior party. *Herman v. Fullman*, 23 App. Cas. (D. C.) 259.

93. *McKnight v. Pohle*, 30 App. Cas. (D. C.) 92; *Weeks v. Dale*, 30 App. Cas. (D. C.) 498; *Lewis v. Cronemeyer*, 29 App. Cas. (D. C.) 174; *Shuman v. Beall*, 27 App. Cas. (D. C.) 324, 329; *Rolfe v. Hoffman*, 26

App. Cas. (D. C.) 336; *French v. Halcomb*, 26 App. Cas. (D. C.) 307; *Quist v. Ostrom*, 23 App. Cas. (D. C.) 69; *Sendelbach v. Gillette*, 22 App. Cas. (D. C.) 168; *Gallagher v. Hastings*, 21 App. Cas. (D. C.) 88; *Dashiell v. Tasker*, 21 App. Cas. (D. C.) 64; *Meyer v. Sarfert*, 21 App. Cas. (D. C.) 26; *Gedge v. Cromwell*, 19 App. Cas. (D. C.) 192; *Sharer v. McHenry*, 19 App. Cas. (D. C.) 158; *Reichenbach v. Kelley*, 17 App. Cas. (D. C.) 333; *Fefel v. Stocker*, 17 App. Cas. (D. C.) 317; *Locke v. Boch*, 17 App. Cas. (D. C.) 75; *Kelly v. Fynn*, 16 App. Cas. (D. C.) 573; *Nielson v. Bradshaw*, 16 App. Cas. (D. C.) 92; *Williams v. Ogle*, 14 App. Cas. (D. C.) 145; *Guilbert v. Killinger*, 13 App. Cas. (D. C.) 107; *Doyle v. McRoberts*, 10 App. Cas. (D. C.) 445; *Hill v. Parmelee*, 9 App. Cas. (D. C.) 503; *La Flare v. Chase*, 8 App. Cas. (D. C.) 83.

**A limitation on this doctrine is that where a patent was inadvertently granted to one party during the pendency of his opponent's application both parties are to be treated as if they were applicants.** *Cutler v. Leonard*, 31 App. Cas. (D. C.) 297; *Jansson v. Larson*, 30 App. Cas. (D. C.) 203; *De Ferranti v. Lyndmark*, 30 App. Cas. (D. C.) 417; *Fenner v. Blake*, 30 App. Cas. (D. C.) 507; *Shaffer v. Dolan*, 23 App. Cas. (D. C.) 79; *Watson v. Thomas*, 23 App. Cas. (D. C.) 65; *Miehle v. Read*, 18 App. Cas. (D. C.) 128; *Hulett v. Long*, 15 App. Cas. (D. C.) 284; *Esty v. Newton*, 14 App. Cas. (D. C.) 50; *Hunt v. McCaslin*, 10 App. Cas. (D. C.) 527; *Paul v. Hess*, 115 Off. Gaz. 251; *Furman v. Dean*, 114 Off. Gaz. 1552.

**Disclosure to patentee.**—A junior applicant in interference, if he would prevail on the ground that he disclosed the invention to his rival, who has received a patent, must prove such disclosure beyond a reasonable doubt. *Anderson v. Wells*, 27 App. Cas. (D. C.) 115.

94. *Flather v. Weber*, 21 App. Cas. (D. C.) 179.

95. *Andrews v. Nilson*, 27 App. Cas. (D. C.) 451.

**Burden not increased.**—The burden of proof imposed on a junior applicant in interference proceedings is not increased by the granting of a patent to his opponents while his application is pending. *Laas v. Scott*, 26 App. Cas. (D. C.) 354.

96. *Alexander v. Blackman*, 26 App. Cas. (D. C.) 541.



(ii) *ADMISSIBILITY AND WEIGHT AND SUFFICIENCY.* In deciding the question of priority of invention the ordinary rules as to the admissibility<sup>97</sup> and weight of evidence are applied.<sup>98</sup> Corroboration by independent circumstances is necessary.<sup>99</sup>

d. *Pleadings.* If a party to an interference wishes to take testimony to show

97. *Nielson v. Bradshaw*, 16 App. Cas. (D. C.) 92, 91 Off. Gaz. 644.

The evidence must relate to the relative rights of the parties involved and evidence that some third party was prior to both is irrelevant. *Brown v. Blood*, 22 App. Cas. (D. C.) 216; *Garrels v. Freeman*, 21 App. Cas. (D. C.) 207; *Foster v. Antisdell*, 14 App. Cas. (D. C.) 552; *Yearsley v. Brookfield*, 30 Fed. Cas. No. 18,131, *McArthur Pat. Cas.* 193.

That the proofs must conform to the issue see *Gibbons v. Peller*, 28 App. Cas. (D. C.) 530; *McKnight v. Pohle*, 22 App. Cas. (D. C.) 219; *Sachs v. Hundhausen*, 21 App. Cas. (D. C.) 511; *Blackford v. Wilder*, 21 App. Cas. (D. C.) 1; *Tracy v. Leslie*, 14 App. Cas. (D. C.) 126; *Mergenthaler v. Scudder*, 11 App. Cas. (D. C.) 264.

*Ex parte affidavits* filed after the close of the taking of testimony to correct alleged errors and deficiencies in the testimony will not be considered. *Blackford v. Wilder*, 104 Off. Gaz. 580; *Nielson v. Bradshaw*, 91 Off. Gaz. 644.

Exhibits offered may be examined microscopically. *Flora v. Powrie*, 23 App. Cas. (D. C.) 195.

Depositions not taken in accordance with the rules will not be considered. *Arnold v. Bishop*, 1 Fed. Cas. No. 552, *Cranch Pat. Dec.* 109, *McArthur Pat. Cas.* 36; *Perry v. Cornell*, 19 Fed. Cas. No. 11,001, *Cranch Pat. Dec.* 130, *McArthur Pat. Cas.* 66; *Jones v. Starr*, 117 Off. Gaz. 1495.

Testimony in one interference is admissible in a second, although a new party is added. *Carter v. Carter*, 5 Fed. Cas. No. 2,475, *McArthur Pat. Cas.* 388; *Eames v. Richards*, 8 Fed. Cas. No. 4,240.

Testimony of inventor is admissible and so is proof of declaration by him. *Yearsley v. Brookfield*, 30 Fed. Cas. No. 18,131, *McArthur Pat. Cas.* 193.

An inventor who has assigned his rights is not a competent witness nor is his wife. *Eames v. Richards*, 8 Fed. Cas. No. 4,240.

Objections to testimony must be made at proper time. *Allen v. Alter*, 1 Fed. Cas. No. 212; *Brown v. Hall*, 4 Fed. Cas. No. 2,008, 6 *Blatchf.* 401, 3 *Fish. Pat. Cas.* 531; *Smith v. Flickenger*, 22 Fed. Cas. No. 13,047, *Cranch Pat. Dec.* 116, *McArthur Pat. Cas.* 46. Technical objections must be taken before hearing. *Meyer v. Rothe*, 13 App. Cas. (D. C.) 97.

98. Signing opponent's application as a witness is strong evidence in favor of the latter. *Pickles v. Aglar*, 13 App. Cas. (D. C.) 556; *Barr Car Co. v. Chicago, etc., R. Co.*, 110 Fed. 972, 49 C. C. A. 194.

Taking assignment from opponent is evidence against a party. *Winslow v. Austin*, 14 App. Cas. (D. C.) 137.

Failure of party to deny allegation of disclosure to him by opponent is conclusive against him. *Ingersoll v. Holt*, 15 App. Cas. (D. C.) 519; *Winslow v. Austin*, 14 App. Cas. (D. C.) 137.

Long delay in making application casts doubt on claims of early invention. *Fefel v. Stocker*, 17 App. Cas. (D. C.) 317; *Nielson v. Bradshaw*, 16 App. Cas. (D. C.) 92; *Beals v. Finkenbinder*, 12 App. Cas. (D. C.) 23; *Hunt v. McCaslin*, 10 App. Cas. (D. C.) 527.

Unsupported recollections of witnesses as to facts occurring several years before are insufficient to establish priority of invention over an earlier patent. *Brooks v. Sacks*, 81 Fed. 403, 26 C. C. A. 456. And see *Caster Socket Co. v. Clark*, 110 Fed. 976.

The unsupported testimony of the inventor or of two joint inventors will not be accepted as sufficient proof. *Durkee v. Winquist*, 31 App. Cas. (D. C.) 248; *Taylor v. Lowrie*, 27 App. Cas. (D. C.) 527; *French v. Halcomb*, 26 App. Cas. (D. C.) 307; *Garrels v. Freeman*, 21 App. Cas. (D. C.) 207; *Petrie v. De Schweinitz*, 19 App. Cas. (D. C.) 386; *Sharer v. McHenry*, 19 App. Cas. (D. C.) 158; *Mergenthaler v. Scudder*, 11 App. Cas. (D. C.) 264; *Fay v. Mason*, 120 Fed. 506 [*reversed* on other grounds in 127 Fed. 325, 62 C. C. A. 159].

99. *Podlesak v. McInnerney*, 26 App. Cas. (D. C.) 399, 120 Off. Gaz. 2127.

Failure to rebut sworn statement of disclosure.—The rule that the failure of a party to an interference to rebut the sworn statement of his adversary that he had fully disclosed the invention to him furnishes strong evidence that the latter is not the prior inventor does not apply where there is no evidence of a complete disclosure, and merely unsatisfactory evidence of a partial disclosure. *Podlesak v. McInnerney*, 26 App. Cas. (D. C.) 399, 120 Off. Gaz. 2127.

Sufficiency of memorandum to prove prior conception see *French v. Halcomb*, 26 App. Cas. (D. C.) 307.

Conduct inconsistent with claims see *Talbot v. Monell*, 23 App. Cas. (D. C.) 108; *Adams v. Murphy*, 18 App. Cas. (D. C.) 172; *Reichenbach v. Kelley*, 17 App. Cas. (D. C.) 333; *Warner v. Smith*, 13 App. Cas. (D. C.) 111; *Hill v. Parmelee*, 9 App. Cas. (D. C.) 503; *Wells v. Reynolds*, 4 App. Cas. (D. C.) 43; *Barr Car Co. v. Chicago, etc., R. Co.*, 110 Fed. 972, 49 C. C. A. 194; *Jenner v. Dickinson*, 117 Off. Gaz. 600; *Harter v. Barrett*, 114 Off. Gaz. 975; *Hillard v. Brooks*, 111 Off. Gaz. 302.

Evidence held sufficient to support claim see *Turnbull v. Curtis*, 27 App. Cas. (D. C.) 567.

Evidence insufficient to show interference.—*Podlesak v. McInnerney*, 26 App. Cas. (D. C.) 399, 120 Off. Gaz. 2127.



invention before his application date, he must file in the patent office a statement within a time fixed and before seeing his opponent's case setting forth the dates of his conception and development of his invention.<sup>1</sup> Such statements correspond to the pleadings, and the party will not be permitted to prove a date earlier than alleged therein.<sup>2</sup> The statements are not considered as proofs.<sup>3</sup>

**e. Second Interference.** The power of the commissioner is not exhausted by once deciding a question of interference;<sup>4</sup> but where cause is shown, he may permit the unsuccessful party to withdraw his application, and refile it and then declare anew an interference between the same parties.<sup>5</sup>

**9. APPEAL — a. In General.** A party dissatisfied with the rejection of his claims by the primary examiner or with the decision in an interference case may appeal to the board of examiners-in-chief;<sup>6</sup> if dissatisfied with their decision he may appeal to the commissioner in person;<sup>7</sup> and if dissatisfied with his decision he may appeal to the court of appeals of the District of Columbia.<sup>8</sup> No appeal lies to the supreme court from the court of appeals, in a case brought up from the patent office.<sup>9</sup> There is no appeal to the secretary of the interior from the commissioner's action granting or refusing patents and he cannot control in any way such action.<sup>10</sup>

**b. Who Entitled to Appeal.** One to whom a patent is allowed has no grounds

Admissions as proving disclosure see *Henry v. Doble*, 27 App. Cas. (D. C.) 33.

1. Pract. Rule 110.

Amendment of the statement may be permitted in the discretion of the commissioner upon proper showing. *Cross v. Phillips*, 14 App. Cas. (D. C.) 228; *Stevens v. Seher*, 11 App. Cas. (D. C.) 245; *Parker v. Appert*, 8 App. Cas. (D. C.) 270.

For variance between allegations and proofs see *Herman v. Fullman*, 23 App. Cas. (D. C.) 259; *Shaffer v. Dolan*, 23 App. Cas. (D. C.) 79.

2. Pract. Rule 110; *Parkes v. Lewis*, 28 App. Cas. (D. C.) 1; *Lowrie v. Taylor*, 27 App. Cas. (D. C.) 522; *Neth v. Ohmer*, 27 App. Cas. (D. C.) 319; *Fowler v. Boyce*, 27 App. Cas. (D. C.) 48; *Fowler v. McBerty*, 27 App. Cas. (D. C.) 41, 46; *Funk v. Haines*, 20 App. Cas. (D. C.) 285; *Bader v. Vajen*, 14 App. Cas. (D. C.) 241; *Cross v. Phillips*, 14 App. Cas. (D. C.) 228; *Stevens v. Seher*, 11 App. Cas. (D. C.) 245; *Colhoun v. Hodgson*, 5 App. Cas. (D. C.) 21; *Hammond v. Basch*, 115 Off. Gaz. 804.

Where the commissioner has refused to permit an amendment of the statement, evidence to show dates other than those given in the statement are inadmissible. *Fowler v. Boyce*, 27 App. Cas. (D. C.) 55; *Fowler v. Dyson*, 27 App. Cas. (D. C.) 52; *Fowler v. McBerty*, 27 App. Cas. (D. C.) 41, 46. The rule will not be ignored, with the consent of the counsel, unless expressly approved by the commissioner of patents or his representatives. While cases may often arise where the interest of the parties to interference proceedings and the public will be best subserved by permitting dates earlier than those set forth in the preliminary statements to be proved, this should be done under the supervision of and with the approval of the patent office. *Fowler v. Boyce*, *supra*.

3. *Ingersoll v. Holt*, 15 App. Cas. (D. C.) 519.

4. *Matthews v. Wade*, 16 Fed. Cas. No. 9,292, *McArthur Pat. Cas.* 143; *Potter v. Dixon*, 19 Fed. Cas. No. 11,325, 5 *Blatchf.* 160, 2 *Fish. Pat. Cas.* 381.

5. *Matthews v. Wade*, 16 Fed. Cas. No. 9,292, *McArthur Pat. Cas.* 143.

6. U. S. Rev. St. (1878) § 4909 [U. S. Comp. St. (1901) p. 3390]; U. S. v. Allen, 192 U. S. 543, 24 S. Ct. 416, 48 L. ed. 555.

Appeals in interference and from rejection of claims are separate and distinct rights. *Hisey v. Peters*, 6 App. Cas. (D. C.) 68.

7. U. S. Rev. St. (1878) § 4910 [U. S. Comp. St. (1901) p. 3391].

Assistant commissioner may hear and decide appeals. *U. S. v. Duell*, 17 App. Cas. (D. C.) 575.

8. U. S. Rev. St. (1878) § 4911, and U. S. St. at L. p. 436, § 9, 27 U. S. St. at L. 436 [U. S. Comp. St. (1901) p. 3391]; *Butterworth v. U. S.*, 112 U. S. 50, 5 S. Ct. 25, 28 L. ed. 656.

Constitutionality of statutes.—Statute permitting appeals to the court of appeals is constitutional. *U. S. v. Duell*, 13 App. Cas. (D. C.) 379 [affirmed in 86 Off. Gaz. 995]; *U. S. v. Seymour*, 10 App. Cas. (D. C.) 294.

Appeal not a proceeding in equity.—An appeal to this court in an interference case is not a proceeding in equity, and the provisions of U. S. Rev. St. (1878) § 4915 [U. S. Comp. St. (1901) p. 3392], providing for relief by a bill in equity where the patent has been finally refused, do not apply. It is a proceeding at law, and hence a decision of the supreme court of the United States as to the statute referred to does not apply. *Sobey v. Holsclaw*, 28 App. Cas. (D. C.) 65.

9. *Rousseau v. Brown*, 21 App. Cas. (D. C.) 73.

10. *U. S. v. Seymour*, 10 App. Cas. (D. C.) 294; *Butterworth v. U. S.*, 112 U. S. 50, 5 S. Ct. 25, 28 L. ed. 656; *U. S. v. Duell*, 86 Off. Gaz. 995.



for appeal.<sup>11</sup> There is a conflict of authority as to whether a patentee may appeal from an adverse decision in interference proceedings; while there are some decisions affirming the right of appeal,<sup>12</sup> the weight of authority is against it,<sup>13</sup> it being said that a decision awarding priority to the applicant and granting him a patent does not invalidate the existing patent.<sup>14</sup>

**c. Formalities and Proceedings.** The appellant must file in the patent office within a fixed time a notice of appeal to the court of appeals together with his reasons of appeal specifically set forth in writing and within a fixed time thereafter must file in court a certified copy of all the original papers and evidence in the case.<sup>15</sup> The commissioner must furnish the court with a statement in writing of the grounds for his decision touching the points involved in the reasons of appeal.<sup>16</sup> The commissioner and examiners may be examined orally by the court.<sup>17</sup> Officers of the patent office may attend the hearing and advise the court.<sup>18</sup>

**d. Appealable Decisions.** An action which amounts to a final refusal of a patent as requested is to be regarded as a rejection and appealable whatever form that action may take.<sup>19</sup> The refusal to entertain an application is a rejection,<sup>20</sup> and the requirement that an application be divided is a rejection and appealable.<sup>21</sup> Mere interlocutory or preliminary rulings or orders are not appealable but only final decisions.<sup>22</sup> A rejection or decision by the commissioner is appealable even where there has been no decision in the case by the examiner or examiners-in-chief.<sup>23</sup> A refusal of a rehearing is not appealable;<sup>24</sup> nor is a decision dissolving

11. *Cushman v. Lines*, 10 App. Cas. (D. C.) 156.

12. *Babcock v. Degener*, 2 Fed. Cas. No. 698, McArthur Pat. Cas. 607; *Beach v. Tucker*, 2 Fed. Cas. No. 1,153.

13. *Drake v. Cunningham*, 7 Fed. Cas. No. 4,060, McArthur Pat. Cas. 378; *Hopkins v. Barnum*, 12 Fed. Cas. No. 6,685, McArthur Pat. Cas. 334; *Pomeroy v. Connison*, 19 Fed. Cas. No. 11,259, Cranch Pat. Dec. 112, McArthur Pat. Cas. 40; *Whipple v. Renton*, 29 Fed. Cas. No. 17,521, McArthur Pat. Cas. 332.

14. *Pomeroy v. Connison*, 19 Fed. Cas. No. 11,259, Cranch Pat. Dec. 112, McArthur Pat. Cas. 40.

15. U. S. Rev. St. (1878) §§ 4912, 4913 [U. S. Comp. St. (1901) p. 3391].

Reasons of appeal must be clear and definite. *Blackinton v. Douglass*, 3 Fed. Cas. No. 1,470, McArthur Pat. Cas. 622; *Greenough v. Clark*, 10 Fed. Cas. No. 5,784, McArthur Pat. Cas. 173.

16. U. S. Rev. St. (1878) § 4913 [U. S. Comp. St. (1901) p. 3391]; *Chandler v. Ladd*, 5 Fed. Cas. No. 2,593, McArthur Pat. Cas. 493; *In re Henry*, 11 Fed. Cas. No. 6,371, McArthur Pat. Cas. 467.

17. U. S. Rev. St. (1878) § 4913; *Richardson v. Hicks*, 20 Fed. Cas. No. 11,783, McArthur Pat. Cas. 335; *In re Seely*, 21 Fed. Cas. No. 12,632, McArthur Pat. Cas. 248.

18. *Perry v. Cornell*, 19 Fed. Cas. No. 11,001, Cranch Pat. Dec. 130, McArthur Pat. Cas. 66.

19. U. S. v. *Allen*, 192 U. S. 543, 24 S. Ct. 416, 48 L. ed. 555; *Holloway v. Whiteley*, 4 Wall. (U. S.) 522, 18 L. ed. 335.

20. *Holloway v. Whiteley*, 4 Wall. (U. S.) 522, 18 L. ed. 335.

21. *Ex p. Frasch*, 192 U. S. 566, 24 S. Ct. 424, 48 L. ed. 564; U. S. v. *Allen*, 192 U. S.

543, 24 S. Ct. 416, 48 L. ed. 555 [*overruling In re Frasch*, 20 App. Cas. (D. C.) 298; *Blackford v. Wilder*, 104 Off. Gaz. 582].

22. *Davis v. Garrett*, 28 App. Cas. (D. C.) 9; *Jones v. Starr*, 26 App. Cas. (D. C.) 64; *Herman v. Fullman*, 23 App. Cas. (D. C.) 259; *Hulett v. Long*, 15 App. Cas. (D. C.) 284; *Cross v. Phillips*, 14 App. Cas. (D. C.) 228; *In re Marshutz*, 13 App. Cas. (D. C.) 228; *In re Neill*, 11 App. Cas. (D. C.) 584; *Westinghouse v. Duncan*, 2 App. Cas. (D. C.) 131; *In re Chinnock*, 21 D. C. 594; *Allen v. U. S.*, 116 Off. Gaz. 2253; *Hillard v. Brooks*, 111 Off. Gaz. 302; *Luger v. Brown*, 104 Off. Gaz. 1123; *Swihart v. Mauldin*, 99 Off. Gaz. 2322.

**Application of rule.**—A motion to dissolve an interference in the patent office before the final hearing of the question of priority, and before the case is ready for such hearing, is an interlocutory proceeding, and is not appealable to the court of appeals unless made so by statute or rule of court. *Allen v. U. S.*, 26 App. Cas. (D. C.) 8.

23. *Holloway v. Whiteley*, 4 Wall. (U. S.) 522, 18 L. ed. 335; *In re Chambers*, 5 Fed. Cas. No. 2,581, McArthur Pat. Cas. 641; *Snowden v. Pierce*, 22 Fed. Cas. No. 13,151, 2 Hayw. & H. 386. See, however, *Ex p. Frasch*, 192 U. S. 566, 24 S. Ct. 424, 48 L. ed. 564; and the *dictum* to the contrary in *Westinghouse v. Duncan*, 2 App. Cas. (D. C.) 131.

24. *Greenwood v. Dover*, 23 App. Cas. (D. C.) 251; *Ross v. Loewer*, 9 App. Cas. (D. C.) 563; *In re Janney*, 13 Fed. Cas. No. 7,209, Cranch Pat. Dec. 143, McArthur Pat. Cas. 86; *In re Rouse*, 20 Fed. Cas. No. 12,686, McArthur Pat. Cas. 286.

**Refusal by commissioner to reopen case and his action suppressing testimony for irregularity are not appealable.** *Jones v. Starr*, 117 Off. Gaz. 1495.



an interference.<sup>25</sup> The reasons for a decision are not appealable, but only the decision itself.<sup>26</sup>

**e. Review.** On appeal from the decision of the commissioner of patents the court is limited to the points involved in the reasons of appeal.<sup>27</sup> And the exercise of the discretion of the commissioner of patents should not be disturbed save where that discretion has palpably been abused.<sup>28</sup> Except in extraordinary cases, the court will not disturb the findings of fact of the patent office. Nevertheless the court is not bound by the conclusions drawn from such facts, unless convinced that such conclusions are correct.<sup>29</sup> The question of identity of invention is in general one which should be settled by the experts of the patent office, and not by the court.<sup>30</sup> And the question of the operativeness of the device cannot be considered by this court as an incident of the main question of priority.<sup>31</sup> So the court will not consider the patentability of the invention, the question in interference cases being one of priority and not of patentability.<sup>32</sup> The unanimous decision of the patent office will not be reversed except for clear error.<sup>33</sup> It will not be reversed on any mere question of doubt whether it be correct or not.<sup>34</sup> If the decision of the commissioner is correct the fact that his opinion is erroneous

25. *Herman v. Fullman*, 23 App. Cas. (D. C.) 259; *Cushman v. Lines*, 10 App. Cas. (D. C.) 156; *Hillard v. Brooks*, 111 Off. Gaz. 302. *Contra*, see *Carter v. Carter*, 5 Fed. Cas. No. 2,475, *McArthur Pat. Cas.* 388; *King v. Gedney*, 14 Fed. Cas. No. 7,795, *McArthur Pat. Cas.* 443.

26. *In re Aiken*, 1 Fed. Cas. No. 107, *McArthur Pat. Cas.* 126; *In re Crooker*, 6 Fed. Cas. No. 3,414, *McArthur Pat. Cas.* 134; *Ex p. Spence*, 22 Fed. Cas. No. 13,228.

Mere comments by the commissioner in his decision are not appealable. *In re Freeman*, 23 App. Cas. (D. C.) 226.

27. *In re Conklin*, 1 *McArthur (D. C.)* 375; *In re Aiken*, 1 Fed. Cas. No. 107, *McArthur Pat. Cas.* 126; *Arnold v. Bishop*, 1 Fed. Cas. No. 553, *McArthur Pat. Cas.* 36, *Cranch Pat. Dec.* 109; *Burlew v. O'Neil*, 4 Fed. Cas. No. 2,167, *McArthur Pat. Cas.* 168.

New matter is not considered. *In re Jackson*, 13 Fed. Cas. No. 7,126, *McArthur Pat. Cas.* 485; *In re Jewett*, 13 Fed. Cas. No. 7,308, *McArthur Pat. Cas.* 259; *Ex p. Sanders*, 21 Fed. Cas. No. 12,292; *Sturtevant v. Greenough*, 23 Fed. Cas. No. 13,579.

28. *Davis v. Garrett*, 28 App. Cas. (D. C.) 9; *In re Frasch*, 27 App. Cas. (D. C.) 25. And see *Jones v. Starr*, 26 App. Cas. (D. C.) 64.

**Extent of oral argument.**—The court cannot control the action of the commissioner of patents in a discretionary matter, such as the extent of oral argument to be permitted at a hearing of an interference. *Sobey v. Holsclaw*, 28 App. Cas. (D. C.) 65.

**Leave to amend.**—Whether leave shall be given to amend a preliminary statement is a matter that rests in the discretion of the commissioner of patents, and is not reviewable in the court of appeals, save possibly in a case of palpable abuse of that discretion. *Neth v. Ohmer*, 27 App. Cas. (D. C.) 319.

29. *O'Connell v. Schmidt*, 27 App. Cas. (D. C.) 77.

30. *Parkes v. Lewis*, 28 App. Cas.

(D. C.) 1. And see *Bechman v. Southgate*, 28 App. Cas. (D. C.) 405, holding that except in extreme cases this court will not go behind the declaration of interference in order to determine the question of identity of invention; and such a case is not presented where it appears that the assignee and employer of the junior and unsuccessful party, after the latter saw his rival's application and drawings, filed the junior party's application, with specifications reading very much like those of the senior party.

31. *Duryea v. Rice*, 28 App. Cas. (D. C.) 423.

32. *Orcutt v. McDonald*, 27 App. Cas. (D. C.) 228; *Hillard v. Brooks*, 23 App. Cas. (D. C.) 526; *Ostergreen v. Tripler*, 17 App. Cas. (D. C.) 557; *Schupphaus v. Stevens*, 17 App. Cas. (D. C.) 548; *Latham v. Armat*, 17 App. Cas. (D. C.) 345; *Newton v. Woodward*, 17 App. Cas. (D. C.) 34; *Westinghouse v. Duncan*, 2 App. Cas. (D. C.) 131; *Stone v. Pupin*, 100 Off. Gaz. 1113. See also *Potter v. McIntosh*, 28 App. Cas. (D. C.) 510; *Kreag v. Geen*, 28 App. Cas. (D. C.) 437; *Sobey v. Holsclaw*, 28 App. Cas. (D. C.) 65. But see *Burrows v. Wetherill*, 4 Fed. Cas. No. 2,208, *McArthur Pat. Cas.* 315; *Jones v. Wetherill*, 13 Fed. Cas. No. 7,508, *McArthur Pat. Cas.* 409; *Yearsley v. Brookfield*, 30 Fed. Cas. No. 18,131, *McArthur Pat. Cas.* 193.

33. *Parkes v. Lewis*, 28 App. Cas. (D. C.) 1; *Bourn v. Hill*, 27 App. Cas. (D. C.) 291; *Fowler v. McBerty*, 27 App. Cas. (D. C.) 41, 46; *Ball v. Flora*, 26 App. Cas. (D. C.) 394; *Flora v. Powrie*, 23 App. Cas. (D. C.) 195; *Talbott v. Monell*, 23 App. Cas. (D. C.) 108; *Cobb v. Goebel*, 23 App. Cas. (D. C.) 75.

**Unanimity in the patent office tribunals** imposes upon the appellant in this court the burden of showing very clearly that the commissioner erred in the final decision appealed from. *In re Clunies*, 28 App. Cas. (D. C.) 18; *Parkes v. Lewis*, 28 App. Cas. (D. C.) 1.

34. *Orcutt v. McDonald*, 27 App. Cas. (D. C.) 228.



is immaterial.<sup>35</sup> The court has no power to send the case back to take further proofs.<sup>36</sup>

**f. Time For Appeal.** Appeals must be taken from the patent office within one year,<sup>37</sup> or within a shorter period fixed in the decision.<sup>38</sup> Notice of appeal to the court of appeals from decisions of the commissioner must be given to the commissioner of patents within forty days from the date of the decision exclusive of Sundays and holidays.<sup>39</sup> A transcript of the record must be filed in the court of appeals within forty days thereafter.<sup>40</sup>

**10. CAVEATS — a. In General.** A caveat is simply notice that the one filing it claims to be the inventor of the subject-matter disclosed.<sup>41</sup> It entitles him to notice from the patent office if any one files an application for the same thing within the life of the caveat which is one year,<sup>42</sup> but it does not entitle him to notice of applications filed previously or subsequently.<sup>43</sup> Its purpose is to prevent the issue of a patent to another while the caveator is perfecting his invention.<sup>44</sup> But the fact that a patent is inadvertently granted while a caveat is pending does not of itself vacate the patent, or authorize the granting of a patent to the other party unless he shows priority of invention.<sup>45</sup> The caveat is not conclusive evidence that the invention is in part perfected; a person may choose to file a caveat while he is going on and making improvements upon an invention which he has already completed so as to be of practical utility.<sup>46</sup>

**b. By Whom Filed.** A caveat can be filed only by the actual inventor but may be filed by a foreigner as well as a citizen of the United States.<sup>47</sup>

**35. *In re Aiken*, 1 Fed. Cas. No. 107, McArthur Pat. Cas. 126; *In re Crooker*, 6 Fed. Cas. No. 3,414, McArthur Pat. Cas. 134.**

**36. *Ex p. Sanders*, 21 Fed. Cas. No. 12,292; *Blackford v. Wilder*, 104 Off. Gaz. 580.**

**37. U. S. Rev. St. (1878) § 4894.**

**Motion for rehearing does not extend time. *Ross v. Loewer*, 9 App. Cas. (D. C.) 563; *Ex p. Linton*, 15 Fed. Cas. No. 8,378.**

**Appellant entitled to time allowed by rules.**—An appeal from the decision of the commissioner of patents will not be dismissed because the appellant has availed himself of all the time allowed by the rules for taking and perfecting his appeal, although by so doing he necessarily prevents the hearing of the appeal until after the summer recess of the court. *Jones v. Starr*, 26 App. Cas. (D. C.) 64.

**Computation of time.**—Saturday half holidays do not count in computing time. *Ocuppaugh v. Norton*, 114 Off. Gaz. 545.

**38. U. S. Rev. St. (1878) § 4904 [U. S. Comp. St. (1901) p. 3389]; *Greenough v. Clark*, 10 Fed. Cas. No. 5,784, McArthur Pat. Cas. 173; *Justice v. Jones*, 14 Fed. Cas. No. 7,588, McArthur Pat. Cas. 635.**

**Power to limit time.**—The court has authority to limit the time for appeals. *In re Hien*, 166 U. S. 432, 17 S. Ct. 624, 41 L. ed. 1066.

**39. U. S. Rev. St. (1878) § 4912 [U. S. Comp. St. (1901) p. 3391]; *Pract. Rule* 149; *Ross v. Loewer*, 9 App. Cas. (D. C.) 563; *Hein v. Pungs*, 9 App. Cas. (D. C.) 492; *In re Bryant*, 9 App. Cas. (D. C.) 447.**

**40. Court of Appeals, rule 21.**

**41. U. S. Electric Co. v. Jamaica, etc., Co.**, 61 Fed. 655; *Hoe v. Kahler*, 12 Fed. 111, 20 Blatchf. 430; *Heath v. Hildreth*, 11 Fed. Cas. No. 6,309; *Ex p. Woodruff*, 30 Fed. Cas. No. 17,989.

**In Canada the law is substantially the same as that in the United States. *Pat. Act*, 35 Vict. c. 26, § 39.**

**In England a caveat is simply opposition at any stage to the grant of a patent to another. *In re Johnson*, 13 Ch. D. 398 note, 28 Wkly. Rep. 709 note; *In re Somerset*, 13 Ch. D. 397, 42 L. T. Rep. N. S. 635, 28 Wkly. Rep. 709. It entitles the caveator to notice. *Reg. v. Cutler*, 14 Q. B. 372 note, 68 E. C. L. 373, 3 C. & K. 215, 1 Starke 354, 2 E. C. L. 138; *Matter of Fawcett*, 2 De G. M. & G. 439, 51 Eng. Ch. 344, 42 Eng. Reprint 942.**

**42. U. S. Rev. St. (1878) § 4902 [U. S. Comp. St. (1901) p. 3388]; *Allen v. Hunter*, 1 Fed. Cas. No. 225, 6 McLean 303; *Bell v. Daniels*, 3 Fed. Cas. No. 1,247, 1 Bond 212, 1 Fish. Pat. Cas. 372.**

**Prior caveat.**—One who has filed a caveat cannot be prejudiced by the omission of the commissioner to give him notice of the application for a patent by one who had filed a prior caveat. *Phelps v. Brown*, 19 Fed. Cas. No. 11,072, 4 Blatchf. 362, 1 Fish. Pat. Cas. 479.

**43. U. S. Rev. St. (1878) § 4902 [U. S. Comp. St. (1901) p. 3388]; *Johnson v. Onion*, 13 Fed. Cas. No. 7,401, 4 Fish. Pat. Cas. 170, 3 Hughes 290.**

**44. *Allen v. Hunter*, 1 Fed. Cas. No. 225, 6 McLean 303.**

**45. *Cochrane v. Waterman*, 5 Fed. Cas. No. 2,929, Cranch Pat. Dec. 121, McArthur Pat. Cas. 52.**

**46. The invention is not necessarily imperfect when caveat is filed.**—*Johnson v. Root*, 13 Fed. Cas. No. 7,411, 1 Fish. Pat. Cas. 351; *Calhoun v. Hodgson*, 70 Off. Gaz. 276.

**47. U. S. Rev. St. (1878) § 4902, as amended March 3, 1903, 32 U. S. St. at L. 1227 [U. S. Comp. St. Suppl. (1905) p. 666].**



**11. SECRECY OF APPLICATIONS AND CAVEATS.** Applications for patents and caveats are preserved in secrecy by the patent office because of the express provisions of the federal statutes<sup>48</sup> that an inventor cannot be compelled to disclose a secret invention made or owned by him.<sup>49</sup>

**12. RIGHT TO INSPECT AND OBTAIN COPIES OF PATENT OFFICE RECORDS.** Any one making proper application therefor and paying the fees provided by law may obtain copies of all public records of the patent office;<sup>50</sup> but they cannot obtain copies of pending applications to which they are not parties except upon a proper showing made to the commissioner of the right to and necessity for the copies or upon the order of a competent court.<sup>51</sup>

**13. COPIES OF RECORDS.** Certified copies of records, books, papers, or drawings belonging to the patent office are received as evidence in all cases where the originals could be evidence;<sup>52</sup> and certified copies of the specifications and drawings of foreign letters patent in the United States patent office constitute *prima facie* evidence of the fact of the granting of such letters patent and of the date and contents thereof.<sup>53</sup>

**14. RULES OF PATENT OFFICE.** The rules of procedure established for the patent office have the force of law where not inconsistent with law and are binding upon the commissioner as well as upon applicants for patents.<sup>54</sup>

**15. CONCLUSIVENESS AND EFFECT OF PATENT OFFICE DECISIONS**<sup>55</sup>—**a. In General.** The decision of the commissioners of patents in the allowance and issue of a patent creates only a *prima facie* right, and is subject to examination by the courts;<sup>56</sup> but the commissioner of patents must abide by the decision of his prede-

48. U. S. Rev. St. (1878) § 4902 [U. S. Comp. St. (1901) p. 3388]; U. S. Rev. St. (1878) § 4908 [U. S. Comp. St. (1901) p. 3390].

49. Pract. Rule 15.

The rule of secrecy in the patent office has no application to investigation of caveat by courts. *Diamond Match Co. v. Oshkosh Match Works*, 63 Fed. 984.

In Canada all papers are open to inspection save caveats. Pat. Act, 35 Vict. c. 26, § 44.

50. U. S. v. *Butterworth Patent Com'r*, 81 Off. Gaz. 505; *In re Drawbaugh*, 66 Off. Gaz. 1451.

A rude and insulting demand is not a legal demand. *Boydén v. Burke*, 14 How. (U. S.) 575, 14 L. ed. 548.

In England an application to inspect provisional specification has been refused. *Tolson's Patent*, 6 De G. M. & G. 422, 4 Wkly. Rep. 518, 55 Eng. Ch. 329, 43 Eng. Reprint 1297.

51. U. S. v. *Patent Com'r*, 19 D. C. 223; U. S. v. *Butterworth Patent Com'r*, 81 Off. Gaz. 505; U. S. v. *Patent Com'r*, 62 Off. Gaz. 1968; U. S. v. *Patent Com'r*, 54 Off. Gaz. 267; U. S. v. *Hall*, 48 Off. Gaz. 1263.

52. U. S. Rev. St. (1878) § 892 [U. S. Comp. St. (1901) p. 673]; *Paine v. Trask*, 56 Fed. 231; *Toohey v. Harding*, 1 Fed. 174, 4 Hughes 253; *Johnson v. Beard*, 13 Fed. Cas. No. 7,371, 12 Ban. & A. 50, 8 Off. Gaz. 435.

A certified copy of the patent office record of an assignment is accepted in place of the original instrument. *Carpenter v. Eberhard Mfg. Co.*, 78 Fed. 127; *Standard Elevator Co. v. Crane Elevator Co.*, 76 Fed. 767, 22 C. C. A. 549; *National Folding-Box, etc., Co. v. American Paper Pail, etc., Co.*, 55 Fed. 488;

*Dederick v. Whitman Agricultural Co.*, 26 Fed. 763; *Brooks v. Jenkins*, 4 Fed. Cas. No. 1,953, 1 Fish. Pat. Rep. 41, 3 McLean 432; *Lee v. Blandy*, 15 Fed. Cas. No. 8,182, 1 Bond 361, 2 Fish. Pat. Cas. 89; *Parker v. Haworth*, 18 Fed. Cas. No. 10,738, 4 McLean 370, 2 Robb Pat. Cas. 725. *Contra*, see *National Cash Register Co. v. Navy Cash-Register Co.*, 99 Fed. 89; *International Tooth-Crown Co. v. Bennett*, 72 Fed. 169; *New York v. American Cable R. Co.*, 60 Fed. 1016, 9 C. C. A. 336; *Paine v. Trask*, 56 Fed. 231.

In Canada the law is like that of the United States. Pat. Act, 35 Vict. c. 26, § 2.

53. U. S. Rev. St. (1878) § 893 [U. S. Comp. St. (1901) p. 673]; *Schoerken v. Swift, etc., Co.*, 7 Fed. 469, 19 Blatchf. 209.

Certificate by acting commissioner is sufficient. *Woodworth v. Hall*, 30 Fed. Cas. No. 18,016, 2 Robb Pat. Cas. 495, 1 Woodb. & M. 248.

In England copy of foreign patent under seal of that country is proved without proof of official character of signer. *In re Betts*, 9 Jur. N. S. 137, 7 L. T. Rep. N. S. 577, 1 Moore P. C. N. S. 49, 1 New Rep. 137, 11 Wkly. Rep. 221, 15 Eng. Reprint 621.

54. U. S. Rev. St. (1878) § 483 [U. S. Comp. St. (1901) p. 272]; *Mell v. Midgley*, 31 App. Cas. (D. C.) 534; U. S. v. *Allen*, 22 App. Cas. (D. C.) 56; *O'Hara v. Hawes*, 18 Fed. Cas. No. 10,466.

55. On application for extension see *infra*, VII, B.

56. *Reckendorfer v. Faber*, 92 U. S. 347, 23 L. ed. 719; *Hayes-Young Tie Plate Co. v. St. Louis Transit Co.*, 137 Fed. 80, 70 C. C. A. 1; *Wilkins Shoe-Button Fastener Co. v. Webb*, 89 Fed. 982; *Allen v. Hunter*, 1 Fed. Cas. No. 225, 6 McLean 303; *Brooks v. Jenkins*, 4



cessor, granting a patent, so long as it is unreversed by a competent court.<sup>57</sup> Such being the *prima facie* presumption the burden of proof to establish a contrary conclusion is upon the opposite party.<sup>58</sup> If the proofs do not overcome this presumption, and the device is of such a character, or relates to such special and peculiar subject-matters, that it does not come within the range of common experience or judicial knowledge, the *prima facie* showing must stand.<sup>59</sup> This presumption in favor of the validity of a patent does not, however, obtain where the records and papers of the patent office show conclusively that the commissioner has acted without authority or has exceeded it,<sup>60</sup> or where his decision is impeached for fraud.<sup>61</sup> It cannot be shown, however, that the commissioner who granted the patent exceeded or irregularly exercised his authority, except by matter apparent on the face of the patent. The patent is conclusively valid until it is successfully impeached in a direct proceeding properly instituted for that purpose.<sup>62</sup> If there was fraud practised in obtaining the patent, that is a matter between the patent office and the patentee. The patent, although obtained by fraud, must be respected and enforced until reversed or annulled by some proceedings directly for that purpose. It is not exposed to the attacks of strangers or third persons for such reason.<sup>63</sup>

**b. As to Application and Procedure in Obtaining Patent.** In the absence of fraud, the issue of a patent is conclusive evidence that the statutory requirements as to the application and procedure in the patent office have been complied with.<sup>64</sup>

Fed. Cas. No. 1,953, Fish. Pat. Rep. 41, 3 McLean 432; Congress Rubber Co. v. American Elastic Cloth Co., 6 Fed. Cas. No. 3,099a; Potter v. Holland, 19 Fed. Cas. No. 11,330, 4 Blatchf. 238, 1 Fish. Pat. Cas. 382; Sands v. Wardwell, 21 Fed. Cas. No. 12,306, 3 Cliff. 277.

No court is bound by the decision of the patent office granting a patent when immediate steps are taken to test its validity in an action instituted for that purpose. Minneapolis Harvester Works v. McCormick Harvesting-Mach. Co., 28 Fed. 565.

**Conclusive as to state court.**—A patent conferred upon an inventor is conclusive of its own validity, and a state court cannot go behind it. Cowan v. Mitchell, 11 Heisk. (Tenn.) 87.

**Due heed and consideration must always be given by the court or jury, as the case may be, to this presumption, but the real question in all cases is whether or not the evidence in the case is or is not sufficient to overcome the *prima facie* presumption which the patent affords.** Los Angeles Art Organ Co. v. Aeolian Co., 143 Fed. 880, 75 C. C. A. 88.

**Joint patent *prima facie* evidence that all patentees participated in invention.**—Hotchkiss v. Greenwood, 12 Fed. Cas. No. 6,718, 4 McLean 456, 2 Robb Pat. Cas. 730 [affirmed in 11 How. 248, 13 L. ed. 633].

57. Matter of Hoevler, 21 D. C. 107; *Ex p.* Larowe, 14 Fed. Cas. No. 8,093; *Ex p.* Simpson, 22 Fed. Cas. No. 12,878.

58. Wilkins Shoe-Button Fastener Co. v. Webb, 89 Fed. 982; Sands v. Wardwell, 21 Fed. Cas. No. 12,306, 3 Cliff. 277. And see *supra*, V, C, 4, c; IV, A, 10, a; IV, C, 3.

59. Packard v. Laing-Stud Co., 70 Fed. 66, 16 C. C. A. 639, holding that the fact that no machine has been constructed or put into practical operation under a patent is not of itself sufficient to show the patent inopera-

tive, or to overcome the presumption of its validity arising from the fact of issuance.

60. Mahn v. Harwood, 112 U. S. 354, 5 S. Ct. 174, 6 S. Ct. 451, 28 L. ed. 665; Allen v. Blunt, 1 Fed. Cas. No. 216, 2 Robb Pat. Cas. 288, 3 Story 742; Whitely v. Swayne, 29 Fed. Cas. No. 17,568, 4 Fish. Pat. Cas. 117 [affirmed in 7 Wall. 685, 19 L. ed. 199].

The commissioner of patents is an officer of limited authority, whose jurisdiction is restricted to the particular cases mentioned in the statute; and therefore, whenever it is apparent upon inspection of the patents that he has acted without authority, or has exceeded it, his judgment must necessarily be regarded as invalid. Giant Powder Co. v. California Vigorit Powder Co., 4 Fed. 720, 6 Sawy. 508.

61. Allen v. Blunt, 1 Fed. Cas. No. 216, 2 Robb Pat. Cas. 288, 3 Story 742.

**Fraud must be shown *prima facie*.**—Where fraud is charged upon a party in respect to his patent, it must be made out at least *prima facie*. Goodyear v. Day, 10 Fed. Cas. No. 5,567.

62. Blackford v. Wilder, 28 App. Cas. (D. C.) 535; Dorsey Harvester Revolving Rake Co. v. Marsh, 7 Fed. Cas. No. 4,014, 6 Fish. Pat. Cas. 387, 9 Phila. (Pa.) 395.

63. Crompton v. Belknap Mills, 30 Fed. Cas. No. 18,285, 3 Fish. Pat. Cas. 536.

64. Philadelphia, etc., R. Co. v. Stimpson, 14 Pet. (U. S.) 448, 10 L. ed. 535; Calculagraph Co. v. Wilson, 132 Fed. 20 [reversed on other grounds in 144 Fed. 91, 75 C. C. A. 249]; Giant Powder Co. v. Safety Nitro Powder Co., 19 Fed. 509; Hoe v. Cottrell, 1 Fed. 597, 17 Blatchf. 546; McMillan v. Barclay, 16 Fed. Cas. No. 8,902, 5 Fish. Pat. Cas. 189, 4 Brewst. (Pa.) 275, 3 Pittsb. (Pa.) 377; Tarr v. Folsom, 23 Fed. Cas. No. 13,756, 1 Ban. & A. 24, Holmes 312, 5 Off. Gaz. 92. Compare Fassett v. Ewart Mfg. Co., 58 Fed. 360 [af-



c. **As to Patentability.** The decision of the patent office, upon an application for a patent, is never final upon the question of the novelty and utility of an invention. Upon reason and authority, the new patent granted after a hearing merely makes out a *prima facie* case for the successful applicant,<sup>65</sup> and the original presumptions of novelty and utility arising from the grant of a patent are strengthened by its extension.<sup>66</sup> Even where an interference is claimed, and as against the parties to the hearing, the commissioner's decision is not conclusive.<sup>67</sup> But while the decision of the commissioner of patents is not *res judicata* on the question of novelty, it is entitled to the highest respect,<sup>68</sup> and where patentable novelty has been denied by all the tribunals of the patent office, it will require a very clear case to obtain a reversal.<sup>69</sup> On the question of usefulness and cost of an invention, it has been held that the testimony of machinists and manufacturers having practical knowledge of the subject-matter is of greater weight than the opinion of the commissioner of patents.<sup>70</sup>

d. **As to Originality and Priority.** The issuance of a patent establishes *prima facie* the patentee's title as the original and first inventor.<sup>71</sup> So a previous deci-

firmed in 62 Fed. 404, 10 C. C. A. 441], holding that the action of the patent office in allowing a separation of claims into divisional applications is not conclusive, and the question whether the severance was proper and valid may be passed upon by the courts. See also McKay v. Dibert, 5 Fed. 587.

**As to giving notice and paying fees.**—A patent once granted cannot be subsequently impeached by evidence tending to show a want of compliance with the law as to giving notice, or paying fees, etc. Lamprey Boiler Furnace Mouth Protector Co. v. Economy Feed Water Heater Co., 62 Fed. 590 [affirmed in 65 Fed. 1000, 13 C. C. A. 271]; Tarr v. Folsom, 23 Fed. Cas. No. 13,756, 1 Ban. & A. 24, Holmes 312, 5 Off. Gaz. 92.

**As to taking of oaths.**—Recitals in letters patent in the absence of fraud are conclusive evidence that the necessary oaths were taken before the patent was granted. Seymour v. Osborne, 11 Wall. (U. S.) 516, 20 L. ed. 33; Hancock Inspirator Co. v. Jenks, 21 Fed. 911; De Florez v. Reynolds, 7 Fed. Cas. No. 3,742, 3 Ban. & A. 292, 14 Blatchf. 505. The fact that a blank form of oath not executed is found among the papers cannot overcome the direct recital of the letters patent that the oath was taken, or the presumption that the requirements of the law were complied with in issuing the patent. Crompton v. Belknap Mills, 30 Fed. Cas. No. 18,285, 3 Fish. Pat. Cas. 536.

**As to signatures.**—The presumption is that a patent is signed and countersigned rightly. Smith v. Mercer, 5 Pa. L. J. 529.

65. *Alabama.*—Stephenson v. Allison, 123 Ala. 439, 26 So. 290.

*Ohio.*—Clark v. Bentel, 9 Ohio Dec. (Reprint) 289, 12 Cinc. L. Bul. 53.

*South Carolina.*—Wright v. Wilson, 11 Rich. 144.

*Tennessee.*—Green v. Stuart, 7 Baxt. 418.

*United States.*—Boyd v. Janesville Hay-Tool Co., 158 U. S. 260, 15 S. Ct. 837, 39 L. ed. 973; National Mach. Co. v. Wheeler, etc., Mfg. Co., 72 Fed. 185 (holding that the fact that a party to an interference proceeding permits the decision to go against him by de-

fault does not make such decision conclusive against him upon the question of the patentability of the machine in a subsequent suit against him for infringement); Ney v. Ney Mfg. Co., 69 Fed. 405, 16 C. C. A. 293; Frankfort Whisky Process Co. v. Mill Creek Distilling Co., 37 Fed. 533; Shaver v. Skinner Mfg. Co., 30 Fed. 68; American Nicholson Pavement Co. v. Elizabeth, 1 Fed. Cas. No. 312, 4 Fish. Pat. Cas. 189; Goodyear v. Day, 10 Fed. Cas. No. 5,566; Serrell v. Collins, 21 Fed. Cas. No. 12,672, 1 Fish. Pat. Cas. 289; Spaulding v. Tucker, 22 Fed. Cas. No. 13,220, Deady 649 [reversed on other grounds in 13 Wall. 453, 20 L. ed. 515]; Union Paper-Bag Mach. Co. v. Crane, 24 Fed. Cas. No. 14,388, 1 Ban. & A. 494, Holmes 429, 6 Off. Gaz. 801.

See 38 Cent. Dig. tit. "Patents," § 164.

The issuance of patents on two applications which were pending at the same time, and relate to the same subject-matter, is in effect an adjudication by the patent office that there is a substantial difference between the inventions, and raises a presumption that the device of the later patent is not an infringement of the earlier one. Boyd v. Janesville Hay-Tool Co., 158 U. S. 260, 15 S. Ct. 837, 39 L. ed. 973.

66. Cook v. Ernest, 6 Fed. Cas. No. 3,155, 5 Fish. Pat. Cas. 396, 1 Woods 195, 2 Off. Gaz. 89; Evarts v. Ford, 8 Fed. Cas. No. 4,574, 6 Fish. Pat. Cas. 587, 5 Off. Gaz. 58.

67. Union Paper-Bag Mach. Co. v. Crane, 24 Fed. Cas. No. 14,388, 1 Ban. & A. 494, Holmes 429, 6 Off. Gaz. 801.

68. Boyden Power-Brake Co. v. Westinghouse Air-Brake Co., 70 Fed. 816, 17 C. C. A. 430; Cook v. Ernest, 6 Fed. Cas. No. 3,155, 5 Fish. Pat. Cas. 396, 1 Woods 195, 2 Off. Gaz. 89.

69. *In re* Beswick, 16 App. Cas. (D. C.) 345; *In re* Smith, 14 App. Cas. (D. C.) 181; *In re* Barratt, 11 App. Cas. (D. C.) 177.

70. *Ex p.* Arthur, 1 Fed. Cas. No. 563a.

71. Clark v. Bentel, 9 Ohio Dec. (Reprint) 289, 12 Cinc. L. Bul. 53; Maurice v. Devol, 23 W. Va. 247; Ashcroft v. Boston, etc., R. Co., 97 U. S. 189, 24 L. ed. 982; Smith v.



sion by the commissioner of patents in interference proceedings upon the question of fact as to priority of invention must be accepted as controlling, unless the contrary is established by testimony which, in character and amount, carries thorough conviction.<sup>72</sup> Much more is this effect to be given to the decision of the commissioner when it has been affirmed by the court of appeals of the District of Columbia.<sup>73</sup> While the decision of the patent office on this question is never final,<sup>74</sup> even as against the parties to an interference proceeding,<sup>75</sup> it is nevertheless entitled to sufficient weight in an infringement suit to cast the burden of proof on the party against whom it was rendered.<sup>76</sup> When the *prima facie* force of a patent as to priority of invention on the part of the patentee has been once destroyed by evidence of prior invention on the part of another, it cannot be restored by the patent itself, but only by specific testimony from witnesses.<sup>77</sup>

**e. As to Abandonment.** The action of the commissioner of patents in granting letters patent does not conclude the question whether there has been an abandonment.<sup>78</sup>

**16. REMEDY IN EQUITY FOR REFUSAL OF PATENT — a. In General.** Where there is an adverse decision by the court of appeals of the District of Columbia upon appeal from the commissioner in an application for patent or in an interference, the defeated party may file a bill in equity and retry the question.<sup>79</sup> The proceed-

Goodyear Dental Vulcanite Co., 93 U. S. 486, 23 L. ed. 952; Seymour v. Osborne, 11 Wall. (U. S.) 516, 20 L. ed. 33; Hale, etc., Mfg. Co. v. Oneonta, etc., R. Co., 129 Fed. 598; Carnegie Steel Co. v. Cambria Iron Co., 89 Fed. 721 [affirmed in 185 U. S. 403, 22 S. Ct. 698, 46 L. ed. 968]; Stonemetz Printers' Mach. Co. v. Brown Folding-Mach. Co., 57 Fed. 601; Pacific Cable R. Co. v. Butte City St. R. Co., 52 Fed. 863 [affirmed in 60 Fed. 90, 8 C. C. A. 484]; Aiken v. Dolan, 1 Fed. Cas. No. 110, 3 Fish. Pat. Cas. 197; Goodyear Dental Vulcanite Co. v. Gardiner, 10 Fed. Cas. No. 5,591, 3 Cliff. 408, 4 Fish. Pat. Cas. 224; Haskell v. Shoe Mach. Mfg. Co., 11 Fed. Cas. No. 6,194, 3 Ban. & A. 553, 15 Off. Gaz. 509; Johnson v. Root, 13 Fed. Cas. No. 7,409, 2 Cliff. 108, 2 Fish. Pat. Cas. 291; Sands v. Wardwell, 21 Fed. Cas. No. 12,306, 3 Cliff. 277; Spear v. Belson, 22 Fed. Cas. No. 13,223, McArthur Pat. Cas. 699 (holding that the issuance of a patent establishes *prima facie* the patentee's title as an original inventor, and he must be considered as such even in a subsequent interference proceeding in which prior invention by another is shown, unless there is proof either positive or presumptive that he had knowledge thereof); Tucker v. Tucker Mfg. Co., 24 Fed. Cas. No. 14,227, 2 Ban. & A. 401, 4 Cliff. 397, 10 Off. Gaz. 464.

**72.** Morgan v. Daniels, 153 U. S. 120, 14 S. Ct. 772, 38 L. ed. 657 [reversing 42 Fed. 451]; John R. Williams Co. v. Miller, etc., Mfg. Co., 107 Fed. 290; Standard Cartridge Co. v. Peters Cartridge Co., 77 Fed. 630, 23 C. C. A. 367 [affirming 69 Fed. 408]; Ecaubert v. Appleton, 67 Fed. 917, 15 C. C. A. 73.

The evidence must establish clearly the priority of a completed and useful machine over that of the patentee, or it is unavailing. To doubt upon this point is to resolve it in the negative. Parham v. American Button-hole, etc., Mach. Co., 18 Fed. Cas. No. 10,713, 4 Fish. Pat. Cas. 468.

**Mere suggestion of mistake insufficient.**—The decision of the commissioner of patents is not final on the question of the priority of invention, but the successful applicant will not be enjoined from receiving his patent upon the mere suggestion that the commissioner was mistaken. Whipple v. Miner, 15 Fed. 117.

**73.** R. Thomas, etc., Co. v. Electric Porcelain, etc., Co., 111 Fed. 923.

**74.** Hubel v. Tucker, 24 Fed. 701, 23 Blatchf. 297; Gloucester Isinglass, etc., Co. v. Brooks, 19 Fed. 426; Whipple v. Miner, 15 Fed. 117; Goodyear v. Day, 10 Fed. Cas. No. 5,566; Perry v. Starrett, 19 Fed. Cas. No. 11,012, 3 Ban. & A. 485, 14 Off. Gaz. 599; Union Paper-Bag Mach. Co. v. Crane, 24 Fed. Cas. No. 14,388, 1 Ban. & A. 494, Holmes 429, 6 Off. Gaz. 801.

**75.** Union Paper-Bag Mach. Co. v. Crane, 24 Fed. Cas. No. 14,388, 1 Ban. & A. 494, Holmes 429, 6 Off. Gaz. 801. But see Shuter v. Davis, 16 Fed. 564.

**76.** Smith v. Goodyear Dental Vulcanite Co., 93 U. S. 486, 23 L. ed. 952; Stonemetz Printers' Mach. Co. v. Brown Folding-Mach. Co., 57 Fed. 601 [affirmed in 58 Fed. 571, 7 C. C. A. 374]; Gloucester Isinglass, etc., Co. v. Brooks, 19 Fed. 426; Wire Book Sewing Mach. Co. v. Stevenson, 11 Fed. 155.

**77.** Barstow v. Swan, 2 Fed. Cas. No. 1,065.

**78.** Woodbury Patent Planing Mach. Co. v. Keith, 101 U. S. 479, 25 L. ed. 939; U. S. Rifle, etc., Co. v. Whitney Arms Co., 28 Fed. Cas. No. 16,793, 2 Ban. & A. 493, 14 Blatchf. 94, 11 Off. Gaz. 373 [affirmed in 118 U. S. 22, 6 S. Ct. 950, 30 L. ed. 531].

**79.** U. S. Rev. St. (1878) § 4915 [U. S. Comp. St. (1901) p. 3392]; Jones v. Starr, 26 App. Cas. (D. C.) 64; McKnight v. Metal Volatilization Co., 128 Fed. 51.

**Conditions precedent.**—Right of appeal must be exhausted. Kirk v. Patent Com'r, 5 Mackey (D. C.) 229.



ing is original in its nature and not appellate,<sup>80</sup> and new evidence may be presented.<sup>81</sup> In interference proceedings, whether a party not involved in the suit was the first inventor is not in issue.<sup>82</sup> The complainant is not entitled to a decree as a matter of right but must establish it.<sup>82a</sup> Where there is no interfering claimant a copy of the bill must be served upon the commissioner of patents, and in such case all costs and expenses of the proceedings must be paid by the complainant whether the decision is in his favor or not.<sup>83</sup> The court has no power to enjoin the commissioner from issuing a patent pending suit.<sup>84</sup> A judgment of the court that the applicant is entitled to a patent will authorize the commissioner to issue.<sup>85</sup>

**b. Time and Place of Suit.** The suit must be brought within one year,<sup>86</sup> and must be brought in the district in which defendant is an inhabitant or may be found.<sup>87</sup> The commissioner of patents is a resident of the District of Columbia and the suit must be brought there against him where there is no interfering party,<sup>88</sup> unless he consents to be sued in another district.<sup>89</sup>

**c. Burden of Proof.** In a suit in equity to obtain a patent, the burden is upon the complainant to prove his right beyond a reasonable doubt.<sup>90</sup>

## VI. REQUISITES AND VALIDITY OF LETTERS PATENT.<sup>91</sup>

**A. Form and Contents — 1. AS AN INSTRUMENT.** A patent is an instrument issued in the name of the United States of America, under the seal of the patent office, signed by the commissioner of patents, containing a short title or description of the invention or discovery indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years of the exclusive right to make, use, and vend the invention or discovery throughout the United States and the territories thereof, and must refer to the specification for the particulars thereof.<sup>92</sup> So, by the provisions of the statute, it is necessary that a

80. *Dover v. Greenwood*, 154 Fed. 854; *Minneapolis Harvester Works v. McCormick Harvesting-Mach. Co.*, 28 Fed. 565; *Butler v. Shaw*, 21 Fed. 321; *New York Belting, etc., Co. v. Sibley*, 15 Fed. 386; *Whipple v. Miner*, 15 Fed. 117; *In re Squire*, 22 Fed. Cas. No. 13,269, 3 Ban. & A. 133, 12 Off. Gaz. 1025.

Claims considered.—Complainant is confined to claims passed on by patent office. *Durham v. Seymour*, 6 App. Cas. (D. C.) 78; *Wheaton v. Kendall*, 85 Fed. 666.

81. *Durham v. Seymour*, 6 App. Cas. (D. C.) 78; *Christie v. Seybold*, 55 Fed. 69, 5 C. C. A. 33; *In re Squire*, 22 Fed. Cas. No. 13,269, 3 Ban. & A. 133, 12 Off. Gaz. 1025.

82. *Christie v. Seybold*, 55 Fed. 69, 5 C. C. A. 33.

**Questions of fact.**—Where the question which of two applicants for a patent for the same invention was the true inventor depends on questions of fact, the court, in an action brought under U. S. Rev. St. (1878) § 4915 [U. S. Comp. St. (1901) p. 3392], by the unsuccessful applicant to compel an issuance of the patent to him, must be very clearly satisfied that the decision of the patent office tribunals between the two was erroneous before it will be justified in reversing the same. *Gillette v. Sendelbach*, 146 Fed. 758, 77 C. C. A. 55.

82a. *Davis v. Garrett*, 152 Fed. 723.

83. U. S. Rev. St. (1878) § 4915 [U. S. Comp. St. (1901) p. 3392].

**Expenses** are paid by complainant only where there is no opposing party save the commissioner. *Butler v. Shaw*, 21 Fed. 321.

**Parties.**—In interference cases the com-

missioner is not a necessary party. *Graham v. Teter*, 25 Fed. 555. The secretary of the interior is not a proper party. *Kirk v. Patent Com'r*, 5 Mackey (D. C.) 229.

84. *Illingworth v. Atha*, 42 Fed. 141; *Whipple v. Miner*, 15 Fed. 117.

85. U. S. Rev. St. (1878) § 4915 [U. S. Comp. St. (1901) p. 3392].

**In an interference where the issue is not patentable** there can be no judgment. *Hill v. Wooster*, 132 U. S. 693, 10 S. Ct. 228, 33 L. ed. 502; *Leslie v. Tracy*, 100 Fed. 475.

86. U. S. Rev. St. (1878) § 4894.

**The statute relating to delay in prosecuting applications** applies to bill in equity. *Gandy v. Marble*, 122 U. S. 432, 7 S. Ct. 1290, 30 L. ed. 1223.

87. *Gandy v. Marble*, 122 U. S. 432, 7 S. Ct. 1290, 30 L. ed. 1223; *Bernardin v. Northall*, 77 Fed. 849; *Vermont Farm Mach. Co. v. Marble*, 20 Fed. 117.

88. *Butterworth v. Hill*, 114 U. S. 128, 5 S. Ct. 796, 29 L. ed. 119.

89. *Vermont Farm Mach. Co. v. Marble*, 20 Fed. 117.

90. *Durham v. Seymour*, 6 App. Cas. (D. C.) 78; *Morgan v. Daniels*, 153 U. S. 120, 14 S. Ct. 772, 38 L. ed. 657 [reversing 42 Fed. 451]; *Standard Cartridge Co. v. Peters Cartridge Co.*, 77 Fed. 630, 23 C. C. A. 367 [affirming 69 Fed. 408].

91. Decisions of United States courts as to validity as precedents for other courts see *Courts*, 11 Cyc. 752.

**Validity of agreement not to contest patent** see *Contracts*, 9 Cyc. 515.

92. U. S. Rev. St. (1878) § 4883, as



copy of the specification and drawings be annexed to the patent and form a part thereof.<sup>93</sup>

**2. RECORD.** The patent together with the specification must be recorded in the patent office in books kept for that purpose.<sup>94</sup>

**3. DATE OF ISSUE.** Every patent shall issue within three months from date of payment of final fee, which fee must be paid within six months from date of allowance and notice to applicant or to his agent.<sup>95</sup> A patent cannot be antedated.<sup>96</sup>

**B. Validity — 1. IN GENERAL.** Where the statutory requirements in the issue of the patent have not been complied with the patent is invalid and this may be shown at any time,<sup>97</sup> although as a general rule a patent is not subject to collateral attack for defects not appearing on the face of the patent.<sup>98</sup> As has already

amended April 11, 1902, 32 U. S. St. at L. 95 [U. S. Comp. St. Suppl. (1905) p. 662]; U. S. Rev. St. (1878) § 4884 [U. S. Comp. St. (1901) p. 3381]. Prior to the amendment of April 11, 1902, patents had to be signed by the secretary of the interior or an assistant secretary and had to be countersigned by the commissioner of patents, and a failure to comply with the statutory provisions, such as the omission of the signature of the secretary of the interior, is fatal to the validity of the patent. *Marsh v. Nichols*, 128 U. S. 605, 9 S. Ct. 168, 32 L. ed. 538.

The acting commissioner may sign patents. *Smith v. Mercer*, 22 Fed. Cas. No. 13,078, 5 Pa. L. J. 529; *Woodworth v. Hall*, 30 Fed. Cas. No. 18,016, 2 Robb Pat. Cas. 495, 1 Woodb. & M. 248.

In Canada the law is like that in the United States except that the time is six, twelve, or eighteen years as elected. Pat. Act, 35 Vict. c. 25, § 10.

93. U. S. Rev. St. (1878) § 4884 [U. S. Comp. St. (1901) p. 3381].

Drawing is part of patent. *Poupard v. Fardell*, 18 Wkly. Rep. 127; *Reg. v. La Force*, 4 Can. Exch. 14.

The drawings of a patent are not required to be working plans, but are merely illustrative, to be read in connection with the specification and claims, and a patented device will not be held inoperative merely because of imperfections in the drawing in respect to the dimensions or relative position of parts of the mechanism. *Wold v. Thayer*, 148 Fed. 227, 78 C. C. A. 350 [affirmed in 142 Fed. 776].

94. U. S. Rev. St. (1878) § 4883; *Wyeth v. Stone*, 30 Fed. Cas. No. 18,107, 2 Robb Pat. Cas. 23, 1 Story 273.

**English practice.**—Patent must be enrolled by patentee within the time fixed and cannot be kept secret. *In re Brough*, 7 Beav. 104, 29 Eng. Ch. 104, 49 Eng. Reprint 1002; *Ex p. Beek*, 1 Bro. Ch. 578, 28 Eng. Reprint 1308; *Ex p. Hoops*, 6 Ves. 599, 31 Eng. Reprint 1215. Master of rolls can correct only clerical errors. *In re Dismore*, 18 Beav. 538, 52 Eng. Reprint 211; *In re Sharp*, 3 Beav. 245, 10 L. J. Ch. 86, 43 Eng. Ch. 245, 49 Eng. Reprint 96; *In re Redmund*, 6 L. J. Ch. O. S. 183, 5 Russ. 44, 5 Eng. Ch. 44, 38 Eng. Reprint 943.

95. U. S. Rev. St. § 4885 as amended May 23, 1908, Public No. 132 [U. S. Comp. St.

(1901) p. 3382]. Where patentee refuses to accept patent because of error therein and it is canceled and an amended patent issued, it dates from amendment. *Railway Register Mfg. Co. v. North Hudson County R. Co.*, 23 Fed. 593.

Reallowance and issuance of patent more than six months after the first allowance does not invalidate it. *Western Electric Co. v. North Electric Co.*, 135 Fed. 79, 67 C. C. A. 553.

**English practice.**—Patent is effective when seal applied and before enrolment. *Devonshire v. Neill*, L. R. 2 Ir. 132, 146; *Russell v. Ledsam*, 9 Jur. 557, 14 L. J. Exch. 353, 14 M. & W. 574 [affirmed in 16 L. J. Exch. 145, 16 M. & W. 633 (affirmed in 1 H. L. Cas. 687, 9 Eng. Reprint 931)]. Patent not given date of foreign application under international convention unless requested within seven months. *Acetylene Illuminating Co. v. United Alkali Co.*, [1902] 1 Ch. 494, 71 L. J. Ch. 301, 50 Wkly. Rep. 361.

96. *Marsh v. Nichols*, 128 U. S. 605, 9 S. Ct. 168, 32 L. ed. 538; *Gramme Electrical Co. v. Arnoux, etc.*, *Electric Co.*, 17 Fed. 838, 21 Blatchf. 450.

97. *Kennedy v. Hazelton*, 128 U. S. 667, 9 S. Ct. 202, 32 L. ed. 576; *Marsh v. Nichols*, 128 U. S. 605, 9 S. Ct. 168, 32 L. ed. 538; *Eagleton Mfg. Co. v. West Bradley, etc.*, *Mfg. Co.*, 111 U. S. 490, 4 S. Ct. 593, 28 L. ed. 493; *Grant v. Raymond*, 6 Pet. (U. S.) 218, 8 L. ed. 376; *Moffitt v. Gaar*, 17 Fed. Cas. No. 9,690, 1 Bond 315, 1 Fish. Pat. Cas. 610. See *supra*, I, A, 4. Clerical error by patent office will not invalidate. *Deere v. Arnold*, 95 Fed. 169, 92 Fed. 186.

**Compliance with prerequisites** need not be recited. *Gear v. Grosvenor*, 10 Fed. Cas. No. 5,291, 6 Fish. Pat. Cas. 314, *Holmes* 215, 3 Off. Gaz. 380.

98. *Seymour v. Osborne*, 11 Wall. (U. S.) 516, 20 L. ed. 33; *Eureka Clothes Wringing Mach. Co. v. Bailey Washing, etc., Mach. Co.*, 11 Wall. (U. S.) 488, 20 L. ed. 209; *Providence Rubber Co. v. Goodyear*, 9 Wall. (U. S.) 788, 19 L. ed. 566; *Railway Register Mfg. Co. v. North Hudson County R. Co.*, 23 Fed. 593; *Hoe v. Cottrell*, 1 Fed. 597, 17 Blatchf. 546; *American Wood-Paper Co. v. Glens Falls Paper Co.*, 1 Fed. Cas. No. 321, 8 Blatchf. 513, 4 Fish. Pat. Cas. 324; *Birdsall v. McDonald*, 3 Fed. Cas. No. 1,434, 1 Ban. & A. 165, 6 Off. Gaz. 682; *Crompton v. Belknap*



been shown in previous chapters, it is invalid if any of the statutory bars to its grant existed.<sup>99</sup>

**2. SUFFICIENCY OF DESCRIPTION.** A patent is invalid if it does not disclose the invention with such clearness as to enable one skilled in the art to make and use it.<sup>1</sup>

**3. NAME OF PATENTEE.** Clerical errors in the name of the patentee will not render the patent void, provided the patent contains a description of him by which he can be identified.<sup>2</sup>

**4. DECEPTIVE PATENT—*a.* In General.** If there be a false suggestion of a material fact set forth in the specification, the patent is invalid.<sup>3</sup> Inaccuracies in

Mills, 6 Fed. Cas. No. 3,406, 3 Fish. Pat. Cas. 536; *Doughty v. West*, 7 Fed. Cas. No. 4,028, 6 Blatchf. 429, 3 Fish. Pat. Cas. 580; *Gear v. Grosvenor*, 10 Fed. Cas. No. 5,291, 6 Fish. Pat. Cas. 314, Holmes 215, 3 Off. Gaz. 380; *Tilghman v. Mitchell*, 23 Fed. Cas. No. 14,042, 9 Blatchf. 18, 4 Fish. Pat. Cas. 615 [*reversed* on other grounds in 19 Wall. 287, 22 L. ed. 125]. See *infra*, VI, E. See also *supra*, V, C, 15.

99. See *supra*, II; III.

Irregular grant of a subsequent patent for the same thing will not invalidate a patent. *Jones v. Sewall*, 13 Fed. Cas. No. 7,495, 3 Cliff. 563, 6 Fish. Pat. Cas. 343, 3 Off. Gaz. 630 [*reversed* on other grounds in 91 U. S. 171, 23 L. ed. 275].

In Canada a patent is void if not manufactured in Canada within two years and if importations are allowed after one year. St. 35 Vict. c. 26, § 28; 38 Vict. c. 14, § 2. Importation of parts will not invalidate. *Anderson Tire Co. v. American Dunlop Tire Co.*, 5 Can. Exch. 82. Trifling and accidental importation will not invalidate. *Consolidated Car Heating Co. v. Came*, 18 Quebec Super. Ct. 44.

1. See *supra*, I, A, 3; V, B, 2, a. And see *Stevens v. Seher*, 11 App. Cas. (D. C.) 245; *Béné v. Jeantet*, 129 U. S. 683, 9 S. Ct. 428, 32 L. ed. 803; *Wood v. Underhill*, 5 How. (U. S.) 1, 12 L. ed. 23; *Panzl v. Battle Island Paper Co.*, 138 Fed. 48, 70 C. C. A. 474 [*modifying* 132 Fed. 607]; *Windle v. Parks, etc.*, Mach. Co., 134 Fed. 381, 67 C. C. A. 363; *Matheson v. Campbell*, 78 Fed. 910, 24 C. C. A. 384.

The description is sufficient if it enables those skilled in the art to make it. *Dolbear v. American Bell Tel. Co.*, 126 U. S. 1, 8 S. Ct. 778, 31 L. ed. 863; *Lawther v. Hamilton*, 124 U. S. 1, 8 S. Ct. 342, 31 L. ed. 325; *Eames v. Andrews*, 122 U. S. 40, 7 S. Ct. 1073, 30 L. ed. 1064; *Sewall v. Jones*, 91 U. S. 171, 23 L. ed. 275; *Mowry v. Whitney*, 14 Wall. (U. S.) 620, 20 L. ed. 860; *Wegmann v. Corcoran*, 13 Ch. D. 65, 41 L. T. Rep. N. S. 358, 28 Wkly. Rep. 331; *Plimpton v. Malcolmson*, 3 Ch. D. 531, 45 L. J. Ch. 505, 34 L. T. Rep. N. S. 340; *Parkes v. Stevens*, L. R. 8 Eq. 358, 38 L. J. Ch. 627, 17 Wkly. Rep. 846 [*affirmed* in L. R. 5 Ch. 36, 22 L. T. Rep. N. S. 635, 18 Wkly. Rep. 233]; *Felton v. Greaves*, 3 C. & P. 611, 14 E. C. L. 743; *Simpson v. Holliday*, 12 L. T. Rep. N. S. 99, 13 Wkly. Rep. 577 [*affirmed* in L. R. 1 H. L. 315, 35 L. J. Ch. 811].

Omissions obvious to mechanic will not in-

validate. *Crossley v. Beverly*, 9 B. & C. 63, 17 E. C. L. 38, 3 C. & P. 513, 14 E. C. L. 690, 7 L. J. K. B. O. S. 127, M. & M. 283, 22 E. C. L. 522, 1 Russ. & M. 166 note, 5 Eng. Ch. 166 note, 39 Eng. Reprint 65.

Drawings may aid in disclosure. *Bloxam v. Elsee*, 6 B. & C. 169, 13 E. C. L. 88, 1 C. & P. 558, 12 E. C. L. 320, 9 D. & R. 215, 5 L. J. K. B. O. S. 104, R. & M. 187, 30 Rev. Rep. 275; *Daw v. Eley*, 13 L. T. Rep. N. S. 399, 14 Wkly. Rep. 126.

The means for accomplishing a result covered by a patent need not be illustrated therein, if they are sufficiently described in the specification. *Hillard v. Fisher Book Typewriter Co.*, 151 Fed. 34 [*affirmed* in 159 Fed. 439].

Ambiguous or misleading patent is void. *Hastings v. Brown*, 1 E. & B. 450, 17 Jur. 647, 22 L. J. Q. B. 161, 72 E. C. L. 450; *Patent Type-Founding Co. v. Richard, Johns*, 381, 6 Jur. N. S. 39, 70 Eng. Reprint 470; *Turner v. Winter*, 1 T. R. 602.

Particular descriptions held insufficient see *Smith v. Murray*, 27 Fed. 69; *Blake v. Stafford*, 3 Fed. Cas. No. 1,504, 6 Blatchf. 195, 3 Fish. Pat. Cas. 294; *Evans v. Chambers*, 8 Fed. Cas. No. 4,555, 1 Robb Pat. Cas. 7, 2 Wash. 125; *Whitney v. Emmett*, 29 Fed. Cas. No. 17,585, *Baldw.* 303, 1 Robb Pat. Cas. 567; *Betts v. Neilson*, L. R. 3 Ch. 429, 37 L. J. Ch. 321, 18 L. T. Rep. N. S. 165, 16 Wkly. Rep. 524; *Hinks v. Safety Lighting Co.*, 4 Ch. D. 607, 46 L. J. Ch. 185, 36 L. T. Rep. N. S. 391; *Rex v. Wheeler*, 2 B. & Ald. 345, 20 Rev. Rep. 465; *Sturz v. De la Rue*, 7 L. J. Ch. O. S. 47, 5 Russ. 322, 5 Eng. Ch. 322, 38 Eng. Reprint 1048, 29 Rev. Rep. 24; *Taylor v. Brandon Mfg. Co.*, 21 Ont. App. 361.

Particular descriptions held sufficient see *Valentine v. Marshall*, 28 Fed. Cas. No. 16,812a; *Wheeler v. Clipper Mower, etc., Co.*, 29 Fed. Cas. No. 17,493, 10 Blatchf. 181, 6 Fish. Pat. Cas. 1, 2 Off. Gaz. 442; *Ralston v. Smith*, 11 H. L. Cas. 223, 20 C. B. N. S. 28, 35 L. J. C. P. 49, 13 L. T. Rep. N. S. 1, 11 Reprint 1318; *Smith v. Mutchmore*, 11 U. C. C. P. 458; *Smith v. Ball*, 21 U. C. Q. B. 122.

2. *Bignall v. Harvey*, 4 Fed. 334, 18 Blatchf. 353; *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 18 Fed. Cas. No. 10,337, 1 Ban. & A. 177, 6 Off. Gaz. 34, 10 Phila. (Pa.) 227.

3. U. S. Rev. St. (1878) § 4920; *Carlton v. Bokee*, 17 Wall. (U. S.) 463, 21 L. ed. 517; *Mowry v. Whitney*, 14 Wall. (U. S.)



matters not vital, will not, however, invalidate the patent if they are due to mistake.<sup>4</sup>

**b. Suppression of Facts.** A fraudulent suppression of material facts about the invention in the specification will render the patent void.<sup>5</sup> To invalidate the patent, however, the omissions must have been made with intent to deceive.<sup>6</sup> Omissions due to mistake or error of judgment will not invalidate the patent, provided the specification is sufficient to enable those skilled in the art to make and use the invention.<sup>7</sup>

**5. JOINDER OF SEVERAL INVENTIONS.** A patent is not invalid for misjoinder therein of claims to separate inventions if those inventions are connected in design and operation and mutually contribute to the production of a single result.<sup>8</sup>

**6. DOUBLE PATENTING.** Where more than one patent is granted to one inventor for a single invention, the first only is valid.<sup>9</sup> The invention covered by two pat-

620, 20 L. ed. 860; *Matheson v. Campbell*, 78 Fed. 910, 24 C. C. A. 384; *Child v. Adams*, 5 Fed. Cas. No. 2,673, 1 Fish. Pat. Cas. 189, 3 Wall. Jr. 20; *Delano v. Scott*, 7 Fed. Cas. No. 3,753, Gilp. 489, 1 Robb Pat. Cas. 700; Reg. v. Cutler, 14 Q. B. 372 note, 68 E. C. L. 373, 3 C. & K. 215, 1 Stark. 354, 2 E. C. L. 138. See *supra*, V, B, 2, f; *infra*, VI, B, 4, b.

The title must correctly indicate what is described or the patent is void. *Cook v. Pearce*, 8 Q. B. 1044, 8 Jur. 499, 13 L. J. Q. B. 189, 55 E. C. L. 1044; *Rex v. Wheeler*, 2 B. & Ald. 345, 20 Rev. Rep. 465; *Croll v. Edge*, 9 C. B. 479, 19 L. J. C. P. 261, 14 Jur. 553, 67 E. C. L. 479.

Title may be broader than description see *Oxley v. Holden*, 8 C. B. N. S. 666, 30 L. J. C. P. 68, 2 L. T. Rep. N. S. 464, 8 Wkly. Rep. 626, 98 E. C. L. 666; *Patent Bottle Envelope Co. v. Seymour*, 5 C. B. N. S. 164, 5 Jur. N. S. 174, 28 L. J. C. P. 22, 94 E. C. L. 164; *Nickells v. Haslam*, 8 Jur. 474, 13 L. J. C. P. 146, 7 M. & G. 378, 8 Scott N. R. 97, 49 E. C. L. 378; *Neilson v. Harford*, 11 L. J. Exch. 20, 8 M. & W. 806.

4. *Hemolin Co. v. Harway Dyewood, etc., Mfg. Co.*, 138 Fed. 54, 70 C. C. A. 480 [*affirming* 131 Fed. 483]; *Matheson v. Campbell*, 78 Fed. 910, 24 C. C. A. 384; *Blanchard's Gun Stock Turning Factory v. Warner*, 3 Fed. Cas. No. 1,521, 1 Blatchf. 258, Fish. Pat. Rep. 184.

Mistake as to theory of operation will not invalidate. See *supra*, V, B, 2, d.

5. U. S. Rev. St. (1878) § 4920; *Philadelphia, etc., R. Co. v. Dubois*, 12 Wall. (U. S.) 47, 20 L. ed. 265; *Electric Boot, etc., Finishing Co. v. Little*, 75 Fed. 276 [*affirmed* in 138 Fed. 732, 71 C. C. A. 270]. And see *supra*, V, B, 2, f.

**English practice.**—Patent must distinguish between what is original and what was communicated from abroad. *Renard v. Levinstein*, 10 L. T. Rep. N. S. 177. Must describe best mode of practising invention. *Wood v. Zimmer*, Holt 58, 17 Rev. Rep. 605, 3 E. C. L. 32; *Neilson v. Harford*, 11 L. J. Exch. 20, 8 M. & W. 806.

Suppression not shown see *Edison, etc., Electric Light Co. v. Woodhouse*, 32 Ch. D. 520, 55 L. J. Ch. 243, 55 L. T. Rep. N. S. 263, 34 Wkly. Rep. 626.

6. *Featherstone v. George R. Bidwell Cycle*

*Co.*, 53 Fed. 113; *Celluloid Mfg. Co. v. Russell*, 37 Fed. 676; *Ligowski Clay-Pigeon Co. v. American Clay-Bird Co.*, 34 Fed. 328; *Gray v. James*, 10 Fed. Cas. No. 5,718, Pet. C. C. 394, 1 Robb Pat. Cas. 120; *Park v. Little*, 18 Fed. Cas. No. 10,715, 1 Robb Pat. Cas. 17, 3 Wash. 196; *Whittemore v. Cutter*, 29 Fed. Cas. No. 17,000, 1 Gall. 478, 1 Robb Pat. Cas. 40.

7. *Matheson v. Campbell*, 78 Fed. 910, 24 C. C. A. 384; *Michaelis v. Roessler*, 34 Fed. 325; *McKesson v. Carnick*, 9 Fed. 44, 19 Blatchf. 158; *Grant v. Mason*, 10 Fed. Cas. No. 5,701; *Kneass v. Schuyllkill Bank*, 14 Fed. Cas. No. 7,875, 1 Robb Pat. Cas. 303, 4 Wash. 9; *Singer v. Walmsley*, 22 Fed. Cas. No. 12,900, 1 Fish. Pat. Cas. 558; *Whitney v. Carter*, 29 Fed. Cas. No. 17,583.

8. *U. S. v. Allen*, 192 U. S. 543, 24 S. Ct. 416, 48 L. ed. 555, 109 Off. Gaz. 549; *Hogg v. Emerson*, 6 How. (U. S.) 437, 12 L. ed. 505; *Sanitas Nut Food Co. v. Voigt*, 139 Fed. 551, 71 C. C. A. 535; *Wilkins Shoe-Button Fastener Co. v. Webb*, 89 Fed. 982; *Fire-Extinguisher Case*, 21 Fed. 40. And see *supra*, V, B, 7.

Machine and separate parts may be claimed in one case. *Holly v. Vergennes Mach. Co.*, 4 Fed. 74, 18 Blatchf. 327; *Foss v. Herbert*, 9 Fed. Cas. No. 4,957, 1 Biss. 121, 2 Fish. Pat. Cas. 31.

Process and article must be covered by separate claims. *Merrill v. Yeomans*, 17 Fed. Cas. No. 9,472, 1 Ban. & A. 47, Holmes 331 [*affirmed* in 94 U. S. 568, 24 L. ed. 235].

**Designs.**—Entire design and parts may be claimed. *Dobson v. Bigelow Carpet Co.*, 114 U. S. 439, 5 S. Ct. 945, 29 L. ed. 177 [*reversing* 10 Fed. 385].

9. *Hill v. Patent Com'r*, 4 Mackey (D. C.) 266; *Jackson v. Lawton*, 10 Johns. (N. Y.) 23, 6 Am. Dec. 311; *Miller v. Eagle Mfg. Co.*, 151 U. S. 186, 14 S. Ct. 310, 38 L. ed. 121; *Underwood v. Gerber*, 149 U. S. 224, 13 S. Ct. 854, 37 L. ed. 710; *Washburn, etc., Mfg. Co. v. Beat 'Em All Barbed-Wire Co.*, 143 U. S. 275, 12 S. Ct. 443, 36 L. ed. 154; *Mosler Safe, etc., Co. v. Mosler*, 127 U. S. 354, 8 S. Ct. 1148, 32 L. ed. 182; *Suffolk Mfg. Co. v. Hayden*, 3 Wall. (U. S.) 315, 18 L. ed. 76; *Palmer Pneumatic Tire Co. v. Lozier*, 90 Fed. 732, 33 C. C. A. 255; *Palmer v. John E. Brown Mfg. Co.*, 84 Fed. 454; *Thompson-*



ents is not different merely because it is differently stated in the claims, since there must be a material difference in the subject-matter and not merely in the scope of the claims.<sup>10</sup>

**7. CLAIMS<sup>11</sup> — a. In General.** Some claims made in a patent may be invalid without invalidating the entire patent, since each claim is separately considered and is a separate statement of the field intended to be covered.<sup>12</sup>

*Houston Electric Co. v. Western Electric Co.*, 70 Fed. 69, 16 C. C. A. 642; *Russell v. Kern*, 69 Fed. 94, 16 C. C. A. 154; *Westinghouse v. New York Air-Brake Co.*, 63 Fed. 962, 11 C. C. A. 342; *Fassett v. Ewart Mfg. Co.*, 62 Fed. 404, 10 C. C. A. 441; *Electrical Accumulator Co. v. Brush Electric Co.*, 52 Fed. 130, 2 C. C. A. 682; *Consolidated Roller-Mill Co. v. Coombs*, 39 Fed. 25; *McMillan v. Rees*, 1 Fed. 722; *Jones v. Sewall*, 13 Fed. Cas. No. 7,495, 3 Cliff. 563, 6 Fish. Pat. Cas. 343, 3 Off. Gaz. 630; *Morris v. Huntington*, 17 Fed. Cas. No. 9,831, 1 Paine 348, 1 Robb Pat. Cas. 448; *Thomson-Houston Electric Co. v. Union R. Co.*, 83 Off. Gaz. 597; *Thomson-Houston Electric Co. v. Hoosick R. Co.*, 80 Off. Gaz. 967; *Thomson-Houston Electric Co. v. Western Electric Co.*, 73 Off. Gaz. 1123.

**English.**—Crown may grant second patent. *National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co.*, 106 Fed. 693, 45 C. C. A. 544; *Barnes Automatic Sprinkler Co. v. Walworth Mfg. Co.*, 60 Fed. 605, 9 C. C. A. 154; *In re Gething*, L. R. 9 Ch. 633; *Ex p. Manceaux*, L. R. 6 Ch. 272, 18 Wkly. Rep. 1184; *In re Dering*, 13 Ch. D. 393, 42 L. T. Rep. N. S. 634, 28 Wkly. Rep. 710.

If issued on the same day, the patentee may elect. *H. W. Johns Mfg. Co. v. Robertson*, 89 Fed. 504; *Electrical Accumulator Co. v. Brush Electric Co.*, 52 Fed. 130, 2 C. C. A. 682. Or they are presumed to have issued in numerical order. *Crown Cork, etc., Co. v. Standard Stopper Co.*, 136 Fed. 841, 69 C. C. A. 200.

**Splitting up inventions not approved.** *Norden v. Spaulding*, 24 App. Cas. (D. C.) 286.

**10. In re Creveling**, 25 App. Cas. (D. C.) 530; *Miller v. Eagle Mfg. Co.*, 151 U. S. 186, 14 S. Ct. 310, 38 L. ed. 121; *Otis Elevator Co. v. Portland Co.*, 127 Fed. 557, 62 C. C. A. 339 [affirming 119 Fed. 928]; *Thomson-Houston Electric Co. v. Elmira, etc., R. Co.*, 71 Fed. 396, 18 C. C. A. 145; *Root v. Sioux City Cable R. Co.*, 42 Fed. 412.

**Different parts of the same machine** may be separately patented. *Thomson-Houston Electric Co. v. Black River Traction Co.*, 135 Fed. 759, 68 C. C. A. 461; *Ide v. Trorlicht, etc., Carpet Co.*, 115 Fed. 137, 53 C. C. A. 341; *Thomson-Houston Electric Co. v. Elmira, etc., R. Co.*, 71 Fed. 396, 18 C. C. A. 145; *Cahn v. Wong Town On*, 19 Fed. 424, 9 Sawy. 630; *McMillan v. Rees*, 1 Fed. 722; *Ex p. Hayden*, 11 Fed. Cas. No. 6,256; *Hayden v. James*, 11 Fed. Cas. No. 6,260. Party may patent improvement upon his own patented device. *O'Reilly v. Morse*, 15 How. (U. S.) 62, 14 L. ed. 601; *Ryan v. Newark Spring Mattress Co.*, 96 Fed. 100; *Aspinwall Mfg. Co. v. Gill*, 32 Fed. 697; *Mathews v. Flower*, 25

Fed. 830. Patent for improvement does not invalidate subsequent broad patent granted on a co-pending application. *Cleveland Foundry Co. v. Detroit Vapor Stove Co.*, 131 Fed. 853, 68 C. C. A. 233; *Badische Anilin, etc., Fabrik v. Klipstein*, 125 Fed. 543; *Westinghouse Electric, etc., Mfg. Co. v. Dayton Fan, etc., Co.*, 106 Fed. 724; *Allington, etc., Mfg. Co. v. Globe Co.*, 89 Fed. 865; *Allington, etc., Mfg. Co. v. Glor*, 83 Fed. 1014; *Thomson-Houston Electric Co. v. Ohio Brass Co.*, 80 Fed. 712, 26 C. C. A. 107; *Thomson-Houston Electric Co. v. Elmira, etc., R. Co.*, 69 Fed. 257 [reversed on other grounds in 71 Fed. 396, 18 C. C. A. 145]; *Eagle Mfg. Co. v. Bradley*, 35 Fed. 295; *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.*, 33 Fed. 254; *Singer v. Braunsdorf*, 22 Fed. Cas. No. 12,897, 7 Blatchf. 521; *Independent Electric Co. v. Jeffrey Mfg. Co.*, 78 Off. Gaz. 797; *National Mach. Co. v. Wheeler, etc., Mfg. Co.*, 74 Off. Gaz. 1588; *Railway Register Mfg. Co. v. Broadway, etc., R. Co.*, 30 Off. Gaz. 180; *Swift v. Jenks*, 27 Off. Gaz. 621; *Graham v. Geneva Lake Crawford Mfg. Co.*, 21 Off. Gaz. 1536; *Graham v. McCormick*, 21 Off. Gaz. 1533.

**Machine, process, and produce** may be separately patented. *Simonds Rolling-Mach. Co. v. Hathorn Mfg. Co.*, 90 Fed. 201; *McKay v. Dibert*, 5 Fed. 587; *Goodyear v. Providence Rubber Co.*, 10 Fed. Cas. No. 5,583, 2 Cliff. 351, 2 Fish. Pat. Cas. 499; *Goodyear v. Wait*, 10 Fed. Cas. No. 5,587, 5 Blatchf. 468, 3 Fish. Pat. Cas. 242; *Merrill v. Yeomans*, 17 Fed. Cas. No. 9,472, 1 Ban. & A. 47; *Holmes* 331, 5 Off. Gaz. 268 [affirmed in 94 U. S. 568, 24 L. ed. 235].

**Designs.**—Design patent invalid in view of prior mechanical patent. *Cary Mfg. Co. v. Neal*, 90 Fed. 725.

**Mechanical patent invalid in view of prior design patent.** *Williams Calk Co. v. Never-slip Mfg. Co.*, 136 Fed. 210 [affirmed in 145 Fed. 928, 76 C. C. A. 466].

**11. Disclaimers** see *infra*, IX.

**12. U. S. Rev. St. (1878) §§ 4917, 4922** [U. S. Comp. St. (1901) pp. 3393, 3396]; *Hotchkiss v. Oliver*, 5 Den. (N. Y.) 314; *Seymour v. McCormick*, 19 How. (U. S.) 96, 15 L. ed. 557; *Hake v. Brown*, 37 Fed. 783; *Cahoon v. Ring*, 4 Fed. Cas. No. 2,292, 1 Cliff. 592, 1 Fish. Pat. Cas. 397; *Kelleher v. Darling*, 14 Fed. Cas. No. 7,653, 3 Ban. & A. 438, 4 Cliff. 124, 14 Off. Gaz. 673; *Peterson v. Wooden*, 19 Fed. Cas. No. 11,038, 3 McLean 248, 2 Robb Pat. Cas. 116; *Rumford Chemical Works v. Lauer*, 20 Fed. Cas. No. 12,135, 10 Blatchf. 122, 5 Fish. Pat. Cas. 615, 3 Off. Gaz. 349; *Stephens v. Felt*, 22 Fed. Cas. No. 13,368, 2 Blatchf. 37, Fish. Pat. Rep. 144. Patent may be valid for part. *Frearson v.*



**b. Excessive Claims.** Where claims are so broad as to include prior inventions they are invalid,<sup>13</sup> and where they do not identify the invention of the patentee they are invalid.<sup>14</sup>

**8. DELAY OF APPLICATION IN PATENT OFFICE.** A patent is not rendered invalid by delays in the patent office where the applicant for patent takes proper action in prosecution of his application within the time fixed by statute.<sup>15</sup>

**9. JURISDICTION TO DETERMINE VALIDITY.** A patent is merely *prima facie* valid, and the United States courts have jurisdiction to declare them invalid in whole or in part, where the issue as to their validity is raised in a proper proceeding.<sup>16</sup> In a suit for infringement of a patent the court may give judgment for defendant on the ground that the patent is invalid, but it cannot in such a proceeding annul the patent, and in the case of interfering patents may declare one void; but it is

Loe, 9 Ch. D. 48, 27 Wkly. Rep. 183; Plimpton v. Spiller, 6 Ch. D. 412, 47 L. J. Ch. 211, 37 L. T. Rep. N. S. 56, 26 Wkly. Rep. 285.

Where one of several distinct parts claimed by the patentee is old, the entire patent is for that reason void. *Kay v. Marshall*, 5 Bing. N. Cas. 492, 8 L. J. C. P. 261, 7 Scott 548, 35 E. C. L. 266 [affirmed in 8 Cl. & F. 245, 8 Eng. Reprint 96, 5 Jur. 1028, West 682, 9 Eng. Reprint 643]; *Morgan v. Seaward*, 1 Jur. 527, 6 L. J. Exch. 153, 2 M. & W. 544, M. & H. 55.

**13.** *Vance v. Campbell*, 1 Black (U. S.) 427, 17 L. ed. 168; *Adjustable Window Screen Co. v. Boughton*, 1 Fed. Cas. No. 81, 1 Ban. & A. 327, 10 Phila. (Pa.) 251; *Aiken v. Dolan*, 1 Fed. Cas. No. 110, 3 Fish. Pat. Cas. 197; *Barrett v. Hall*, 2 Fed. Cas. No. 1,047, 1 Mason 447, 1 Robb Pat. Cas. 207; *Blake v. Stafford*, 3 Fed. Cas. No. 1,504, 6 Blatchf. 195, 3 Fish. Pat. Cas. 294; *Evans v. Eaton*, 8 Fed. Cas. No. 4,559, Pet. C. C. 322, 1 Robb Pat. Cas. 68; *Hopkins, etc., Mfg. Co. v. Corbin*, 12 Fed. Cas. No. 6,695, 3 Ban. & A. 199, 14 Blatchf. 396, 14 Off. Gaz. 3 [affirmed in 103 U. S. 786, 26 L. ed. 610]; *Hovey v. Stevens*, 12 Fed. Cas. No. 6,746, 2 Robb Pat. Cas. 567, 3 Woodb. & M. 17; *Odiorne v. Winkley*, 18 Fed. Cas. No. 10,432, 2 Gall. 51, 1 Robb Pat. Cas. 52; *Stanley v. Hewitt*, 22 Fed. Cas. No. 13,285; *Stanley v. Whipple*, 22 Fed. Cas. No. 13,286, 2 McLean 35, 2 Robb Pat. Cas. 1; *Stanley Rule, etc., Co. v. Davis*, 22 Fed. Cas. No. 13,288; *Turner v. Johnson*, 24 Fed. Cas. No. 14,261, 2 Cranch C. C. 287, Fish. Pat. Rep. 4; *Tyler v. Deval*, 24 Fed. Cas. No. 14,307, 1 Code Rep. (N. Y.) 30; *Watson v. Bladen*, 29 Fed. Cas. No. 17,277, 1 Robb Pat. Cas. 510, 4 Wash. 580; *Whitney v. Emmett*, 29 Fed. Cas. No. 17,585, Baldw. 303, 1 Robb Pat. Cas. 567; *Whitemore v. Cutter*, 29 Fed. Cas. No. 17,601, 1 Gall. 478, 1 Robb Pat. Cas. 40. And see *supra*, V, B.

Claim so broad as to include substances which will not perform the necessary functions is void. *Consolidated Electric Light Co. v. McKeesport Light Co.*, 159 U. S. 465, 16 S. Ct. 75, 40 L. ed. 221 [affirming 40 Fed. 21]; *De Lamar v. De Lamar Min. Co.*, 117 Fed. 240, 54 C. C. A. 272; *Rickard v. Du Bon*, 97 Fed. 96; *Matheson v. Campbell*, 78 Fed. 910, 24 C. C. A. 384; *Wegmann v. Corcoran*, 13 Ch. D. 65, 41 L. T. Rep. N. S. 358, 28 Wkly.

Rep. 331; *Stevens v. Keating*, 2 Exch. 772, 19 L. J. Exch. 57.

**Excessive claim is void.** *Minter v. Mower*, 6 A. & E. 735, 6 L. J. K. B. 183, 1 N. & P. 595, W. W. & D. 262, 33 E. C. L. 387; *Campion v. Benyon*, 3 B. & B. 5, 6 Moore C. P. 71, 23 Rev. Rep. 549, 7 E. C. L. 574; *Hill v. Thompson*, Holt N. P. 636, 3 E. C. L. 249, 3 Meriv. 629, 17 Rev. Rep. 156, 36 Eng. Reprint 239, 2 Moore C. P. 424, 8 Taunt. 375, 20 Rev. Rep. 488, 4 E. C. L. 190; *Cochrane v. Smethurst*, 1 Stark. 205, 18 Rev. Rep. 761, 2 E. C. L. 84.

**14.** *O'Reilly v. Morse*, 15 How. (U. S.) 62, 14 L. ed. 601; *Manhattan Gen. Constr. Co. v. Helios-Upton Co.*, 135 Fed. 785; *Hoke Engraving Plate Co. v. Schraubstadter*, 47 Fed. 506; *Blake v. Stafford*, 3 Fed. Cas. No. 1,504, 6 Blatchf. 195, 3 Fish. Pat. Cas. 294; *Murray v. Clayton*, L. R. 7 Ch. 570, 20 Wkly. Rep. 649.

**15.** *U. S. v. American Bell Tel. Co.*, 167 U. S. 224, 17 S. Ct. 809, 42 L. ed. 144 [affirming 68 Fed. 542, 15 C. C. A. 569]; *Electric Storage Battery Co. v. Buffalo Electric Carriage Co.*, 117 Fed. 314 [affirmed in 120 Fed. 672, 57 C. C. A. 183]; *Thomson-Houston Electric Co. v. Winchester Ave. R. Co.*, 71 Fed. 192; *Electrical Accumulator Co. v. Brush Electric Co.*, 52 Fed. 130, 2 C. C. A. 682; *Brush Electric Co. v. Electrical Accumulator Co.*, 47 Fed. 48; *Adams v. Edwards*, 1 Fed. Cas. No. 53, 1 Fish. Pat. Cas. 1; *Dental Vulcanite Co. v. Wetherbee*, 7 Fed. Cas. No. 3,810, 2 Cliff. 555, 3 Fish. Pat. Cas. 87; *Howard v. Christy*, 12 Fed. Cas. No. 6,754, 2 Ban. & A. 457, 10 Off. Gaz. 981; *Sayles v. Chicago, etc., R. Co.*, 21 Fed. Cas. No. 12,414, 1 Biss. 468, 2 Fish. Pat. Cas. 523; *Sparkman v. Higgins*, 22 Fed. Cas. No. 13,208, 1 Blatchf. 205, Fish. Pat. Rep. 110, 5 N. Y. Leg. Obs. 122.

**16.** *U. S. Rev. St. (1878) §§ 711, 4918, 4920 [U. S. Comp. St. (1901) p. 3394].* And see *infra*, VI, E; XIII, A, 1; XIII, C, 2, a.

State courts have no jurisdiction to decide on the validity of a patent. *Elmer v. Pennel*, 40 Me. 430.

In Canada the minister of agriculture determines disputes as to validity under Pat. Act (1872), § 28; *Smith v. Goldie*, 9 Can. Sup. Ct. 46 [affirming 7 Ont. App. 628]; *Toronto Tel. Mfg. Co. v. Bell Tel. Co.*, 2 Can. Exch. 524; *In re Bell Tel. Co.*, 9 Ont. 339; *In re Bell Tel. Co.*, 7 Ont. 605.



only by suit instituted by the government that the United States courts can annul and cancel a patent.<sup>17</sup>

**C. Correction or Amendment of Patents.**<sup>18</sup> The officials of the government have authority to correct errors made by them in the issue of patents,<sup>19</sup> and errors made by the applicant may be corrected by disclaimer or reissue.<sup>20</sup>

**D. Interfering Patents**<sup>21</sup>—1. **IN GENERAL.** Interfering patents are those which claim the same invention in whole or in part.<sup>22</sup> Where two patents are issued, some or all of the claims of which are substantially the same, any one interested in either patent or any one interested in the working of the invention claimed under either of them may have relief against the interfering patentee by suit in equity and the court may adjudge either patent invalid.<sup>23</sup>

2. **PROCEEDINGS.** The suit is governed by ordinary equity rules,<sup>24</sup> and must be brought in the district where defendant may be found.<sup>25</sup> If the bill fails to show that defendants are the owners of the alleged interfering patent it is bad on special demurrer.<sup>26</sup> Suit to annul an interfering patent may be joined with suit for infringement.<sup>27</sup> It is not necessary for defendant to file a cross bill to obtain affirmative relief.<sup>28</sup> The better opinion is that the evidence should be confined to the question of priority of invention between the patentees,<sup>29</sup> although there are authorities to the effect that evidence as to the state of the art is admissible.<sup>30</sup> The suit is independent of any interference in the patent office, and the deposi-

17. U. S. Rev. St. (1878) §§ 4918, 4920 [U. S. Comp. St. (1901) p. 3394]; U. S. v. American Bell Tel. Co., 128 U. S. 315, 9 S. Ct. 90, 32 L. ed. 450; Mowry v. Whitney, 14 Wall. (U. S.) 434, 20 L. ed. 858.

In Canada the court may determine validity in an infringement suit. St. 35 Vict. c. 26, § 26; Maw v. Massey-Harris Co., 13 Manitoba 252.

18. Reissues see *infra*, VIII.

19. Marsh v. Nichols, 128 U. S. 605, 9 S. Ct. 168, 32 L. ed. 538; Bell v. Hearne, 19 How. (U. S.) 252, 15 L. ed. 614; Woodworth v. Hall, 30 Fed. Cas. No. 18,016, 2 Robb Pat. Cas. 495, 1 Woodb. & M. 248; Woodworth v. Hall, 30 Fed. Cas. No. 18,017, 2 Robb Pat. Cas. 517, 1 Woodb. & M. 389; Reed v. Street, 34 Off. Gaz. 339.

**English practice.**—The master of the rolls may correct clerical errors. *In re Johnson*, 5 Ch. D. 503, 46 L. J. Ch. 555. Amendment by way of correction or explanation is permissible but not to cover an enlarged or different invention. Kelly v. Heathman, 45 Ch. D. 256, 60 L. J. Ch. 22, 63 L. T. Rep. N. S. 517, 39 Wkly. Rep. 91; Marsden v. Moser, 73 L. T. Rep. N. S. 667. Corrected by application to lord chancellor. *In re Nickel*, 5 Jur. 882, 1 Phil. 36, 19 Eng. Ch. 36, 41 Eng. Reprint 544.

20. See *infra*, VIII; IX.

In Canada the law as to disclaimer and reissue is much like the United States law. St. 35 Vict. c. 26, §§ 19–20; 38 Vict. c. 14, § 1.

21. Interferences on application see *supra*, V, C, 8.

22. Nathan Mfg. Co. v. Craig, 49 Fed. 370. See also Dederick v. Fox, 56 Fed. 714.

23. U. S. Rev. St. (1878) § 4918 [U. S. Comp. St. (1901) p. 3394]; Cantrell v. Wallick, 117 U. S. 689, 6 S. Ct. 970, 29 L. ed. 1017; Robertson v. Blake, 94 U. S. 728, 24 L. ed. 245; Thomson-Houston Electric Co. v. Western Electric Co., 72 Fed. 530, 19 C. C. A. 1; Palmer Pneumatic Tire Co. v.

Lozier, 69 Fed. 346; Ecaubert v. Appleton, 67 Fed. 917, 15 C. C. A. 73.

That parties must claim as well as show the same invention see Stonemetz Printers' Mach. Co. v. Brown Folding-Mach. Co., 57 Fed. 601; Dederick v. Fox, 56 Fed. 714; Nathan Mfg. Co. v. Craig, 49 Fed. 370; Morris v. Kempshall Mfg. Co., 20 Fed. 121; Gold, etc., Ore Separating Co. v. U. S. Disintegrating Ore Co., 10 Fed. Cas. No. 5,508, 6 Blatchf. 307, 3 Fish. Pat. Cas. 489.

24. Liggett, etc., Tobacco Co. v. Miller, 1 Fed. 203, 1 McCrary 31.

**Laches.**—Long delay by complainant in filing his bill after an adverse decision by the commissioner will be considered as bearing on the good faith of complainant's proceeding, no explanation of the delay being offered. Sawyer v. Massey, 25 Fed. 144.

25. Prentiss v. Elsworth, 27 Off. Gaz. 623.

26. Nathan Mfg. Co. v. Craig, 47 Fed. 522.

27. American Roll-Paper Co. v. Knopp, 44 Fed. 609.

**Complainant may sue for infringement** instead of under Rev. St. § 4918. Western Electric Co. v. Sperry Electric Co., 59 Fed. 295, 8 C. C. A. 129.

28. Electrical Accumulator Co. v. Brush Electric Co., 44 Fed. 602; American Clay-Bird Co. v. Ligowski Clay-Bird Co., 31 Fed. 466; Lockwood v. Cleaveland, 6 Fed. 721.

Where affirmative relief is prayed in the answer plaintiff cannot dismiss. Electrical Accumulator Co. v. Brush Electric Co., 44 Fed. 602.

29. Palmer Pneumatic Tire Co. v. Lozier, 84 Fed. 659 [reversed on other grounds in 90 Fed. 732, 33 C. C. A. 255]; Nathan Mfg. Co. v. Craig, 47 Fed. 522; American Clay-Bird Co. v. Ligowski Clay-Pigeon Co., 31 Fed. 466; Sawyer v. Massey, 25 Fed. 144; Pentlarge v. Pentlarge, 19 Fed. 817.

30. Palmer Pneumatic Tire Co. v. Lozier, 90 Fed. 732, 33 C. C. A. 255; Ecaubert v. Appleton, 67 Fed. 917, 15 C. C. A. 73; Foster



tions there taken are not ordinarily admissible in evidence.<sup>31</sup> Where two patents interfere there is a rebuttable presumption that the patentee who first filed his application is the first inventor.<sup>32</sup>

**3. JUDGMENT.** If there is no interference in fact the bill of complaint will be dismissed.<sup>33</sup> If there is an interference the court will declare the patent of the later inventor void in whole or in part, or as inoperative or invalid in a specified part of the United States in accordance with the interest of the parties,<sup>34</sup> and may grant relief by injunction when necessary to protect the rights of a party.<sup>35</sup> The judgment does not affect the rights of persons not parties to the suit unless they acquire title from one of the parties subsequently.<sup>36</sup>

**E. Annulment or Repeal.** The United States government can maintain a suit in the United States courts to annul or cancel a patent on the ground that it was obtained through fraud, but no individual can bring or maintain such a suit.<sup>37</sup> The matter of instituting suit is within the control of the attorneys for the government, and they are not required to institute such suit at the request of a party who declares the patent to be invalid.<sup>38</sup> Suit may be maintained by the government not only when it has a proprietary and pecuniary interest in the result, but also when it is necessary in order to enable it to discharge its obligations to the public, and sometimes when the purpose and effect are simply to enforce the rights of an individual;<sup>39</sup> and prayers for cancellation of two patents relating to the same

*v. Lindsay*, 9 Fed. Cas. No. 4,975, 1 Ban. & A. 605, 7 Off. Gaz. 514.

31. *Ecaubert v. Appleton*, 67 Fed. 917, 15 C. C. A. 73; *Atkinson v. Boardman*, 2 Fed. Cas. No. 607.

Where the depositions cannot be retaken, it has been held that they may be read. *Clow v. Baker*, 36 Fed. 692.

32. *Ashton Valve Co. v. Coale Muffler, etc.*, Co., 50 Fed. 100 [affirmed in 52 Fed. 314, 3 C. C. A. 98]; *American Roll-Paper Co. v. Knopp*, 44 Fed. 609; *Pelton v. Waters*, 19 Fed. Cas. No. 10,913, 1 Ban. & A. 599, 7 Off. Gaz. 425.

33. *Mowry v. Whitney*, 14 Wall. (U. S.) 434, 20 L. ed. 858; *Boston Pneumatic Power Co. v. Eureka Patents Co.*, 139 Fed. 29; *Simplex R. Appliance Co. v. Wands*, 115 Fed. 517, 53 C. C. A. 171; *Stonemetz Printers' Mach. Co. v. Brown Folding-Mach. Co.*, 57 Fed. 601; *Dederick v. Fox*, 56 Fed. 714; *Nathan Mfg. Co. v. Craig*, 49 Fed. 370; *Electrical Accumulator Co. v. Brush Electric Co.*, 44 Fed. 602; *Morris v. Kempshall Mfg. Co.*, 20 Fed. 121; *Gold, etc., Ore Separating Co. v. U. S. Disintegrating Ore Co.*, 10 Fed. Cas. No. 5,508, 6 Blatchf. 307, 3 Fish. Pat. Cas. 489.

34. U. S. Rev. St. (1878) § 4918 [U. S. Comp. St. (1901) p. 3394]. Court may declare either or both patents void. *Palmer Pneumatic Tire Co. v. Lozier*, 90 Fed. 732, 33 C. C. A. 255; *Foster v. Lindsay*, 9 Fed. Cas. No. 4,975, 1 Ban. & A. 605, 7 Off. Gaz. 514.

35. *Palmer Pneumatic Tire Co. v. Lozier*, 69 Fed. 346; *Sawyer v. Massey*, 25 Fed. 144.

36. U. S. Rev. St. (1878) § 4918 [U. S. Comp. St. (1901) p. 3394]; *Mowry v. Whitney*, 14 Wall. (U. S.) 434, 20 L. ed. 858. Does not prevent suit on patent where claims are different. *Brush v. Naugatuck R. Co.*, 24 Fed. 371, 23 Blatchf. 277.

37. U. S. v. American Bell Tel. Co., 128 U. S. 315, 9 S. Ct. 90, 32 L. ed. 450; *Mowry v. Whitney*, 14 Wall. (U. S.) 434, 20 L. ed.

858; *Ex p. Wood*, 9 Wheat. (U. S.) 603, 6 L. ed. 171; *U. S. v. American Lumber Co.*, 85 Fed. 827, 29 C. C. A. 431; *Atty.-Gen. v. Rumford Chemical Works*, 32 Fed. 608; *U. S. v. Gunning*, 18 Fed. 511, 21 Blatchf. 516; *Delano v. Scott*, 7 Fed. Cas. No. 3,753, Gilp. 489, 1 Robb Pat. Cas. 700; *Mersevole v. Union Paper Collar Co.*, 17 Fed. Cas. No. 9,488, 6 Blatchf. 356, 3 Fish. Pat. Cas. 483; *Thompson v. Haight*, 23 Fed. Cas. No. 13,956.

**English practice.**—*Scire facias* abolished, and now patents may be revoked on petition to court by attorney-general or a party interested. Act (1883), § 26. Bill in equity to set aside may be maintained by person interested where fraud alleged. *In re Avery*, 36 Ch. D. 307, 56 L. J. Ch. 1007, 57 L. T. Rep. N. S. 506, 36 Wkly. Rep. 249; *Atty.-Gen. v. Vernon*, 2 Ch. Rep. 353, 21 Eng. Reprint 685, 1 Vern. Ch. 277, 23 Eng. Reprint 468; *Re Edge*, 63 L. T. Rep. N. S. 370, 38 Wkly. Rep. 698; *Re Morgan*, 58 L. T. Rep. N. S. 713.

**Canadian practice.**—*Scire facias* to annul must be by attorney-general and not by private party. *Reg. v. Pattee*, 5 Ont. Pr. 292; *Patent Elbow Co. v. Cunin*, 10 Quebec Super. Ct. 56. Not annulled because foreign patent expired. *Reg. v. Ontario Gen. Engineering Co.*, 6 Can. Exch. 328.

38. *New York, etc., Coffee Polishing Co. v. New York Coffee Polishing Co.*, 9 Fed. 578, 20 Blatchf. 174.

**Canadian practice.**—Proceedings according to practice on *scire facias* in England. *Smith v. Goldie*, 9 Can. Sup. Ct. 46; *Reg. v. Ontario Gen. Engineering Co.*, 6 Can. Exch. 328; *Peterson v. Crown Cork, etc., Co.*, 5 Can. Exch. 400; *Reg. v. La Force*, 4 Can. Exch. 14; *Reg. v. Hall*, 27 U. C. Q. B. 146.

39. U. S. v. American Bell Tel. Co., 167 U. S. 224, 17 S. Ct. 809, 42 L. ed. 144.

When the bill to annul a patent is really in the interest of private parties, who have given bond to indemnify the government from



subject and owned by the same party may be joined.<sup>40</sup> It cannot maintain a suit to repeal on grounds that have been sustained in a suit for infringement,<sup>41</sup> nor ask an injunction restraining the commencement or prosecution of suits for infringement of a patent for the repeal of which they have begun an action.<sup>42</sup> The appropriate remedy is by bill in equity,<sup>43</sup> and actual fraud must be alleged and proved.<sup>44</sup>

**F. Estoppel to Dispute Validity** — 1. **IN GENERAL.** The issuance of a patent does not estop the patentee from proving that the invention claimed therein is not novel in the absence of bad faith in procuring such patent.<sup>45</sup> Nor, as a general rule, will a contest in the patent office upon the question of priority of invention foreclose the defeated applicant for a patent from assailing the validity of the patent upon other grounds.<sup>46</sup> A patentee is, however, estopped to deny the correctness of the description in the specification of the existing art.<sup>47</sup> So also a patentee, who secures a correction limiting the life of his patent, is estopped, as against infringers, to deny the validity of the limitation.<sup>48</sup> Furthermore other persons associated with him in the ownership of rights under the patent are also estopped, in the absence of an affirmative showing that they were ignorant of his acts in procuring the limitation.<sup>49</sup> An answer in an infringement suit asserting the validity of a patent granted to defendant estops him to deny on the hearing the validity of a similar patent granted to plaintiff.<sup>50</sup> In a suit upon a license or contract, which contains a covenant upon the part of the licensee, by which the validity of the patent is admitted, and the licensee has had the benefit of the license, he is estopped to deny the validity of the patent by setting up anything contrary to the admissions in his contract.<sup>51</sup> So a covenant or agreement not to infringe estops the parties thereto from controverting the validity of the patent.<sup>52</sup> But it has been held that an arrangement made by two patentees, by way of compromise to avoid litigation, will not be construed as an acknowledgment by either of the validity of the other's patent, so as to estop him or his assigns or licensees to deny its validity.<sup>53</sup> Nor does a mere mercantile agreement not to deal in certain patented machines operate as an estoppel to deny the validity of the patent.<sup>54</sup>

2. **ESTOPPEL OF INFRINGER.** An infringer cannot deny the utility of the invention, although he may deny its novelty.<sup>55</sup> But it has been held that one

all costs and who could have set up the matters on which the suit is based as a defense in a suit against them by the patentee, it must be dismissed. *U. S. v. Frazer*, 22 Fed. 106.

40. *U. S. v. American Bell Tel. Co.*, 128 U. S. 315, 9 S. Ct. 90, 32 L. ed. 450 [reversing 32 Fed. 591].

41. *U. S. v. Colgate*, 32 Fed. 624.

42. *U. S. v. Colgate*, 21 Fed. 318.

43. *U. S. v. Gunning*, 18 Fed. 511, 21 Blatchf. 516.

44. *U. S. v. American Bell Tel. Co.*, 167 U. S. 224, 17 S. Ct. 809, 42 L. ed. 144 [affirming 68 Fed. 542, 15 C. C. A. 569]; *Mowry v. Whitney*, 14 Wall. (U. S.) 434, 20 L. ed. 858; *U. S. v. Gunning*, 18 Fed. 511, 21 Blatchf. 516; *Delano v. Scott*, 7 Fed. Cas. No. 3,753, Gilp. 489, 1 Robb Pat. Cas. 700; *Stearns v. Barrett*, 22 Fed. Cas. No. 13,337, 1 Mason 153, 1 Robb Pat. Cas. 97.

45. *Greenwood v. Bracher*, 1 Fed. 856.

46. *Holliday v. Pickhardt*, 29 Fed. 853.

47. *Heaton-Peninsular Button-Fastener Co. v. Schlochtmeier*, 69 Fed. 592.

48. *Edison Electric Light Co. v. Buckeye Electric Co.*, 64 Fed. 225.

49. *Edison Electric Light Co. v. Buckeye Electric Co.*, 64 Fed. 225.

50. *Russell, etc., Mfg. Co. v. Mallory*, 21 Fed. Cas. No. 12,166, 10 Blatchf. 140, 5 Fish. Pat. Cas. 632, 2 Off. Gaz. 495.

51. *Marsh v. Harris Mfg. Co.*, 63 Wis. 276, 22 N. W. 516; *Washburn, etc., Mfg. Co. v. Cincinnati Barbed-Wire Fence Co.*, 22 Fed. 712; *Evory v. Candee*, 8 Fed. Cas. No. 4,583, 4 Ban. & A. 545, 17 Blatchf. 200; *Magic Ruffle Co. v. Elm City Co.*, 16 Fed. Cas. No. 8,949, 2 Ban. & A. 152, 13 Blatchf. 151, 8 Off. Gaz. 773; *Waterbury Brass Co. v. New York, etc., Brass Co.*, 29 Fed. Cas. No. 17,256.

52. *Hall Mfg. Co. v. American R. Supply Co.*, 48 Mich. 331, 12 N. W. 205; *Brooks v. Moorhouse*, 4 Fed. Cas. No. 1,956, 3 Ban. & A. 229, 13 Off. Gaz. 499; *Magic Ruffle Co. v. Elm City Co.*, 16 Fed. Cas. No. 8,949, 2 Ban. & A. 152, 13 Blatchf. 151, 8 Off. Gaz. 773.

53. *Van Hook v. Wood*, 28 Fed. Cas. No. 16,855. See also *White v. S. Harris, etc., Mfg. Co.*, 3 Fed. 161.

54. *Mannie v. Everett*, 16 Fed. Cas. No. 9,039.

55. *Gandy v. Main Belting Co.*, 143 U. S. 587, 12 S. Ct. 598, 36 L. ed. 272; *Simmond v. Morrison*, 44 Fed. 757; *Kirk v. Du Bois*, 33 Fed. 252 [affirmed in 158 U. S. 58, 15 S. Ct. 729, 39 L. ed. 895]; *La Rue v. Western Electric Co.*, 31 Fed. 80, 24 Blatchf. 392 [affirmed



making use of another's patent mark is estopped to deny the validity of the patent.<sup>56</sup>

**3. ESTOPPEL OF ASSIGNOR.** One who assigns a patent cannot dispute its validity as against his assignee.<sup>57</sup> As to the rest of the world the patent may be void but the assignor is estopped from urging that defense against his assignee.<sup>58</sup> The assignor is not estopped, however, to deny infringement or to show that the patent is limited in its scope.<sup>59</sup>

in 139 U. S. 601, 11 S. Ct. 670, 35 L. ed. 294; *Gray v. James*, 10 Fed. Cas. No. 5,718, Pet. C. C. 394, 1 Robb Pat. Cas. 120; *Kneass v. Schuylkill Bank*, 14 Fed. Cas. No. 7,875, 1 Robb Pat. Cas. 303, 4 Wash. 9; *Vance v. Campbell*, 28 Fed. Cas. No. 16,836; *Vance v. Campbell*, 28 Fed. Cas. No. 16,837, 1 Fish. Pat. Cas. 483; *Whitney v. Mowry*, 29 Fed. Cas. No. 17,594, 4 Fish. Pat. Cas. 207 [*reversed* on other grounds in 14 Wall. 620, 20 L. ed. 860].

56. *Washburn, etc., Mfg. Co. v. Haish*, 29 Fed. Cas. No. 17,217, 4 Ban. & A. 571, 9 Biss. 141, 18 Off. Gaz. 465.

57. *Mathews Gravity Carrier Co. v. Lister*, 154 Fed. 490; *Wold v. Thayer*, 148 Fed. 227, 78 C. C. A. 350 [*affirming* 142 Fed. 776]; *Frank v. Bernard*, 131 Fed. 269 [*affirmed* in 135 Fed. 1021, 68 C. C. A. 566]; *Force v. Sawyer-Boss Mfg. Co.*, 113 Fed. 1018, 51 C. C. A. 592; *Alvin Mfg. Co. v. Scharling*, 100 Fed. 87; *Martin, etc., Cash-Carrier Co. v. Martin*, 67 Fed. 786, 14 C. C. A. 642; *Woodward v. Boston Lasting Mach. Co.*, 60 Fed. 283, 8 C. C. A. 622; *Corbin Cabinet Lock Co. v. Yale, etc., Mfg. Co.*, 58 Fed. 563; *Adee v. Thomas*, 41 Fed. 342; *American Paper Barrel Co. v. Laraway*, 28 Fed. 141; *Parker v. McKee*, 24 Fed. 808; *Underwood v. Warren*, 21 Fed. 573; *Curren v. Burdsall*, 20 Fed. 835, 31 Fed. 918; *Consolidated Middlings Purifier Co. v. Guilder*, 9 Fed. 155, 3 McCrary 186; *Bowman v. Taylor*, 2 A. & E. 278, 4 L. J. K. B. 58, 4 N. & M. 264, 29 E. C. L. 142; *Chambers v. Crichley*, 33 Beav. 374, 55 Eng. Reprint 412; *Walton v. Lavater*, 8 C. B. N. S. 162, 6 Jur. N. S. 1251, 29 L. J. C. P. 275, 3 L. T. Rep. N. S. 272, 98 E. C. L. 162; *Smith v. Scott*, 6 C. B. N. S. 771, 5 Jur. N. S. 1356, 28 L. J. C. P. 325, 95 E. C. L. 771; *Heugh v. Chamberlain*, 25 Wkly. Rep. 742; *Clark v. Adie*, 21 Wkly. Rep. 456 [*affirmed* in 21 Wkly. Rep. 764].

**Estoppel to deny title of licensee.**—The owner of a patent who grants an exclusive license thereunder is estopped to deny that the licensee took good title to the privilege which he undertook to convey. *Seal v. Beach*, 113 Fed. 831.

**The foundation of the estoppel against a vendor patentee** is the fact that he has received and retained a valuable thing in consideration of the statements contained in the application for, or specification of, the patent. Therefore, when an assignment is made pending the application for a patent, it is immaterial whether or not the vendor may have made representations to the purchasers concerning the probability of obtaining a patent. Nor is it material that the purchasers knew that the thing sought to be patented

was old, when they understood that the patent was sought for a new application and use of it. *National Conduit Mfg. Co. v. Connecticut Pipe Mfg. Co.*, 73 Fed. 491.

**Infringement of another patent.**—The patentee is estopped to deny the validity of the patent on the ground that it infringes another patent owned by him. *Essex Button Co. v. Paul*, 48 Fed. 310; *Adee v. Thomas*, 41 Fed. 346; *Curran v. Burdsall*, 20 Fed. 835.

**A patentee whose wife has sold the patent to another** is estopped to deny the validity of the patent. *Onderdonk v. Fanning*, 4 Fed. 148.

**Corporations.**—The rule applies to corporations as well as to natural persons. *Marvel Co. v. Pearl*, 114 Fed. 946; *Force v. Sawyer-Boss Mfg. Co.*, 111 Fed. 902 [*affirmed* in 113 Fed. 1018, 51 C. C. A. 592]; *Edison Electric Light Co. v. Buckeye Electric Co.*, 64 Fed. 225. The estoppel against the assignor of a patent operates against a corporation subsequently formed by him, and which is entirely owned and controlled by him. The corporation will be estopped, even if another party has a substantial interest therein, where it appears that at the time of acquiring his interest he had known of the patent and its assignment and had been associated with the assignor in the line of business to which the patent relates. *National Conduit Mfg. Co. v. Connecticut Pipe Mfg. Co.*, 73 Fed. 491. The mere fact, however, that an inventor, who has assigned his patent, subsequently becomes an officer in a corporation which is alleged to be an infringer does not render applicable to such corporation the estoppel which operates against him personally. *Corbin Cabinet Lock Co. v. Yale, etc., Mfg. Co.*, 58 Fed. 563.

**Mortgage trustee** is estopped. *Regina Music Box Co. v. Newell*, 131 Fed. 606.

**Licensors** estopped. *National Healing-Mach. Co. v. Abbott*, 77 Fed. 462.

**As to patent not sued on** there is no estoppel. *McCormick Harvesting Mach. Co. v. Aultman*, 69 Fed. 371, 16 C. C. A. 259.

58. *Alvin Mfg. Co. v. Scharling*, 100 Fed. 87; *Adee v. Thomas*, 41 Fed. 346.

59. *Noonan v. Chester Park Athletic Club Co.*, 99 Fed. 90, 39 C. C. A. 426; *Martin, etc., Cash-Carrier Co. v. Martin*, 67 Fed. 786, 14 C. C. A. 642; *Western Tel. Constr. Co. v. Stromberg*, 66 Fed. 550; *Babcock v. Clarkson*, 63 Fed. 607, 11 C. C. A. 351; *Ball, etc., Fastener Co. v. Ball Glove Fastening Co.*, 58 Fed. 818, 7 C. C. A. 498.

**A limitation on this doctrine**, however, is that he cannot insist on a construction that would render the patent valueless. *Hurwood Mfg. Co. v. Wood*, 138 Fed. 835.



**4. ESTOPPEL OF ASSIGNEE, GRANTEE, OR LICENSEE.** A licensee or grantee cannot dispute the validity of the patent unless it has been pronounced invalid by a court of last resort.<sup>60</sup> An assignee or licensee cannot dispute the validity of the patent for the purpose of avoiding carrying out the conditions of sale or license.<sup>61</sup> A mere offer to take a license will not operate as an estoppel,<sup>62</sup> and there is no estoppel where an implied license is alleged.<sup>63</sup> A corporation is not estopped by a personal license to a stock-holder.<sup>64</sup> In the absence of any specific agreement not to contest the validity of the patent, the estoppel of a lessee or licensee is confined to the particular article covered by the lease or license;<sup>65</sup> but a party may bind himself generally not to dispute the validity of the patents embodied in those articles.<sup>66</sup>

**5. EXPIRED LICENSE.** The fact that a party once operated under a license will not estop him from disputing the validity of the patent, unless there was some agreement by him to that effect.<sup>67</sup>

**60.** *Hyatt v. Dale Tile Mfg. Co.*, 106 N. Y. 651, 12 N. E. 705 [affirmed in 125 U. S. 46, 8 S. Ct. 756, 31 L. ed. 683]; *Marston v. Swett*, 66 N. Y. 206, 23 Am. Rep. 43, 82 N. Y. 526; *Hyatt v. Ingalls*, 49 N. Y. Super. Ct. 375; *Hardwick v. Galbraith*, 147 Pa. St. 333, 23 Atl. 451; *Harvey Steel Co. v. U. S.*, 38 Ct. Cl. 662; *Clark v. Adie*, 2 App. Cas. 423, 46 L. J. Ch. 598, 37 L. T. Rep. N. S. 1, 26 Wkly. Rep. 45; *Hills v. Laming*, 9 Exch. 256, 23 L. J. Exch. 60; *Crossley v. Dixon*, 10 H. L. Cas. 293, 9 Jur. N. S. 607, 32 L. J. Ch. 617, 8 L. T. Rep. N. S. 260, 11 Wkly. Rep. 716, 11 Eng. Reprint 1039; *Beam v. Merner*, 14 Ont. 412; *Whiting v. Tuttle*, 17 Grant Ch. (U. C.) 454; *Gray v. Billington*, 21 U. C. C. P. 288.

Where the patent has been pronounced void, there is no estoppel. *Hawkes v. Swett*, 4 Hun (N. Y.) 146; *Ross v. Fuller, etc., Co.*, 105 Fed. 510.

The licensee may dispute construction given to patent by licensor. *Trotman v. Wood*, 16 C. B. N. S. 479, 111 E. C. L. 479.

**61.** *Illinois*.—*Rhodes v. Ashurst*, 176 Ill. 351, 52 N. E. 118; *Charter Gas Engine Co. v. Charter*, 47 Ill. App. 36. *Contra*, *Pratt v. Paris Gas Light, etc., Co.*, 51 Ill. App. 603.

*Maine*.—*Jones v. Burnham*, 67 Me. 93, 24 Am. Rep. 10.

*Minnesota*.—*Deane v. Hodge*, 35 Minn. 146, 27 N. Y. 917, 59 Am. Rep. 321.

*New Hampshire*.—*Clark v. Amoskeag Mfg. Co.*, 62 N. H. 612.

*New York*.—*Saltus v. Belford Co.*, 133 N. Y. 499, 31 N. E. 518; *Hyatt v. Ingalls*, 124 N. Y. 93, 26 N. E. 285; *Hyatt v. Dale Tile Mfg. Co.*, 106 N. Y. 651, 12 N. E. 705; *Marston v. Swett*, 66 N. Y. 206, 23 Am. Rep. 43; *General Electric Co. v. Nassau Electric R. Co.*, 36 N. Y. App. Div. 510, 55 N. Y. Suppl. 858; *Skidmore v. Fahys Watch-Case Co.*, 28 N. Y. App. Div. 94, 50 N. Y. Suppl. 1016; *Denise v. Swett*, 68 Hun 188, 22 N. Y. Suppl. 950; *Marsh v. Dodge*, 4 Hun 278; *Baylis v. Bullock Electric Mfg. Co.*, 32 Misc. 218, 66 N. Y. Suppl. 253 [reversed on other grounds in 59 N. Y. App. Div. 576, 69 N. Y. Suppl. 693]; *Kaffeman v. Stern*, 23 Misc. 599, 53 N. Y. Suppl. 260; *Montgomery v. Waterbury*, 2 Misc. 145, 21 N. Y. Suppl. 637 [affirmed in 142 N. Y. 652, 37 N. E. 569]; *Smith*

*v. Standard Laundry Mach. Co.*, 11 Daly 154; *Brusie v. Peck*, 16 N. Y. Suppl. 648.

*Ohio*.—*Ely v. Topliff*, 41 Ohio St. 357; *Clark v. Bentel*, 9 Ohio Dec. (Reprint) 289, 12 Cinc. L. Bul. 53.

*Pennsylvania*.—*Jarecki v. Hays*, 161 Pa. St. 613, 29 Atl. 118; *Hubbard v. Allen*, 123 Pa. St. 198, 16 Atl. 772; *Patterson's Appeal*, 99 Pa. St. 521; *Hardwick v. Caves*, 1 Pa. Dist. 137.

*United States*.—*U. S. v. Harvey Steel Co.*, 196 U. S. 310, 25 S. Ct. 240, 49 L. ed. 492; *Kinsman v. Parkhurst*, 18 How. 289, 15 L. ed. 385; *United Shoe Mach. Co. v. Caunt*, 134 Fed. 239; *Consolidated Rubber Tire Co. v. Finley Rubber Tire Co.*, 116 Fed. 629; *Piaget Novelty Co. v. Headley*, 108 Fed. 870, 48 C. C. A. 116 [affirming 107 Fed. 134]; *Moore v. National Water-Tube Boiler Co.*, 84 Fed. 346; *Godell v. Wells, etc., Co.*, 70 Fed. 319; *Platt v. Fire-Extinguisher Mfg. Co.*, 59 Fed. 897, 8 C. C. A. 357; *National Rubber Co. v. Boston Rubber-Shoe Co.*, 41 Fed. 48; *Rogers v. Riessner*, 30 Fed. 525; *Birdsall v. Perego*, 3 Fed. Cas. No. 1,435, 5 Blatchf. 251; *Goodyear v. Day*, 10 Fed. Cas. No. 5,566; *Wilder v. Adams*, 29 Fed. Cas. No. 17,647, 2 Woodb. & M. 329. *Contra*, *Baltimore Car-Wheel Co. v. North Baltimore Pass. R. Co.*, 21 Fed. 47; *Pelham v. Edelmeyer*, 15 Fed. 262, 21 Blatchf. 188; *National Mfg. Co. v. Meyers*, 7 Fed. 355; *Mitchell v. Barclay*, 17 Fed. Cas. No. 9,659; *Morse Arms Mfg. Co. v. U. S.*, 16 Ct. Cl. 296. *Contra*.—*Sherman v. Champlain Transp. Co.*, 31 Vt. 162.

**62.** *Evans v. Eaton*, 8 Fed. Cas. No. 4,559, Pet. C. C. 322, 1 Robb Pat. Cas. 68.

**63.** *Harvey Steel Co. v. U. S.*, 38 Ct. Cl. 662.

**64.** *Newark Spring-Mattress Co. v. Ryan*, 102 Fed. 693, 42 C. C. A. 594.

**65.** *Dunham v. Bent*, 72 Fed. 60.

**66.** *Dunham v. Bent*, 72 Fed. 60.

**67.** *Stimpson Computing Scale Co. v. W. F. Stimpson Co.*, 104 Fed. 893, 44 C. C. A. 241; *Dueber Watch-Case Mfg. Co. v. Robbins*, 75 Fed. 17, 21 C. C. A. 198 [reversing 71 Fed. 186]; *Mudgett v. Thomas*, 55 Fed. 645; *Tibbe, etc., Mfg. Co. v. Heineken*, 37 Fed. 686; *Blatherwick v. Carey*, 9 Fed. 202, 10 Biss. 494; *Burr v. Duryee*, 4 Fed. Cas. No. 2,190,



VII. TERM.<sup>68</sup>

**A. In General — 1. MECHANICAL PATENTS.** All mechanical patents granted in the United States upon applications filed after December 31, 1897, have a term of seventeen years from the date of the grant.<sup>69</sup> The term of seventeen years was fixed by the act of 1871;<sup>70</sup> but between that date and the time the act of March 3, 1897, went into effect, patents were limited to expire with foreign patents upon the invention. Under section 8, the act of 1897 applied only to patents granted on applications filed after December 31, 1897.<sup>70a</sup>

**2. DESIGNS.** The term of a design patent is three and one-half, seven, or fourteen years, as elected in the application for patent.<sup>71</sup>

**3. REISSUES.** A reissued patent is operative only for the unexpired part of the term of the original patent.<sup>72</sup>

**4. LIMITATION BY FOREIGN PATENT — a. In General.** Patents granted upon applications filed before January 1, 1898, are by statute limited to expire at the same time as any foreign patent previously procured by or for the United States patentee having the shortest term to run.<sup>73</sup> The question of secrecy or publicity in the

2 Fish. Pat. Cas. 275 [*affirmed* in 1 Wall. 531, 17 L. ed. 650, 660, 661]; *Wooster v. Singer Mfg. Co.*, 30 Fed. Cas. No. 18,039a, 15 Reporter 524, 23 Off. Gaz. 2513; *Goucher v. Clayton*, 11 Jur. N. S. 107, 34 L. J. Ch. 239, 11 L. T. Rep. N. S. 732, 13 Wkly. Rep. 336; *Dangerfield v. Jones*, 13 L. T. Rep. N. S. 142.

**68. Term of reissued patent** see *infra*, VIII, A, 4.

**69. U. S. Rev. St. (1878) § 4884** [U. S. Comp. St. (1901) p. 3381]; *Guarantee Ins. Trust, etc., Co. v. Sellers*, 123 U. S. 276, 8 S. Ct. 117, 31 L. ed. 153.

In England the term is fourteen years from date, but fees must be paid at stated times to keep it in force. Act (1883), § 17.

In Canada the term is eighteen years, but the fee may be paid for only six years, or twelve if so elected. St. 55 & 56 Vict. c. 24, § 5.

**70. 12 U. S. St. at L. 249.**

**70a. United Shoe Mach. Co. v. Duplessis** Shoe Mach. Co., 155 Fed. 842, 84 C. C. A. 76.

**71. U. S. Rev. St. (1878) § 4931** [U. S. Comp. St. (1901) 3399].

**72. U. S. Rev. St. (1878) § 4916** [U. S. Comp. St. (1901) p. 3393].

**73. U. S. Rev. St. (1878) § 4887**, prior to the amendment of March 3, 1897, 29 U. S. St. at L. 692 [U. S. Comp. St. (1901) p. 3382]; *United Shoe Mach. Co. v. Duplessis* Shoe Mach. Co., 155 Fed. 842, 84 C. C. A. 76; *Bate Refrigerating Co. v. Sulzberger*, 157 U. S. 1, 15 S. Ct. 508, 39 L. ed. 601; *Commercial Mfg. Co. v. Fairbank Canning Co.*, 135 U. S. 176, 10 St. C. 718, 34 L. ed. 88; *Pohl v. Anchor Brewing Co.*, 134 U. S. 381, 10 S. Ct. 577, 33 L. ed. 953; *Bate Refrigerating Co. v. Hammond*, 129 U. S. 151, 9 S. Ct. 225, 32 L. ed. 645; *Dolbear v. American Bell Tel. Co.*, 126 U. S. 1, 8 S. Ct. 778, 31 L. ed. 863; *Guarantee Ins. Trust, etc., Co. v. Sellers*, 123 U. S. 276, 8 S. Ct. 117, 31 L. ed. 153; *United Shoe Mach. Co. v. Duplessis* Shoe Mach. Co., 148 Fed. 31; *Edison Electric Light*

*Co. v. U. S. Electric Lighting Co.*, 52 Fed. 300, 3 C. C. A. 83; *Electrical Accumulator Co. v. Brush Electric Co.*, 52 Fed. 130, 2 C. C. A. 682; *De Florez v. Reynolds*, 8 Fed. 434, 17 Blatchf. 436; *Nathan v. New York El. R. Co.*, 2 Fed. 225; *Weston v. White*, 29 Fed. Cas. No. 17,458, 2 Ban. & A. 321, 13 Blatchf. 364, 9 Off. Gaz. 1196.

**Assignment of right to patent.**—The fact that an applicant for a patent assigned his right thereto to another before applying for and obtaining a foreign patent for the invention which was issued before the one in this country will not prevent the latter from being limited to the term of the foreign patent. *John R. Williams Co. v. Miller, etc., Mfg. Co.*, 115 Fed. 526.

The statute is not retroactive and does not apply to American patents granted before the law took effect or to the reissues of such patents granted after the law took effect. *Badische Anilin, etc., Fabrik v. Hamilton Mfg. Co.*, 2 Fed. Cas. No. 721, 3 Ban. & A. 235, 13 Off. Gaz. 273; *Goff v. Stafford*, 10 Fed. Cas. No. 5,504, 3 Ban. & A. 610, 14 Off. Gaz. 748.

**"Term."**—The word "term," which when used in reference to a foreign patent, when more than one such patent exists, indicates what was meant as the time of duration. *Paillard v. Bruno*, 29 Fed. 864, 865.

In England the patent expires with any foreign patent granted before the English patent. *In re Winan*, L. R. 4 P. C. 93, 8 Moore P. C. N. S. 306, 17 Eng. Reprint 327; *In re Betts Patent*, 9 Jur. N. S. 137, 7 L. T. Rep. N. S. 577, 1 Moore P. C. N. S. 49, 1 New Rep. 137, 11 Wkly. Rep. 221, 15 Eng. Reprint 621; *In re Bodmer*, 8 Moore P. C. 282, 14 Eng. Reprint 108.

In Canada the patent expires with any foreign patent in existence during the life of the Canadian patent. *Dominion Cotton Mills Co. Ltd. v. Ontario Gen. Engineering Co.*, [1902] A. C. 570, 71 L. J. P. C. 119, 87 L. T. Rep. N. S. 186; *Auer Incandescent Light Mfg. Co. v. Dreschel*, 6 Can. Exch. 55



foreign patent does not prevent the limitation.<sup>74</sup> To act as a limitation, however, the foreign patent must be procured by the United States patentee or by his consent or be ratified by him.<sup>75</sup> It would be manifestly unjust that a patentee should lose the full fruits of his patent by the fact that some intermeddler had caused the invention to be patented abroad.<sup>76</sup> A provisional patent issued in a foreign country which merely secures the applicant against the effects of publication for three years and entitles him to a definitive patent on making the required proofs of the existence of either the article itself or a model thereof within that time is not such a patent as is referred to in the statute,<sup>77</sup> and a foreign patent void *ab initio* will not limit or invalidate the United States patent.<sup>78</sup> The rule is otherwise, however, as to a patent issued by virtue of the recognized lawful authority vested in the king of a foreign country, although there was no patent law in the shape of a legislative enactment.<sup>79</sup> Failure to limit the patent on its face so as to expire at the same time with the prior foreign patent having the shortest time does not affect its validity.<sup>80</sup> Although the patentee procures the "correction" of a patent limiting it to expire with a foreign patent, which attempted "correction" is void for want of jurisdiction of the commissioner to make it, he is not estopped to claim that the patent was in force for the full term of its life as originally fixed.<sup>81</sup>

**b. Identity of Invention.** It is not necessary that the patents be identical in all particulars, or that the inventions disclosed therein be identical, since it is sufficient if upon examination of the two instruments it appears that substantially the same thing is intended to be covered thereby.<sup>82</sup> A difference in mere detail does not avoid identity,<sup>83</sup> unless such difference affects the essence of the invention in a patentable sense.<sup>84</sup> And a foreign patent and a subsequent American patent are not for different inventions because the latter contains a more genuine claim, which covers the specific form of device described in the former, and other

[*affirmed* in 28 Can. Sup. Ct. 608]; *Barter v. Howland*, 26 Grant Ch. (U. C.) 135.

74. *Gramme Electrical Co. v. Arnoux, etc.*, Electrical Co., 17 Fed. 838, 21 Blatchf. 450.

Act March 3, 1903 (32 U. S. St. at L. 1225 [U. S. Comp. St. Suppl. (1905) p. 663]) is not retroactive to revive an expired patent. *Sawyer Spindle Co. v. Carpenter*, 133 Fed. 238 [*affirmed* in 143 Fed. 976, 75 C. C. A. 162].

75. *Hobbs v. Beach*, 180 U. S. 363, 21 S. Ct. 409, 45 L. ed. 536 [*affirming* 92 Fed. 146, 34 C. C. A. 248]; *United Shoe Mach., etc., Co. v. Duplessis Shoe Mach. Co.*, 155 Fed. 842, 84 C. C. A. 76; *Sawyer Spindle Co. v. Carpenter*, 133 Fed. 238 [*affirmed* in 143 Fed. 976, 75 C. C. A. 162]; *Willcox, etc., Sewing Mach. Co. v. Industrial Mfg. Co.*, 110 Fed. 210 [*reversed* on other grounds in 112 Fed. 535, 50 C. C. A. 387]; *Beach v. Hobbs*, 82 Fed. 916; *Edison Electric Light Co. v. U. S. Electric Lighting Co.*, 35 Fed. 134; *Kendrick v. Emmons*, 14 Fed. Cas. No. 7,695, 2 Ban. & A. 208, 9 Off. Gaz. 201.

76. *Hobbs v. Beach*, 180 U. S. 383, 21 S. Ct. 409, 45 L. ed. 536.

77. *Société Anonyme, etc. v. General Electric Co.*, 97 Fed. 604.

78. *Bate Refrigerating Co. v. Gillett*, 20 Fed. 192.

79. *Atlas Glass Co. v. Simonds Mfg. Co.*, 102 Fed. 643, 42 C. C. A. 554 [*affirming* 102 Fed. 338].

80. *Bate Refrigerating Co. v. Hammond*, 129 U. S. 151, 9 S. Ct. 225, 32 L. ed. 645; *O'Reilly v. Morse*, 15 How. (U. S.) 62, 14

L. ed. 601; *Edison Electric Light Co. v. U. S. Electric Lighting Co.*, 52 Fed. 300, 3 C. C. A. 83; *American Paper Barrel Co. v. Laraway*, 23 Fed. 141; *Canan v. Pound Mfg. Co.*, 23 Fed. 185, 23 Blatchf. 173. *Contra*, *Smith v. Ely*, 22 Fed. Cas. No. 13,043, 5 McLean 76, 1 Fish. Pat. Cas. 339.

81. *Edison Electric Light Co. v. Bloomington, etc.*, 65 Fed. 212; *Edison Electric Light Co. v. U. S. Electric Lighting Co.*, 52 Fed. 300, 3 C. C. A. 83.

82. *Commercial Mfg. Co. v. Fairbank Canning Co.*, 135 U. S. 176, 10 S. Ct. 718, 34 L. ed. 88; *Bate Refrigerating Co. v. Hammond*, 129 U. S. 151, 9 S. Ct. 225, 32 L. ed. 645; *Guarantee Ins. Trust, etc., Co. v. Sellers*, 123 U. S. 276, 8 S. Ct. 117, 31 L. ed. 153; *Plummer v. Sargent*, 120 U. S. 442, 7 S. Ct. 640, 30 L. ed. 737; *United Shoe Mach. Co. v. Duplessis Shoe Mach. Co.*, 148 Fed. 31; *Aquarama Co. v. Old Mill Co.*, 124 Fed. 229; *Atlas Glass Co. v. Simonds Mfg. Co.*, 102 Fed. 338 [*affirmed* in 102 Fed. 643, 42 C. C. A. 554]; *J. L. Mott Iron Works v. Henry McShane Mfg. Co.*, 80 Fed. 516; *Accumulator Co. v. Julien Electric Co.*, 57 Fed. 605; *Clark v. Wilson*, 23 Fed. 95; *Brush Electric Co. v. Electric Accumulator Co.*, 56 Off. Gaz. 1334 [*affirmed* in 61 Off. Gaz. 886].

Patent is limited, although one is for process and the other for product. *Accumulator Co. v. Julien Electric Co.*, 57 Fed. 605.

83. *Thomson-Houston Electric Co. v. McLean*, 153 Fed. 883, 82 C. C. A. 629.

84. *Thomson-Houston Electric Co. v. McLean*, 153 Fed. 883, 82 C. C. A. 629.



forms as well.<sup>85</sup> But a prior patent in a foreign country for a minor part of a broad or basic invention is not for the same invention as a subsequent United States patent covering both the minor parts and the broad main invention.<sup>86</sup> When American letters patent are issued covering the same invention described in foreign letters patent of an earlier date, the life of the American patent is not prolonged by the fact that it also covers improvements upon the invention as patented in a foreign country.<sup>87</sup> It is necessary that the foreign patent claim the same invention; it is not sufficient that it disclose the invention of the later United States patent, where it is not claimed therein.<sup>88</sup>

**c. Date of Foreign Patent.** To limit a United States patent the foreign patent must have been actually sealed and issued before the date of the United States patent, and the antedating of a foreign patent will not make it limit a patent here which was actually granted first.<sup>89</sup> Dates of actual issue and not the dates of application control.<sup>90</sup>

**d. Term of Foreign Patent.** The term of a foreign patent is the time which the patentee may as a matter of right keep it in force under the law of the country.<sup>91</sup> It includes not merely the term mentioned in the grant, but any extension thereof which may be procured at the option of the patentee, and it is immaterial whether or not such extension is actually procured.<sup>92</sup> The judgment of the courts of the foreign country as to the meaning of its laws and the term of the patents is controlling.<sup>93</sup>

**e. Lapse or Expiration of Foreign Patent.** Where, at the time that the United States patent is granted, a foreign patent is in force, granted for a certain term, and that patent subsequently lapses through failure to pay fees or taxes or for similar cause, the United States patent does not lapse with the foreign patent,

85. *Sawyer Spindle Co. v. Carpenter*, 133 Fed. 238 [affirmed in 143 Fed. 976, 75 C. C. A. 162]. And see *Accumulator Co. v. Julien Electric Co.*, 57 Fed. 605.

86. *Victor Talking Mach. Co. v. Leeds, etc., Co.*, 146 Fed. 534 [affirmed without opinion in 148 Fed. 1022, 79 C. C. A. 536].

87. *Guarantee Ins. Trust, etc., Co. v. Sellers*, 123 U. S. 276, 8 S. Ct. 117, 31 L. ed. 153.

88. *Westinghouse Electric, etc., Co. v. Stanley Instrument Co.*, 138 Fed. 823, 71 C. C. A. 189; *Holmes Electric Protective Co. v. Metropolitan Burglar Co.*, 22 Fed. 341. *Contra*, *Westinghouse Electric, etc., Co. v. Stanley Instrument Co.*, 138 Fed. 823, 71 C. C. A. 189; *Western Electric Co. v. Citizens' Tel. Co.*, 106 Fed. 215.

89. *Bate Refrigerating Co. v. Sulzberger*, 157 U. S. 1, 15 S. Ct. 508, 39 L. ed. 601; *Elizabeth v. American Nicholson Pavement Co.*, 97 U. S. 126, 24 L. ed. 1000; *Edison Electric Light Co. v. Waring Electric Co.*, 59 Fed. 358 [affirmed in 69 Fed. 645, 15 C. C. A. 700]; *American Bell Tel. Co. v. Cushman*, 57 Fed. 842; *Holmes Burglar Alarm Tel. Co. v. Domestic Tel., etc., Co.*, 42 Fed. 220; *Seibert Cylinder Oil Cup Co. v. William Powell Co.*, 35 Fed. 591; *Emerson v. Lippert*, 31 Fed. 911; *Gold, etc., Tel. Co. v. Commercial Tel. Co.*, 23 Fed. 340, 23 Blatchf. 199.

In Canada the foreign patent must be in existence when the Canadian patent is granted. *Ontario Gen. Engineering Co. v. Dominion Cotton Mills Co.*, 31 Can. Sup. Ct. 75; *Auer Incandescent Light Mfg. Co. v.*

*Dreschel*, 6 Can. Exch. 55 [affirmed in 28 Can. Sup. Ct. 608].

90. *Bate Refrigerating Co. v. Sulzberger*, 157 U. S. 1, 15 S. Ct. 508, 39 L. ed. 601; *Accumulator Co. v. Julien Co.*, 57 Fed. 605; *Edison Electric Light Co. v. U. S. Electric Lighting Co.*, 35 Fed. 134; *Bate Refrigerating Co. v. Gillett*, 13 Fed. 553, 31 Fed. 809.

91. *Pohl v. Anchor Brewing Co.*, 134 U. S. 381, 10 S. Ct. 577, 33 L. ed. 953; *Bate Refrigerating Co. v. Hammond*, 129 U. S. 151, 9 S. Ct. 225, 32 L. ed. 645; *Atlas Glass Co. v. Simonds Mfg. Co.*, 102 Fed. 338 [affirmed in 102 Fed. 643, 42 C. C. A. 554]; *Bonsack Mach. Co. v. Smith*, 70 Fed. 383; *Consolidated Roller Mill Co. v. Walker*, 43 Fed. 575 [affirmed in 138 U. S. 124, 11 S. Ct. 292, 34 L. ed. 920]. See also *Edison Electric Light Co. v. Perkins Electric Lamp Co.*, 42 Fed. 327.

92. *Bate Refrigerating Co. v. Hammond*, 129 U. S. 151, 9 S. Ct. 225, 32 L. ed. 645; *Edison Electric Light Co. v. U. S. Electric Lighting Co.*, 52 Fed. 300, 3 C. C. A. 83. *Contra*, *Gramme Electrical Co. v. Arnoux, etc., Electric Co.*, 17 Fed. 838, 21 Blatchf. 450; *Bate Refrigerating Co. v. Gillett*, 13 Fed. 553; *Henry v. Providence Tool Co.*, 11 Fed. Cas. No. 6,384, 3 Ban. & A. 501; *Reissner v. Sharp*, 20 Fed. Cas. No. 11,689, 4 Ban. & A. 366, 16 Blatchf. 383.

Extension under subsequent law will not avoid. *Accumulator Co. v. Julien Electric Co.*, 57 Fed. 605.

93. *Consolidated Roller Mill Co. v. Walker*, 43 Fed. 575 [affirmed in 136 U. S. 124, 11 S. Ct. 292, 34 L. ed. 920].



but extends throughout the original term of the foreign patent.<sup>94</sup> The life of a United States patent must be certain from the day of the grant.<sup>95</sup> Where the foreign patent expired or lapsed for any cause before the grant of the United States patent, the United States patent is void.<sup>96</sup>

**B. Extensions.**<sup>97</sup> There is no general act of congress permitting the extension of patents, and therefore patents can now be extended only by special acts of congress.<sup>98</sup> Congress, however, as is shown by a very considerable number of

94. *Pohl v. Anchor Brewing Co.*, 134 U. S. 381, 10 S. Ct. 577, 33 L. ed. 593; *Victor Talking Mach. Co. v. Leeds, etc., Co.*, 146 Fed. 534 [affirmed without opinion in 148 Fed. 1022, 79 C. C. A. 536]; *Welsbach Light Co. v. Apollo Incandescent Gaslight Co.*, 96 Fed. 332, 37 C. C. A. 508; *Diamond Match Co. v. Adirondack Match Co.*, 65 Fed. 803; *Pohl v. Heyman*, 58 Fed. 568; *Paillard v. Bruno*, 29 Fed. 864; *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.*, 21 Fed. 458.

95. *Huber v. N. O. Nelson Mfg. Co.*, 148 U. S. 270, 13 S. Ct. 603, 37 L. ed. 447; *Bate Refrigerating Co. v. Gillett*, 40 Off. Gaz. 1029; *Paillard v. Bruno*, 38 Off. Gaz. 900; *Henry v. Providence Tool Co.*, 14 Off. Gaz. 855. Where foreign patent lapsed after the application in the United States, the United States patent is valid. *Welsbach Light Co. v. Apollo Incandescent Gaslight Co.*, 96 Fed. 332, 37 C. C. A. 508.

96. *Huber v. N. O. Nelson Mfg. Co.*, 148 U. S. 270, 13 S. Ct. 603, 37 L. ed. 447.

97. Extension of reissued patent see *infra*, VIII, F.

98. Act 1861 (12 U. S. St. at L. 249) prohibited extensions. *Guarantee Ins. Trust, etc., Co. v. Sellers*, 123 U. S. 276, 8 S. Ct. 117, 31 L. ed. 153.

**Extension by treaty.**—The term of a patent granted by the United States to a citizen thereof cannot be extended by a treaty. *United Shoe Mach. Co. v. Duplessis Shoe Mach. Co.*, 148 Fed. 31 [affirmed in 155 Fed. 842, 84 C. C. A. 76].

**In England** the crown may extend patents (*In re Parsons*, [1898] A. C. 673, 67 L. J. P. C. 55; *Matter of Brandon*, 9 App. Cas. 589, 53 L. J. P. C. 84; *In re Betts*, 9 Jur. N. S. 137, 7 L. T. Rep. N. S. 577, 1 Moore P. C. N. S. 49, 1 New Rep. 137, 11 Wkly. Rep. 221, 15 Eng. Reprint 621; *Ledsam v. Russell*, 1 H. L. Cas. 687, 9 Eng. Reprint 931); and may extend the time even after expiration hearing on petition prior thereto (*Ledsam v. Russell*, 1 H. L. Cas. 687, 9 Eng. Reprint 931; *Re Bodmer*, 2 Moore P. C. 471, 12 Eng. Reprint 1085). The assignees may secure extension (*Russell v. Ledsam*, 9 Jur. 557, 14 L. J. Exch. 353, 14 M. & W. 574 [affirmed in 16 L. J. Exch. 145, 16 M. & W. 633 (affirmed in 1 H. L. Cas. 687, 9 Eng. Reprint 931)]; *In re Napier*, 13 Moore P. C. 543, 9 Wkly. Rep. 390, 15 Eng. Reprint 204), but their claims are not viewed so favorably (*In re Hopkinson*, [1897] A. C. 249, 66 L. J. P. C. 38, 75 L. T. Rep. N. S. 462; *In re Normand*, L. R. 3 P. C. 193, 6 Moore P. C. N. S. 477, 17 Eng. Reprint 805; *In re Norton*, 9 Jur. N. S. 419, 1 Moore P. C. N. S. 339,

1 New Rep. 557, 11 Wkly. Rep. 720, 15 Eng. Reprint 729). An importer from abroad may secure extension, but is not looked upon favorably. *In re Johnson's Patent*, L. R. 4 P. C. 75, 8 Moore P. C. N. S. 282, 17 Eng. Reprint 318; *In re Newton*, 14 Moore P. C. 156, 10 Wkly. Rep. 731, 15 Eng. Reprint 265; *In re Claridge*, 7 Moore P. C. 394, 13 Eng. Reprint 932. An extension will be refused where clearly invalid. *In re Blake*, L. R. 4 P. C. 535, 9 Moore P. C. N. S. 373, 17 Eng. Reprint 554; *Re Hill*, 9 Jur. N. S. 1209, 9 L. T. Rep. N. S. 101, 1 Moore P. C. N. S. 258, 12 Wkly. Rep. 25, 15 Eng. Reprint 698; *In re Bett*, 9 Jur. N. S. 137, 7 L. T. Rep. N. S. 877, 1 Moore P. C. N. S. 49, 1 New Rep. 137, 11 Wkly. Rep. 221, 15 Eng. Reprint 621. An extension may be granted on conditions. *In re Mallet*, L. R. 1 P. C. 308; *Ledsam v. Russell*, 1 H. L. Cas. 687, 9 Eng. Reprint 931; *In re Bodmer*, 8 Moore P. C. 282, 14 Eng. Reprint 108; *Baxter's Patent*, 13 Jur. 593. Invention must have merit and public utility and the patentee must have been sufficiently remunerated. *In re McDougal*, L. R. 2 P. C. 1, 37 L. J. P. C. 17, 5 Moore P. C. N. S. 1, 16 Eng. Reprint 415; *In re Pinkus*, 12 Jur. 233; *In re Bell*, 10 Jur. 363; *In re Heath*, 8 Moore P. C. 217, 14 Eng. Reprint 83; *In re Smith*, 7 Moore P. C. 133, 13 Eng. Reprint 830; *Re Russell*, 2 Moore P. C. 496, 12 Eng. Reprint 1095. Petition for extension must state everything fully and fairly and must include complete account of profits. *In re Wuterich*, [1903] A. C. 206, 72 L. J. P. C. 60, 88 L. T. Rep. N. S. 306; *In re Peach*, [1902] A. C. 414, 71 L. J. P. C. 98, 87 L. T. Rep. N. S. 153; *In re Johnson*, L. R. 5 P. C. 87; *In re Wield*, L. R. 4 P. C. 89, 8 Moore P. C. N. S. 300, 17 Eng. Reprint 325; *In re Pitman*, L. R. 4 P. C. 84, 8 Moore P. C. N. S. 293, 17 Eng. Reprint 322; *In re Clark*, L. R. 3 P. C. 421, 7 Moore P. C. N. S. 255, 17 Eng. Reprint 97; *In re Bett*, 9 Jur. N. S. 137, 7 L. T. Rep. N. S. 577, 1 Moore P. C. N. S. 49, 1 New Rep. 137, 11 Wkly. Rep. 221, 15 Eng. Reprint 621; *In re Markwick*, 13 Moore P. C. 310, 8 Wkly. Rep. 333, 15 Eng. Reprint 116. Expenses, etc., must be deducted in estimating profits (*In re Carr*, L. R. 4 P. C. 539, 9 Moore P. C. N. S. 379, 17 Eng. Reprint 556; *In re Poole*, L. R. 1 P. C. 514; *Matter of Galloway*, 7 Jur. 453; *In re Newton*, 14 Moore P. C. 156, 10 Wkly. Rep. 731, 15 Eng. Reprint 265); and failure of profits must be shown not to be due to failure to make proper efforts (*In re Thornycroft*, [1899] A. C. 415, 68 L. J. P. C. 68; *In re Patterson*, 13 Jur. 593, 6 Moore P. C. 469, 13 Eng. Reprint 765; *In re Norton*, 9 Jur.



decisions, has authority to extend the term of patents either by general law or special act.<sup>99</sup>

### VIII. REISSUES.<sup>1</sup>

**A. In General — 1. DEFINITION.** A reissued patent is in effect an amendment of the original patent made to cure some defect or insufficiency in the original;<sup>2</sup> a patent which merely secures the patent rights more definitely in some particular wherein the original patent was defective.<sup>3</sup>

**2. POWER TO REISSUE AND GROUNDS.** The statutes of the United States authorize a reissue of a patent where the original is inoperative or invalid by reason of a defective or insufficient specification, or by reason of the patentee's claiming as his own invention or discovery more than he has a right to claim as new, provided the error arose by inadvertence, accident, or mistake and without any fraudulent or deceptive intent.<sup>4</sup> The statute is mandatory and gives the commissioner no dis-

N. S. 419, 1 Moore P. C. N. S. 339, 1 New Rep. 557, 11 Wkly. Rep. 720, 15 Eng. Reprint 729). An extension will be refused where not sufficiently useful (*In re Allan*, L. R. 1 P. C. 507; *In re Herbert*, L. R. 1 P. C. 399; *Matter of Simister*, 7 Jur. 451, 4 Moore P. C. 164, 13 Eng. Reprint 264), and time of filing petition for extension must be considered (*In re Marshall*, [1891] A. C. 430; *In re Jablochkoff*, [1891] A. C. 293, 60 L. J. P. C. 61, 65 L. T. Rep. N. S. 5; *Matter of Brandon*, 9 App. Cas. 589, 53 L. J. P. C. 84; *In re Hutchison*, 14 Moore P. C. 364, 15 Eng. Reprint 343). Any one filing caveat may oppose extension (*In re Schlumberger*, 2 Eq. Rep. 36, 9 Moore P. C. 1, 14 Eng. Reprint 197; *In re Lowe*, 8 Moore P. C. 1, 14 Eng. Reprint 1; *In re Smith*, 7 Moore P. C. 133, 13 Eng. Reprint 830; *Re Woodcroft*, 3 Moore P. C. 171, 13 Eng. Reprint 72), and an objection to extension should state grounds but not necessarily particulars (*In re Ball*, 4 App. Cas. 171, 48 L. J. P. C. 24, 27 Wkly. Rep. 477). Costs are allowed on opposition to extension. *In re Wield*, L. R. 4 P. C. 89, 8 Moore P. C. N. S. 300, 17 Eng. Reprint 325; *In re Johnson*, L. R. 4 P. C. 75, 8 Moore P. C. N. S. 282, 17 Eng. Reprint 318; *In re Jones*, 9 Moore P. C. 41, 14 Eng. Reprint, 213; *In re Milner*, 9 Moore P. C. 39, 14 Eng. Reprint 212.

99. *Wilson v. Rousseau*, 4 How. (U. S.) 646, 11 L. ed. 1141; *New American File Co. v. Nicholson File Co.*, 8 Fed. 816; *Blanchard v. Sprague*, 3 Fed. Cas. No. 1,518, 1 Robb Pat. Cas. 734, 742, 2 Story 164, 3 Sumn. 535; *Blanchard's Gun-Stock Turning Factory v. Warner*, 3 Fed. Cas. No. 1,521, 1 Blatchf. 258, Fish. Pat. Rep. 184; *Bloomer v. Stolley*, 3 Fed. Cas. No. 1,559, Fish. Pat. Rep. 376, 5 McLean 158; *Brooks v. Jenkins*, 4 Fed. Cas. No. 1,953, Fish. Pat. Rep. 41, 3 McLean 432; *Evans v. Robinson*, 8 Fed. Cas. No. 4,571, Brunn. Col. Cas. 400; *Gibson v. Gifford*, 10 Fed. Cas. No. 5,395, 1 Blatchf. 529, Fish. Pat. Rep. 366; *Gibson v. Harris*, 10 Fed. Cas. No. 5,396, 1 Blatchf. 167, Fish. Pat. Rep. 115; *Jordan v. Dobson*, 13 Fed. Cas. No. 7,519, 2 Abb. 398, 4 Fish. Pat. Cas. 232, 7 Phila. (Pa.) 533; *Potter v. Braunsdorf*, 19 Fed. Cas. No. 11,321, 7 Blatchf. 97; *Washburn v. Gould*, 29 Fed. Cas. No. 17,214, 2 Robb Pat. Cas. 206,

3 Story 122; *Woodworth v. Hall*, 30 Fed. Cas. No. 18,016, 2 Robb Pat. Cas. 495, 1 Woodb. & M. 248; *Woodworth v. Sherman*, 30 Fed. Cas. No. 18,019, 2 Robb Pat. Cas. 257, 3 Story 171.

1. Correction or amendment of original patent see *supra*, VI, C.

Extension of original patent see *supra*, VII, B.

2. *Lattig v. Dean*, 25 App. Cas. (D. C.) 591; *McBurney v. Goodyear*, 11 Cush. (Mass.) 569; *Dobson v. Lees*, 137 U. S. 258, 11 S. Ct. 71, 34 L. ed. 652; *Grant v. Raymond*, 6 Pet. (U. S.) 218, 8 L. ed. 376; *Shaw v. Colwell Lead Co.*, 11 Fed. 711, 20 Blatchf. 417; *Crompton v. Belknap Mills*, 6 Fed. Cas. No. 3,406, 3 Fish. Pat. Cas. 536.

Either the specification or claim may be amended. *Battin v. Taggart*, 17 How. (U. S.) 74, 15 L. ed. 37; *Hart*, etc., Mfg. Co. v. *Anchor Electric Co.*, 92 Fed. 657, 34 C. C. A. 606.

3. *Ingersoll v. Holt*, 104 Fed. 682.

4. U. S. Rev. St. (1878) § 4916 [U. S. Comp. St. (1901) p. 3393]; *Sewing-Mach. Co. v. Frame*, 24 Fed. 596; *Gold*, etc., Tel. Co. v. *Wiley*, 17 Fed. 234; *Hailes v. Albany Stove Co.*, 16 Fed. 240, 21 Blatchf. 271; *Woven-Wire Mattress Co. v. Wire-Web Bed Co.*, 8 Fed. 87; *Smith v. Merriam*, 6 Fed. 713; *Wilson v. Coon*, 6 Fed. 611, 18 Blatchf. 532; *Giant Powder Co. v. California Vigorit Powder Co.*, 4 Fed. 720, 6 Sawy. 508; *Atlantic Giant-Powder Co. v. Goodyear*, 2 Fed. Cas. No. 623, 3 Ban. & A. 161, 13 Off. Gaz. 45; *Badische Anilin*, etc., *Fabrik v. Higgin*, 2 Fed. Cas. No. 722, 3 Ban. & A. 462, 15 Blatchf. 290, 14 Off. Gaz. 414; *Ex p. Ball*, 2 Fed. Cas. No. 810; *Dyson v. Gambrill*, 8 Fed. Cas. No. 4,230; *Knight v. Baltimore*, etc., R. Co., 14 Fed. Cas. No. 7,882, 3 Fish. Pat. Cas. 1, *Taney* 106; *Stevens v. Pritchard*, 23 Fed. Cas. No. 13,407, 2 Ban. & A. 390, 4 Cliff. 417, 10 Off. Gaz. 505; *Tucker v. Tucker Mfg. Co.*, 24 Fed. Cas. No. 14,227, 2 Ban. & A. 401, 4 Cliff. 397, 10 Off. Gaz. 464; *Wells v. Jacques*, 29 Fed. Cas. No. 17,398, 1 Ban. & A. 60, 5 Off. Gaz. 364.

Prior to the passage of the reissue statute the authority to grant a reissue existed. *Grant v. Raymond*, 6 Pet. (U. S.) 218, 8 L. ed. 376.



cretion as to cases within its provisions.<sup>5</sup> While it is to be construed liberally according to its spirit,<sup>6</sup> a reissue cannot be granted except as provided therein.<sup>7</sup> To warrant a reissue it is necessary that there should be a *bona fide* mistake or accident and not merely an error in judgment,<sup>8</sup> and the patent must be inoperative and invalid.<sup>9</sup> Claims that are too narrow render the patent inoperative and justify a reissue.<sup>10</sup> So where the patent claims too much there may be a reissue.<sup>11</sup> The reissue is not invalid because the error corrected was immaterial.<sup>12</sup>

**3. PERSONS ENTITLED TO REISSUE.** A reissue may be granted to the inventor, his executor or administrator, or in case of assignment recorded in the patent office may be granted to the assignee.<sup>13</sup> Joint owners must all join in a surrender for reissue or ratify a reissue, otherwise it is invalid.<sup>14</sup> In regard to reissues citizens and aliens have the same rights.<sup>15</sup>

In Canada the law is like that in the United States. St. 35 Vict. c. 26, § 19. Defective or inoperative patent may be amended by reissue. *Auer Incandescent Light Mfg. Co. v. O'Brien*, 5 Can. Exch. 243; *Hunter v. Carriek*, 28 Grant Ch. (U. C.) 489 [*reversed* on other grounds in 10 Ont. App. 449].

5. *Ex p. Dyson*, 8 Fed. Cas. No. 4,228.

6. *Ex p. Ball*, 2 Fed. Cas. No. 810.

7. *Burr v. Duryee*, 1 Wall. (U. S.) 531, 17 L. ed. 650, 660, 661; *Peoria Target Co. v. Cleveland Target Co.*, 58 Fed. 227, 7 C. C. A. 197; *Child v. Adams*, 5 Fed. Cas. No. 2,673, 1 Fish. Pat. Cas. 189, 3 Wall. Jr. 20.

8. *In re Conklin*, 1 MacArthur (D. C.) 375; *Huber v. N. O. Nelson Mfg. Co.*, 148 U. S. 270, 13 S. Ct. 603, 37 L. ed. 447 [*affirming* 38 Fed. 830]; *Yale Lock Mfg. Co. v. Berkshire Nat. Bank*, 135 U. S. 342, 10 S. Ct. 884, 34 L. ed. 168; *Yale Lock Mfg. Co. v. James*, 125 U. S. 447, 8 S. Ct. 967, 31 L. ed. 807; *Matthews v. Iron-Clad Mfg. Co.*, 124 U. S. 347, 8 S. Ct. 639, 31 L. ed. 477; *Eames v. Andrews*, 122 U. S. 40, 7 S. Ct. 1073, 30 L. ed. 1064; *Coon v. Wilson*, 113 U. S. 268, 5 S. Ct. 537, 28 L. ed. 963; *Mahn v. Harwood*, 112 U. S. 354, 5 S. Ct. 174, 28 L. ed. 665; *Miller v. Bridgeport Brass Co.*, 104 U. S. 350, 26 L. ed. 783; *Westinghouse Electric, etc., Co. v. Stanley Electric Mfg. Co.*, 115 Fed. 810; *American Soda-Fountain Co. v. Swietusch*, 85 Fed. 968, 29 C. C. A. 506; *Jenkins v. Stetson*, 32 Fed. 398; *Arnheim v. Finster*, 24 Fed. 276; *American Diamond Drill Co. v. Sullivan Mach. Co.*, 21 Fed. 74; *Newton v. Furst, etc., Mfg. Co.*, 14 Fed. 465, 11 Biss. 405; *Putnam v. Hutchinson*, 12 Fed. 127, 11 Biss. 233; *Whitehouse v. Travelers' Ins. Co.*, 29 Fed. Cas. No. 17,566.

Actual mistake shown see *Hobbs v. Beach*, 180 U. S. 383, 21 S. Ct. 409, 45 L. ed. 586; *Topliff v. Topliff*, 145 U. S. 156, 12 S. Ct. 825, 36 L. ed. 658; *Peoria Target Co. v. Cleveland Target Co.*, 43 Fed. 922; *National Spring Co. v. Union Car Spring Mfg. Co.*, 17 Fed. Cas. No. 10,051, 1 Ban. & A. 240, 12 Blatchf. 80, 6 Off. Gaz. 224; *In re Briede*, 123 Off. Gaz. 322.

How shown.—Mistake may be shown by evidence outside of official record. *Ex p. Dyson*, 8 Fed. Cas. No. 4,228; *Hussey v. Bradley*, 12 Fed. Cas. No. 6,946, 5 Blatchf. 134, 2 Fish. Pat. Cas. 362.

9. *Burr v. Duryee*, 1 Wall. (U. S.) 531, 17 L. ed. 650, 660, 661; *Idealite Co. v. Pro-*

*tection Light Co.*, 103 Fed. 973; *Giant Powder Co. v. California Powder Works*, 10 Fed. Cas. No. 5,379, 2 Ban. & A. 131, 3 Sawy. 448 [*reversed* on other grounds in 98 U. S. 126, 25 L. ed. 77]; *Goodyear v. Day*, 10 Fed. Cas. No. 5,566.

10. *In re Briede*, 27 App. Cas. (D. C.) 298, 123 Off. Gaz. 322; *Yale Lock Mfg. Co. v. Berkshire Nat. Bank*, 135 U. S. 342, 10 S. Ct. 884, 34 L. ed. 168; *Mahn v. Harwood*, 112 U. S. 354, 5 S. Ct. 174, 28 L. ed. 665; *Western Union Tel. Co. v. Baltimore, etc., Tel. Co.*, 25 Fed. 30; *Giant Powder Co. v. Safety Nitro Powder Co.*, 19 Fed. 509; *Welling v. Rubber-Coated Harness Trimming Co.*, 29 Fed. Cas. No. 17,383, 2 Ban. & A. 1.

11. *Hubel v. Dick*, 28 Fed. 656; *Mathews v. Flower*, 25 Fed. 830; *Dorsey Harvester Revolving-Rake Co. v. Marsh*, 7 Fed. Cas. No. 4,014, 6 Fish. Pat. Cas. 387, 9 Phila. (Pa.) 395; *Knight v. Baltimore, etc., R. Co.*, 14 Fed. Cas. No. 7,882, 3 Fish. Pat. Cas. 1, Taney 106; *Treadwell v. Bladen*, 24 Fed. Cas. No. 14,154, 1 Robb Pat. Cas. 531, 4 Wash. 703.

12. *Hobbs v. Beach*, 180 U. S. 383, 21 S. Ct. 409, 45 L. ed. 586; *Thomson-Houston Electric Co. v. Black River Traction Co.*, 135 Fed. 759, 63 C. C. A. 461; *Buerk v. Valentine*, 4 Fed. Cas. No. 2,109, 9 Blatchf. 479, 5 Fish. Pat. Cas. 366, 2 Off. Gaz. 295.

13. U. S. Rev. St. (1878) §§ 4895, 4916 [U. S. Comp. St. (1901) pp. 3393, 3385]; *Carew v. Boston Elastic Fabric Co.*, 5 Fed. Cas. No. 2,397, 3 Cliff. 356, 5 Fish. Pat. Cas. 90, 1 Off. Gaz. 91; *Potter v. Holland*, 19 Fed. Cas. No. 11,329, 4 Blatchf. 206, 1 Fish. Pat. Cas. 327; *Smith v. Mercer*, 22 Fed. Cas. No. 13,078, 5 Pa. L. J. 529; *Wing v. Warren*, 30 Fed. Cas. No. 17,871, 5 Fish. Pat. Cas. 548, 2 Off. Gaz. 342.

Assignee may secure reissue in his own name and for his own benefit without consent of inventor. *Carew v. Boston Elastic Fabric Co.*, 5 Fed. Cas. No. 2,398, Holmes 45; *Swift v. Whisen*, 23 Fed. Cas. No. 13,700, 2 Bond 115, 3 Fish. Pat. Cas. 343.

14. *Dental Vulcanite Co. v. Wetherbee*, 7 Fed. Cas. No. 3,810, 2 Cliff. 553, 3 Fish. Pat. Cas. 87; *Potter v. Holland*, 19 Fed. Cas. No. 11,329, 4 Blatchf. 206, 1 Fish. Pat. Cas. 327; *Woodworth v. Stone*, 30 Fed. Cas. No. 18,021, 2 Robb Pat. Cas. 296, 3 Story 749.

15. *Shaw v. Cooper*, 7 Pet. (U. S.) 292, 8 L. ed. 689.



4. TERM. The reissue is granted for the unexpired part of the term of the original patent.<sup>16</sup>

**B. Time For Application** — 1. IN GENERAL. Application for reissue should be made with promptness,<sup>17</sup> and while the length of delay which is permissible depends on the circumstances of the particular case,<sup>18</sup> it has been said that where claims are broadened a delay of two years will ordinarily be regarded as too long unless excuse is shown therefor.<sup>19</sup>

2. INTERVENING RIGHTS OF THIRD PERSONS. Where a reissue is sought merely to expand the claims of a patent, so as to embrace structures or devices brought into use since the issuance of the original, and which were not infringements of the claim of the original, there being no proof of mistake or inadvertence, the right to a reissue is lost by unreasonable delay, and the reissue, being made, is void.<sup>20</sup>

16. U. S. Rev. St. (1878) § 4916 [U. S. Comp. St. (1901) p. 3393]; *Gibson v. Harris*, 10 Fed. Cas. No. 5,396, 1 Blatchf. 167, Fish. Pat. Rep. 115; *Morris v. Huntington*, 17 Fed. Cas. No. 9,831, 1 Paine 348, 1 Robb Pat. Cas. 448; *Woodworth v. Edwards*, 30 Fed. Cas. No. 18,014, 2 Robb Pat. Cas. 610, 3 Woodb. & M. 120.

17. *Yale Lock Mfg. Co. v. Berkshire Nat. Bank*, 135 U. S. 342, 10 S. Ct. 884, 34 L. ed. 168; *Hartshorn v. Saginaw Barrel Co.*, 119 U. S. 664, 7 S. Ct. 421, 30 L. ed. 539; *Wollensak v. Reiher*, 115 U. S. 96, 5 S. Ct. 1137, 29 L. ed. 350; *Mahn v. Harwood*, 112 U. S. 354, 5 S. Ct. 174, 28 L. ed. 665; *Thomson-Houston Electric Co. v. Sterling-Meaker Co.*, 150 Fed. 589; *Milloy Electric Co. v. Thompson-Houston Electric Co.*, 148 Fed. 843, 78 C. C. A. 533; *Pelzer v. Meyberg*, 97 Fed. 969; *Shirley v. Mayer*, 25 Fed. 38, 23 Blatchf. 249; *Western Union Tel. Co. v. Baltimore, etc., Tel. Co.*, 25 Fed. 30; *Ives v. Sargent*, 17 Fed. 447, 21 Blatchf. 417; *Pope Mfg. Co. v. Marqua*, 15 Fed. 400; *Jones v. Barker*, 11 Fed. 597; *Kidder v. Smart Mfg. Co.*, 8 Ont. 362.

18. *Wilson v. Rousseau*, 4 How. (U. S.) 646, 11 L. ed. 1141; *Western Union Tel. Co. v. Baltimore, etc., Tel. Co.*, 25 Fed. 30; *Odell v. Stout*, 22 Fed. 159; *Stutz v. Armstrong*, 20 Fed. 843.

For facts showing unreasonable delay see *In re Starkey*, 21 App. Cas. (D. C.) 519; *In re Messenger*, 12 App. Cas. (D. C.) 532; *Eby v. King*, 158 U. S. 366, 15 S. Ct. 972, 39 L. ed. 1018; *Wollensak v. Sargent*, 151 U. S. 221, 14 S. Ct. 291, 38 L. ed. 137; *Leggett v. Standard Oil Co.*, 149 U. S. 287, 13 S. Ct. 902, 37 L. ed. 737; *Electric Gas-Lighting Co. v. Boston Electric Co.*, 139 U. S. 481, 11 S. Ct. 586, 35 L. ed. 250; *Hartshorn v. Saginaw Barrel Co.*, 119 U. S. 664, 7 S. Ct. 421, 30 L. ed. 539; *White v. Dunbar*, 119 U. S. 47, 7 S. Ct. 72, 30 L. ed. 303; *Gardner v. Herz*, 118 U. S. 180, 6 S. Ct. 1027, 30 L. ed. 158; *Thomson v. Wooster*, 114 U. S. 104, 5 S. Ct. 788, 29 L. ed. 105; *Torrent, etc., Lumber Co. v. Rodgers*, 112 U. S. 659, 5 S. Ct. 501, 28 L. ed. 842; *Mahn v. Harwood*, 112 U. S. 354, 5 S. Ct. 174, 6 S. Ct. 451, 28 L. ed. 665; *Johnson v. Flushing, etc., R. Co.*, 105 U. S. 539, 26 L. ed. 1162; *Bantz v. Frantz*, 105 U. S. 160, 26 L. ed. 1013; *Matthews v. Boston Mach. Co.*, 105 U. S. 54, 26 L. ed. 1022; *Miller v. Bridgeport Brass Co.*, 104 U. S. 350, 26 L. ed. 783; *United Blue-Flame Oil*

*Stove Co. v. Glazier*, 119 Fed. 157, 55 C. C. A. 553; *Troy Laundry Mach. Co. v. Adams Laundry Mach. Co.*, 112 Fed. 437; *Pfenninger v. Heubner*, 99 Fed. 440; *Horn, etc., Mfg. Co. v. Pelzer*, 91 Fed. 665, 34 C. C. A. 45; *Mast v. Iowa Windmill, etc., Co.*, 76 Fed. 816, 22 C. C. A. 586; *Philadelphia Novelty Mfg. Co. v. Rouss*, 39 Fed. 273; *Wollensak v. Sargent*, 33 Fed. 840; *Shickle, etc., Iron Co. v. South St. Louis Foundry Co.*, 29 Fed. 866; *Curran v. St. Louis Refrigerator, etc., Co.*, 29 Fed. 320; *Hubel v. Dick*, 28 Fed. 656; *Shirley v. Mayer*, 25 Fed. 38, 23 Blatchf. 249; *Tuttle v. Loomis*, 24 Fed. 789; *Scrivner v. Oakland Gas Co.*, 22 Fed. 98, 10 Sawy. 390; *Singer Mfg. Co. v. Goodrich*, 15 Fed. 455; *Sheriff v. Fulton*, 12 Fed. 136; *Combined Patents Can Co. v. Lloyd*, 11 Fed. 149. After a decision of a court of appeals declaring a patent void, the owner cannot continue litigation in other circuits and wait until the patent has again been declared void before applying for a reissue. *Thomson-Houston Electric Co. v. Western Electric Co.*, 158 Fed. 813.

For facts showing reasonable diligence see *In re Briede*, 27 App. Cas. (D. C.) 298, 123 Off. Gaz. 322; *In re Heroult*, 29 App. Cas. (D. C.) 42; *Featherstone v. George R. Bidwell Cycle Co.*, 53 Fed. 113; *Russell v. Laughlin*, 26 Fed. 699; *In re Briede*, 123 Off. Gaz. 322.

19. *In re Ams*, 29 App. Cas. (D. C.) 91; *In re Starkey*, 21 App. Cas. (D. C.) 519; *Topliff v. Topliff*, 145 U. S. 156, 12 S. Ct. 825, 36 L. ed. 658; *Wollensak v. Reiher*, 115 U. S. 96, 5 S. Ct. 1137, 29 L. ed. 350; *Mahn v. Harwood*, 112 U. S. 354, 5 S. Ct. 174, 28 L. ed. 665; *Asmus v. Alden*, 27 Fed. 684; *Phillips v. Risser*, 26 Fed. 308.

**Application to enlarge monopoly.**—Where the reissue was obtained, not for the purpose of correcting a mistake, but for the mere purpose of enlarging the monopoly of the patent, it is immaterial that the application for reissue was made within two years from the time of the original grant. *Parker, etc., Co. v. Yale Clock Co.*, 123 U. S. 87, 8 S. Ct. 38, 31 L. ed. 100; *Coon v. Wilson*, 113 U. S. 268, 5 S. Ct. 537, 28 L. ed. 963; *Union Paper-Bag Mach. Co. v. Waterbury*, 39 Fed. 389; *Russell v. Laughlin*, 26 Fed. 699.

20. *Dunham v. Dennison Mfg. Co.*, 154 U. S. 103, 14 S. Ct. 986, 38 L. ed. 924 [*affirming* 40 Fed. 667]; *Ives v. Sargent*, 119 U. S. 652, 7 S. Ct. 436, 30 L. ed. 544; *Newton*



Even if the claim is technically narrowed instead of broadened, a reissue after long delay, during which adverse equities have arisen, cannot be sustained, when the original patent did not indicate, or even hint at, the invention of the reissue.<sup>21</sup> What is not claimed in an original patent is dedicated to the public unless the patent is surrendered and reissued within a reasonable time and before adverse rights have accrued.<sup>22</sup> It will not do for the patentee to wait until other inventors have produced new forms of improvement and then, with the new light thus acquired, under pretense of inadvertence and mistake, apply for such an enlargement of his claim as to make it embrace these new forms.<sup>23</sup> Such a process of expansion carried on indefinitely, without regard to lapse of time, would operate most unjustly against the public and is totally unauthorized by the law.<sup>24</sup> No matter how valuable and meritorious an invention may be, a patentee has no right, by reissuing his patent, to gradually widen the scope of his claims so as to keep pace with the progress of invention.<sup>25</sup> But a reissued patent is not void, because the things claimed in the original had been in public use in the interval between the original and the reissued patent. Such a publication is not an abandonment or dedication.<sup>26</sup>

**3. EXCUSES FOR DELAY.** The applicant may excuse delay in applying for reissue by showing good reasons for failing to make the application sooner.<sup>27</sup> The question whether delay is unreasonable is a matter of law for the court.<sup>28</sup>

*v. Furst, etc., Mfg. Co.*, 119 U. S. 373, 7 S. Ct. 369, 30 L. ed. 442; *White v. Dunbar*, 119 U. S. 47, 7 S. Ct. 72, 30 L. ed. 303 [reversing 15 Fed. 747, 4 Woods 116]; *Brown v. Davis*, 116 U. S. 237, 6 S. Ct. 379, 29 L. ed. 659; *Coon v. Wilson*, 113 U. S. 268, 5 S. Ct. 537, 28 L. ed. 963; *Torrent, etc., Lumber Co. v. Rodgers*, 112 U. S. 659, 5 S. Ct. 501, 28 L. ed. 872; *Turner, etc., Mfg. Co. v. Dover Stamping Co.*, 111 U. S. 319, 4 S. Ct. 401, 28 L. ed. 442; *Clements v. Odorless Excavating Apparatus Co.*, 109 U. S. 641, 3 S. Ct. 525, 27 L. ed. 1060; *Gill v. Wells*, 22 Wall. (U. S.) 1, 22 L. ed. 699; *Troy Laundry Mach. Co. v. Adams Laundry Mach. Co.*, 112 Fed. 437; *Horn, etc., Mfg. Co. v. Pelzer*, 91 Fed. 665, 34 C. C. A. 45; *American Soda-Fountain Co. v. Swietusch*, 85 Fed. 968, 29 C. C. A. 506 [affirming 75 Fed. 573]; *Mast v. Iowa Windmill, etc., Co.*, 76 Fed. 816, 22 C. C. A. 586 [affirming 68 Fed. 213]; *Hubel v. Dick*, 28 Fed. 132; *Hudnut v. Lafayette Hominy Mills*, 26 Fed. 636; *Flower v. Detroit*, 22 Fed. 292; *Wooster v. Handy*, 21 Fed. 51; *Baltimore Car-Wheel Co. v. North Baltimore Pass. R. Co.*, 21 Fed. 47; *Turrell v. Bradford*, 15 Fed. 808, 21 Blatchf. 284; *Holt v. Keeler*, 13 Fed. 464, 21 Blatchf. 68; *Batten v. Taggart*, 2 Fed. Cas. No. 1,107, 2 Wall. Jr. 101 [reversed on other grounds in 17 How. 74, 15 L. ed. 37]; *Swain Turbine, etc., Co. v. Ladd*, 23 Fed. Cas. No. 13,662, 2 Ban. & A. 488, 11 Off. Gaz. 153. See also as sustaining this view *Whitely v. Swayne*, 29 Fed. Cas. No. 17,568, 4 Fish. Pat. Cas. 117 [affirmed in 7 Wall. 685, 19 L. ed. 199].

One having actual, as distinguished from constructive, notice of an original patent is not thereby chargeable with notice of all the possibilities of reissue, so as to make unavailable in his behalf the doctrine of intervening rights of one making devices covered by the reissue, but not by the original patent. *American Soda-Fountain Co. v. Swie-*

*tusch*, 85 Fed. 968, 29 C. C. A. 506 [affirming 75 Fed. 573].

**21.** *Carpenter Straw-Sewing Mach. Co. v. Searle*, 60 Fed. 82, 8 C. C. A. 476 [affirming 52 Fed. 809].

**22.** *Clements v. Odorless Excavating Apparatus Co.*, 109 U. S. 641, 3 S. Ct. 525, 27 L. ed. 1060; *Miller v. Bridgeport Brass Co.*, 104 U. S. 350, 26 L. ed. 783; *Flower v. Detroit*, 22 Fed. 292; *Baltimore Car-Wheel Co. v. North Baltimore Pass. R. Co.*, 21 Fed. 47; *Brainard v. Cramme*, 12 Fed. 621, 20 Blatchf. 530.

**23.** *Miller v. Bridgeport Brass Co.*, 104 U. S. 350, 26 L. ed. 783; *Flower v. Detroit*, 22 Fed. 292; *Wooster v. Handy*, 21 Fed. 51.

**24.** *Miller v. Bridgeport Brass Co.*, 104 U. S. 350, 26 L. ed. 783.

**25.** *Swain Turbine, etc., Co. v. Ladd*, 23 Fed. Cas. No. 13,662, 2 Ban. & A. 488, 11 Off. Gaz. 153.

**26.** *Goodyear v. Day*, 10 Fed. Cas. No. 5,566.

**27.** *In re Briede*, 27 App. Cas. (D. C.) 298, 123 Off. Gaz. 322; *In re Heroult*, 29 App. Cas. (D. C.) 42; *Whitcomb v. Spring Valley Coal Co.*, 47 Fed. 652; *Boland v. Thompson*, 26 Fed. 633, 23 Blatchf. 440.

For facts constituting insufficient excuse see *In re Briede*, 27 App. Cas. (D. C.) 298; *Wollensak v. Sargent*, 151 U. S. 221, 14 S. Ct. 291, 38 L. ed. 137; *Ives v. Sargent*, 119 U. S. 652, 7 S. Ct. 436, 30 L. ed. 544; *Haines v. Peck*, 26 Fed. 625.

For circumstances showing sufficient excuse for thirteen or fourteen years' delay see *Maitland v. B. Goetz Mfg. Co.*, 86 Fed. 124, 29 C. C. A. 607; *Celluloid Mfg. Co. v. Zylo-nite Brush, etc., Co.*, 27 Fed. 291.

**28.** *Hoskin v. Fisher*, 125 U. S. 217, 8 S. Ct. 834, 31 L. ed. 759; *Mahn v. Harwood*, 112 U. S. 354, 5 S. Ct. 174, 28 L. ed. 665; *Western Union Tel. Co. v. Baltimore, etc., Tel. Co.*, 25 Fed. 30.



**C. Identity of Invention<sup>29</sup> — 1. IN GENERAL.** The reissued patent must be for the same invention as the original patent and no new matter can be introduced.<sup>30</sup> The invention may be differently stated, but must remain the same.<sup>31</sup> The "same invention" as used in the reissue statute refers to whatever invention was described in the original letters patent and appears to have been secured

**29. Conclusiveness and effect of decision in patent office on issue of identity see *infra*, VIII, G, 3.**

**30. U. S. Rev. St. (1878) § 4916 [U. S. Comp. St. (1901) p. 3393];** *In re Hoey*, 23 App. Cas. (D. C.) 416; *Lehigh Valley R. Co. v. Kearney*, 158 U. S. 461, 15 S. Ct. 871, 39 L. ed. 1055; *Eby v. King*, 158 U. S. 366, 15 S. Ct. 972, 39 L. ed. 1018; *Olin v. Timken*, 155 U. S. 141, 15 S. Ct. 49, 39 L. ed. 100; *Dunham v. Dennison Mfg. Co.*, 154 U. S. 103, 14 S. Ct. 986, 38 L. ed. 924; *Corbin Cabinet Lock Co. v. Eagle Lock Co.*, 150 U. S. 38, 14 S. Ct. 28, 37 L. ed. 989; *Leggett v. Standard Oil Co.*, 149 U. S. 287, 13 S. Ct. 902, 37 L. ed. 737; *Huber v. N. O. Nelson Mfg. Co.*, 148 U. S. 270, 13 S. Ct. 603, 37 L. ed. 447; *Freeman v. Asmus*, 145 U. S. 226, 12 S. Ct. 939, 36 L. ed. 685; *Topliff v. Topliff*, 145 U. S. 156, 12 S. Ct. 825, 36 L. ed. 658; *Patent Clothing Co. v. Glover*, 141 U. S. 560, 12 S. Ct. 79, 35 L. ed. 858; *Yale Lock Mfg. Co. v. Berkshire Nat. Bank*, 135 U. S. 342, 10 S. Ct. 884, 34 L. ed. 168; *Pattee Plow Co. v. Kingman*, 129 U. S. 294, 9 S. Ct. 259, 32 L. ed. 700; *Farmers' Friend Mfg. Co. v. Challenge Corn-Planter Co.*, 128 U. S. 506, 9 S. Ct. 146, 32 L. ed. 529; *Flower v. Detroit*, 127 U. S. 563, 8 S. Ct. 1291, 32 L. ed. 175; *Worden v. Searls*, 121 U. S. 14, 7 S. Ct. 814, 30 L. ed. 853; *Gardner v. Herz*, 118 U. S. 180, 6 S. Ct. 1027, 30 L. ed. 158; *Eachus v. Broomall*, 115 U. S. 429, 6 S. Ct. 229, 29 L. ed. 419; *Cochrane v. Badische Anilin, etc., Fabrik*, 111 U. S. 293, 4 S. Ct. 455, 28 L. ed. 433; *McMurray v. Mallory*, 111 U. S. 97, 4 S. Ct. 375, 28 L. ed. 365; *Gage v. Herring*, 107 U. S. 640, 2 S. Ct. 819, 27 L. ed. 601; *Wing v. Anthony*, 106 U. S. 142, 1 S. Ct. 93, 27 L. ed. 110; *Johnson v. Flushing, etc., R. Co.*, 105 U. S. 539, 26 L. ed. 1162; *Hald v. Rice*, 104 U. S. 737, 26 L. ed. 910; *James v. Campbell*, 104 U. S. 356, 26 L. ed. 786; *Garneau v. Dozier*, 102 U. S. 230, 26 L. ed. 133; *Ball v. Langles*, 102 U. S. 128, 26 L. ed. 104; *Giant Powder Co. v. California Powder Works*, 98 U. S. 126, 25 L. ed. 77; *Marsh v. Seymour*, 97 U. S. 348, 24 L. ed. 963; *Russell v. Dodge*, 93 U. S. 460, 23 L. ed. 973; *Union Paper Collar Co. v. Van Deusen*, 23 Wall. (U. S.) 530, 23 L. ed. 128; *Gill v. Wells*, 22 Wall. (U. S.) 1, 22 L. ed. 699; *Littlefield v. Perry*, 21 Wall. (U. S.) 205, 22 L. ed. 577; *Seymour v. Osborne*, 11 Wall. (U. S.) 516, 20 L. ed. 33; *Battin v. Taggart*, 17 How. (U. S.) 74, 15 L. ed. 37; *Troy Laundry Mach. Co. v. Adams Laundry Mach. Co.*, 112 Fed. 437; *Idealite Co. v. Protection Light Co.*, 103 Fed. 973; *Gaskill v. Myers*, 81 Fed. 854, 26 C. C. A. 642; *Peoria Target Co. v. Cleveland Target Co.*, 58 Fed. 227, 7 C. C. A. 197; *American Heat Insulating Co. v. Johnston*, 52 Fed. 228,

3 C. C. A. 53; *Philadelphia Novelty Mfg. Co. v. Rouss*, 39 Fed. 273; *Hubel v. Dick*, 28 Fed. 132; *Gage v. Kellogg*, 26 Fed. 242; *Reed v. Chase*, 25 Fed. 94; *Driven Well Cases*, 16 Fed. 387, 5 McCrary 181; *Doane, etc., Mfg. Co. v. Smith*, 15 Fed. 459; *Gould v. Spicer*, 15 Fed. 344; *Hayes v. Seton*, 12 Fed. 120, 20 Blatchf. 484; *Walters v. Crandal*, 11 Fed. 868, 20 Blatchf. 118; *Smith v. Merriam*, 6 Fed. 903; *Novelty Paper-Box Co. v. Stapler*, 5 Fed. 919; *Flower v. Rayner*, 5 Fed. 793; *Washburn, etc., Mfg. Co. v. Haish*, 4 Fed. 900, 10 Biss. 65; *Putnam v. Tinkham*, 4 Fed. 411; *Siebert Cylinder Oil-Cup Co. v. Harper Steam Lubricator Co.*, 4 Fed. 328; *Yale Lock Mfg. Co. v. Scovill Mfg. Co.*, 3 Fed. 288, 18 Blatchf. 248; *Ball v. Withington*, 2 Fed. Cas. No. 815, 1 Ban. & A. 549, 6 Off. Gaz. 933; *Cahart v. Austin*, 4 Fed. Cas. No. 2,288, 2 Cliff. 528, 2 Fish. Pat. Cas. 543; *Cammermeyer v. Newton*, 4 Fed. Cas. No. 2,344, 4 Ban. & A. 159, 16 Off. Gaz. 720; *Ex p. Dyson*, 8 Fed. Cas. No. 4,228; *Francis v. Mellor*, 9 Fed. Cas. No. 5,039, 5 Fish. Pat. Cas. 153, 1 Off. Gaz. 48, 8 Phila. (Pa.) 157; *Hoffheins v. Brandt*, 12 Fed. Cas. No. 6,575, 3 Fish. Pat. Cas. 218; *Johnson v. Flushing, etc., R. Co.*, 13 Fed. Cas. No. 7,384, 3 Ban. & A. 428, 15 Blatchf. 192 [affirmed in 105 U. S. 539, 26 L. ed. 1162]; *Knight v. Baltimore, etc., R. Co.*, 14 Fed. Cas. No. 7,882, 3 Fish. Pat. Cas. 1, Taney 106; *Sickles v. Evans*, 22 Fed. Cas. No. 12,839, 2 Cliff. 203, 2 Fish. Pat. Cas. 417; *Sloat v. Spring*, 22 Fed. Cas. No. 12,948a; *Stevens v. Pritchard*, 23 Fed. Cas. No. 13,407, 2 Ban. & A. 390, 4 Cliff. 417, 10 Off. Gaz. 505; *Tucker v. Tucker Mfg. Co.*, 24 Fed. Cas. No. 14,227, 2 Ban. & A. 401, 4 Cliff. 397, 10 Off. Gaz. 464.

**Statement of advantage does not change invention.** *Whitcomb v. Spring Valley Coal Co.*, 47 Fed. 652; *Kearney v. Lehigh Valley R. Co.*, 32 Fed. 320; *Potter v. Stewart*, 7 Fed. 215, 18 Blatchf. 561; *Ex p. Ball*, 2 Fed. Cas. No. 810.

**31. McCreary v. Pennsylvania Canal Co.**, 14 Phila. (Pa.) 441; *Driven Well Cases*, 122 U. S. 40, 7 S. Ct. 1073, 30 L. ed. 1064; *Gage v. Herring*, 107 U. S. 640, 2 S. Ct. 819, 27 L. ed. 601; *Elizabeth v. American Nicholson Pavement Co.*, 97 U. S. 126, 24 L. ed. 1000; *Haggenmacher v. Nelson*, 88 Fed. 486; *Gas-kill v. Myers*, 81 Fed. 854, 26 C. C. A. 642; *Pratt v. Lloyd*, 65 Fed. 800; *Whitcomb v. Spring Valley Coal Co.*, 47 Fed. 652; *Hubel v. Waldie*, 35 Fed. 414; *National Pump Cylinder Co. v. Gunnison*, 17 Fed. 812; *Schilling v. Greenway Brewing Co.*, 17 Fed. 244, 21 Blatchf. 383; *Meyer v. Goodyear India-Rubber Glove Mfg. Co.*, 11 Fed. 891, 20 Blatchf. 91; *Yale Lock Mfg. Co. v. Scovill Mfg. Co.*, 3 Fed. 288, 18 Blatchf. 248; *Cahart v. Austin*, 4 Fed. Cas. No. 2,288, 2 Cliff.



thereby.<sup>32</sup> A broader claim than that in the original patent will not invalidate the reissue if it is for the same invention.<sup>33</sup> If not for the same invention it will.<sup>34</sup> Claims may be amended to include features not before claimed.<sup>35</sup> What may

528, 2 Fish. Pat. Cas. 543; *Carew v. Boston Electric Fabric Co.*, 5 Fed. Cas. No. 2,397, 3 Cliff. 356, 5 Fish. Pat. Cas. 90, 1 Off. Gaz. 91; *Carver v. Braintree Mfg. Co.*, 5 Fed. Cas. No. 2,485, 2 Robb Pat. Cas. 141, 2 Story 432; *Christman v. Rumsey*, 5 Fed. Cas. No. 2,704, 4 Ban. & A. 506, 17 Blatchf. 148, 17 Off. Gaz. 903, 58 How. Pr. (N. Y.) 114; *Crompton v. Belknap Mills*, 6 Fed. Cas. No. 3,406, 3 Fish. Pat. Cas. 536; *Decker v. Grote*, 7 Fed. Cas. No. 3,726, 10 Blatchf. 331, 6 Fish. Pat. Cas. 143, 3 Off. Gaz. 65; *Ex p. Dietz*, 7 Fed. Cas. No. 3,902; *Goodyear v. Providence Rubber Co.*, 10 Fed. Cas. No. 5,583, 2 Cliff. 351, 2 Fish. Pat. Cas. 499; *Hussey v. McCormick*, 12 Fed. Cas. No. 6,948, 1 Biss. 300, 1 Fish. Pat. Cas. 509; *Parham v. American Buttonhole, etc., Co.*, 18 Fed. Cas. No. 10,713, 4 Fish. Pat. Cas. 468; *Pearl v. Ocean Mills*, 19 Fed. Cas. No. 10,876, 2 Ban. & A. 469, 11 Off. Gaz. 2; *Pennsylvania Salt Mfg. Co. v. Thomas*, 19 Fed. Cas. No. 10,956, 5 Fish. Pat. Cas. 148, 8 Phila. (Pa.) 144; *St. Louis Stamping Co. v. Quinby*, 21 Fed. Cas. No. 12,240, 4 Ban. & A. 192, 16 Off. Gaz. 135; *Sarven v. Hall*, 21 Fed. Cas. No. 12,369, 9 Blatchf. 524, 5 Fish. Pat. Cas. 415, 1 Off. Gaz. 437; *Sloat v. Spring*, 22 Fed. Cas. No. 12,948a; *Tarr v. Folsom*, 23 Fed. Cas. No. 13,756, 1 Ban. & A. 24, Holmes 312, 5 Off. Gaz. 92; *Union Paper-Bag Co. v. Nixon*, 24 Fed. Cas. No. 14,386, 6 Fish. Pat. Cas. 402, 4 Off. Gaz. 31; *Union Paper-Collar Co. v. Leland*, 24 Fed. Cas. No. 14,394, 1 Ban. & A. 491, Holmes 427, 7 Off. Gaz. 221; *Crompton v. Belknap Mills*, 30 Fed. Cas. No. 18,285, 3 Fish. Pat. Cas. 536.

32. *Walker Pat. § 233*; *Parker, etc., Co. v. Yale Clock Co.*, 123 U. S. 87, 8 S. Ct. 38, 31 L. ed. 100; *In re Briede*, 27 App. Cas. (D. C.) 298, 123 Off. Gaz. 322.

33. *Topliff v. Topliff*, 145 U. S. 156, 12 S. Ct. 825, 36 L. ed. 658; *Morey v. Lockwood*, 8 Wall. (U. S.) 230, 19 L. ed. 339; *Fay v. Mason*, 120 Fed. 506 [reversed on other grounds in 127 Fed. 325]; *Hammond v. Franklin*, 22 Fed. 833, 23 Blatchf. 77; *Odell v. Stout*, 22 Fed. 159; *Jones v. Barker*, 11 Fed. 597; *Combined Patents Can Co. v. Lloyd*, 11 Fed. 149; *Wilson v. Coon*, 6 Fed. 611, 18 Blatchf. 532 [reversed on other grounds in 113 U. S. 268, 5 S. Ct. 537, 28 L. ed. 963]; *Dorsey Harvester Revolving Rake Co. v. Marsh*, 7 Fed. Cas. No. 4,014, 6 Fish. Pat. Cas. 387, 9 Phila. (Pa.) 395; *Lorillard v. McDowell*, 15 Fed. Cas. No. 8,510, 2 Ban. & A. 531, 11 Off. Gaz. 640, 13 Phila. (Pa.) 461; *Morse, etc., Tel. Case*, 17 Fed. Cas. No. 9,861; *Seymour v. Marsh*, 21 Fed. Cas. No. 12,687, 6 Fish. Pat. Cas. 115, 2 Off. Gaz. 675, 9 Phila. (Pa.) 380.

34. *McMurray v. Mallory*, 111 U. S. 97, 4 S. Ct. 375, 28 L. ed. 365; *American Heat Insulating Co. v. Johnston*, 52 Fed. 228, 3 C. C. A. 53 [reversing 48 Fed. 446]; *International Terra-Cotta Lumber Co. v. Maurer*,

44 Fed. 618; *Dunham v. Dennison Mfg Co.*, 40 Fed. 667 [affirmed in 154 U. S. 103, 14 S. Ct. 986, 38 L. ed. 924]; *Driven Well Cases*, 16 Fed. 387 [affirmed in 123 U. S. 267]; *Fay v. Preble*, 14 Fed. 652, 11 Biss. 422; *Searls v. Bouton*, 12 Fed. 874, 20 Blatchf. 528; *New York Bung, etc., Co. v. Hoffman*, 9 Fed. 199, 20 Blatchf. 3; *Meyer v. Maxheimer*, 9 Fed. 99; *Flower v. Rayner*, 5 Fed. 793; *Giant Powder Co. v. California Vigorit Powder Co.*, 4 Fed. 720, 6 Sawy. 508; *Goodyear v. Providence Rubber Co.*, 10 Fed. Cas. No. 5,583.

35. *Westinghouse v. New York Air-Brake Co.*, 59 Fed. 581 [modified in 63 Fed. 962, 11 C. C. A. 528]; *Adee v. Peck*, 42 Fed. 497; *Holmes Burglar Alarm Tel. Co. v. Domestic Tel., etc., Co.*, 42 Fed. 220; *Jenkins v. Stetson*, 32 Fed. 398; *Hubel v. Dick*, 28 Fed. 132; *Asmus v. Alden*, 27 Fed. 684; *Odell v. Stout*, 22 Fed. 159; *McWilliams Mfg. Co. v. Blundell*, 11 Fed. 419; *Atwood v. Portland Co.*, 10 Fed. 283; *Dederick v. Cassell*, 9 Fed. 306; *Smith v. Merriam*, 6 Fed. 713; *Stephenson v. Second Ave. R. Co.*, 1 Fed. 416; *Bantz v. Elsas*, 2 Fed. Cas. No. 967, 1 Ban. & A. 251, 6 Off. Gaz. 117; *Boomer v. United Power Press Co.*, 3 Fed. Cas. No. 1,638, 2 Ban. & A. 106, 13 Blatchf. 107; *Carew v. Boston Elastic Fabric Co.*, 5 Fed. Cas. No. 2,397, 3 Cliff. 356, 5 Fish. Pat. Cas. 90, 1 Off. Gaz. 91; *Carver v. Braintree Mfg. Co.*, 5 Fed. Cas. No. 2,485, 2 Robb Pat. Cas. 141, 2 Story 432; *Chicago Fruit-House Co. v. Busch*, 5 Fed. Cas. No. 2,669, 2 Biss. 472, 4 Fish. Pat. Cas. 395; *Christian v. Rumsey*, 5 Fed. Cas. No. 2,704, 4 Ban. & A. 506, 17 Blatchf. 148, 17 Off. Gaz. 903; *Dorsey Harvester Revolving Rake Co. v. Marsh*, 7 Fed. Cas. No. 4,014, 6 Fish. Pat. Cas. 387, 9 Phila. (Pa.) 395; *French v. Rogers*, 9 Fed. Cas. No. 5,103, 1 Fish. Pat. Cas. 133; *Gallahue v. Butterfield*, 9 Fed. Cas. No. 5,198, 10 Blatchf. 232, 6 Fish. Pat. Cas. 203, 2 Off. Gaz. 645; *Gould v. Ballard*, 10 Fed. Cas. No. 5,635, 3 Ban. & A. 324, 13 Off. Gaz. 1081; *Herring v. Nelson*, 12 Fed. Cas. No. 6,424, 3 Ban. & A. 55, 14 Blatchf. 293, 12 Off. Gaz. 753 [reversed on other grounds in 107 U. S. 640, 2 S. Ct. 819, 27 L. ed. 601]; *Middletown Tool Co. v. Judd*, 17 Fed. Cas. No. 9,536, 3 Fish. Pat. Cas. 141; *Morris v. Royer*, 17 Fed. Cas. No. 9,835, 2 Bond 66, 3 Fish. Pat. Cas. 176; *Parham v. American Buttonhole Overseaming, etc., Co.*, 18 Fed. Cas. No. 10,713, 4 Fish. Pat. Cas. 468; *Pennsylvania Salt Mfg. Co. v. Thomas*, 18 Fed. Cas. No. 10,956, 5 Fish. Pat. Cas. 148, 8 Phila. (Pa.) 144; *Pearl v. Ocean Mills*, 19 Fed. Cas. No. 10,876, 2 Ban. & A. 469, 11 Off. Gaz. 2; *Richardson v. Lockwood*, 20 Fed. Cas. No. 11,786, 4 Cliff. 128; *Seymour v. Marsh*, 21 Fed. Cas. No. 12,687, 6 Fish. Pat. Cas. 115, 2 Off. Gaz. 675, 9 Phila. (Pa.) 380; *Stevens v. Pritchard*, 23 Fed. Cas. No. 13,407, 2 Ban. & A. 390, 4 Cliff. 417, 10 Off. Gaz. 505; *Swift v. Whisen*, 23 Fed. Cas. No. 13,700, 2 Bond 115, 3 Fish. Pat. Cas. 348; *Woodward*



have been claimed originally may be included in the reissue.<sup>36</sup> Where the reissue omits several devices which were essential to the original purpose, the reissue is void.<sup>37</sup>

**2. NEW MATTER—a. In General.** The rule is otherwise, however, where the omission does not constitute an essential or material change but is only an incidental feature.<sup>38</sup> The reissue cannot include matter which formed a part of the patentee's real invention unless that matter was actually included in the original patent.<sup>39</sup> A failure to include it through inadvertence, accident, or mistake does not justify its inclusion by reissue.<sup>40</sup> Where the claims of the reissue contain new patentable matter which is so interwoven with other elements specified in the original that they cannot be separated, the entire reissued claim must be taken together and a patent issued thereon is void.<sup>41</sup>

**b. Intention to Claim.** It must furthermore appear from the face of the papers that the subject-matter covered by the claims of the reissue was not merely disclosed in the original patent, but was sought and intended to be claimed therein.<sup>42</sup> Matter abandoned or disclaimed on the original application cannot

*v. Dinsmore*, 30 Fed. Cas. No. 18,003, 4 Fish. Pat. Cas. 163; *Crompton v. Belknap Mills*, 30 Fed. Cas. No. 18,285, 3 Fish. Pat. Cas. 536.

**36.** *In re Briede*, 27 App. Cas. (D. C.) 298, 123 Off. Gaz. 322; *In re Heroult*, 29 App. Cas. (D. C.) 42; *Hobbs v. Beach*, 180 U. S. 383, 21 S. Ct. 409, 45 L. ed. 586; *Topliff v. Topliff*, 145 U. S. 156, 12 S. Ct. 825, 36 L. ed. 658; *Crown Cork, etc., Co. v. Aluminum Stopper Co.*, 100 Fed. 849; *Hendy v. Golden State, etc., Iron Works*, 17 Fed. 515, 8 Sawy. 468; *Calkins v. Bertrand*, 4 Fed. Cas. No. 2,317, 2 Ban. & A. 215, 6 Biss. 494, 9 Off. Gaz. 795; *Draper v. Wattles*, 7 Fed. Cas. No. 4,073, 3 Ban. & A. 618, 16 Off. Gaz. 629; *Swift v. Whisen*, 22 Fed. Cas. No. 13,700, 2 Bond 115, 3 Fish. Pat. Cas. 343; *Wilson v. Singer*, 30 Fed. Cas. No. 17,835; *In re Briede*, 123 Off. Gaz. 322.

**37.** *Johnson v. Flushing, etc., R. Co.*, 105 U. S. 539, 26 L. ed. 1162; *Russell v. Dodge*, 93 U. S. 460, 23 L. ed. 973; *Featherstone v. George R. Bidwell Cycle Co.*, 57 Fed. 631, 6 C. C. A. 487; *Brewster v. Shuler*, 37 Fed. 785; *Blackman v. Hibbler*, 3 Fed. Cas. No. 1,471, 4 Ban. & A. 641, 17 Blatchf. 333, 10 Reporter 257, 17 Off. Gaz. 107.

**38.** *Adee v. Peck*, 42 Fed. 497; *McWilliams Mfg. Co. v. Blundell*, 11 Fed. 419.

**39.** *Schillinger v. Cranford, 4 Mackey* (D. C.) 450; *Parker v. Yale Clock Co.*, 123 U. S. 87, 8 S. Ct. 38, 31 L. ed. 100; *Ives v. Sargent*, 119 U. S. 652, 7 S. Ct. 436, 30 L. ed. 544; *Hopkins, etc., Mfg. Co. v. Corbin*, 103 U. S. 786, 26 L. ed. 610; *Ball v. Langles*, 102 U. S. 128, 26 L. ed. 104; *Russell v. Dodge*, 93 U. S. 460, 23 L. ed. 973; *Seymour v. Osborne*, 11 Wall. (U. S.) 516, 20 L. ed. 33; *Weston Electrical Instrument Co. v. Stevens*, 134 Fed. 574, 67 C. C. A. 374; *Hammond v. Franklin*, 22 Fed. 833, 23 Blatchf. 77; *Washburn, etc., Mfg. Co. v. Fuchs*, 16 Fed. 661, 5 McCrary 236; *Lorillard v. McAlpin*, 14 Fed. 112; *Atwater Mfg. Co. v. Beecher Mfg. Co.*, 8 Fed. 608; *Siebert Cylinder Oil-Cup Co. v. Harper Steam Lubricator Co.*, 4 Fed. 328; *Albright v. Celluloid Harness Trimming Co.*, 1 Fed. Cas. No. 147, 2 Ban. & A. 629, 12 Off. Gaz. 227;

*Carew v. Boston Elastic Fabric Co.*, 5 Fed. Cas. No. 2,397, 3 Cliff. 356, 5 Fish. Pat. Cas. 90, 1 Off. Gaz. 91; *Chicago Fruit-House Co. v. Busch*, 5 Fed. Cas. No. 2,669, 2 Biss. 472, 4 Fish. Pat. Cas. 395; *Giant Powder Co. v. California Powder Works*, 10 Fed. Cas. No. 5,379, 2 Ban. & A. 131, 3 Sawy. 448 [*reversed* on other grounds in 98 U. S. 126, 25 L. ed. 77]; *Kelleher v. Darling*, 14 Fed. Cas. No. 7,653, 3 Ban. & A. 438, 4 Cliff. 424, 14 Off. Gaz. 673; *Sarven v. Hall*, 21 Fed. Cas. No. 12,369, 9 Blatchf. 524, 5 Fish. Pat. Cas. 415, 1 Off. Gaz. 437; *Thomas v. Shoe Mach. Mfg. Co.*, 22 Fed. Cas. No. 13,911, 3 Ban. & A. 557, 16 Off. Gaz. 541; *Tarr v. Webb*, 23 Fed. Cas. No. 13,757, 10 Blatchf. 96, 5 Fish. Pat. Cas. 593, 2 Off. Gaz. 568; *Vogler v. Semple*, 28 Fed. Cas. No. 16,987, 2 Ban. & A. 556, 7 Biss. 382, 11 Off. Gaz. 923.

**40.** *James v. Campbell*, 104 U. S. 356, 26 L. ed. 786; *Seymour v. Osborne*, 11 Wall. (U. S.) 516, 20 L. ed. 33; *O'Reilly v. Morse*, 15 How. (U. S.) 62, 14 L. ed. 601; *Carpenter Straw-Sewing Mach. Co. v. Searle*, 60 Fed. 82, 8 C. C. A. 476; *Cahart v. Austin*, 4 Fed. Cas. No. 2,288, 2 Cliff. 528, 2 Fish. Pat. Cas. 543; *Giant Powder Co. v. California Powder Works*, 10 Fed. Cas. No. 5,379, 2 Ban. & A. 131, 3 Sawy. 448 [*reversed* on other grounds in 98 U. S. 126, 25 L. ed. 77].

**41.** *Cahart v. Austin*, 4 Fed. Cas. No. 2,288, 2 Cliff. 528, 2 Fish. Pat. Cas. 543.

**42.** *Corbin Cabinet Lock Co. v. Eagle Lock Co.*, 150 U. S. 38, 14 S. Ct. 28, 37 L. ed. 989; *Freeman v. Asmus*, 145 U. S. 226, 12 S. Ct. 939, 36 L. ed. 685; *Parker v. Yale Clock Co.*, 123 U. S. 87, 8 S. Ct. 38, 31 L. ed. 100; *Matthews v. Boston Mach. Co.*, 105 U. S. 54, 26 L. ed. 1022; *Whip Co. v. Hassler*, 134 Fed. 398; *Idé v. Trorlicht, etc., Carpet Co.*, 115 Fed. 137, 53 C. C. A. 341; *American Soda-Fountain Co. v. Zwietusch*, 75 Fed. 573; *Carpenter Straw-Sewing Mach. Co. v. Searls*, 52 Fed. 809 [*affirmed* in 60 Fed. 82, 8 C. C. A. 476]; *Railway Register Mfg. Co. v. Broadway, etc., R. Co.*, 26 Fed. 522; *Turrell v. Bradford*, 15 Fed. 808, 21 Blatchf. 284; *Kells v. McKenzie*, 9 Fed. 284; *Giant Powder Co. v. California Powder Works*, 10 Fed. Cas. No.



ordinarily be claimed on reissue.<sup>43</sup> This doctrine does not apply, however, if the disclaimer was made by accident, inadvertence, or mistake.<sup>44</sup>

**c. Apparatus, Process, and Product.** A patent for an apparatus cannot generally be reissued to claim the process, since a process and the apparatus are not necessarily one and the same invention.<sup>45</sup> A process patent cannot generally be reissued to cover the apparatus.<sup>46</sup> There is no hard and fixed rule, however, and in some cases such a reissue may be allowed.<sup>46a</sup> A process patent may, however in some cases be reissued to cover the product produced by the process.<sup>47</sup>

**3. REINSERTION OF CANCELED CLAIM.** The patentee cannot obtain by reissue claims inserted in the original application and canceled therefrom in view of objection or rejection by the patent office.<sup>48</sup>

**D. Surrender of Original Patent.** To obtain a reissue, the applicant must surrender the original patent, but the surrender does not take effect until the reissue is granted, and if the reissue is refused the original patent is in force.<sup>49</sup> The so-called surrender is nothing but a preliminary offer prior to the issue of the new patent;<sup>50</sup> the original patent is extinguished by reissue.<sup>51</sup> Whether, if

5,379, 2 Ban. & A. 131, 3 Sawy. 448 [reversed on other grounds in 98 U. S. 126, 25 L. ed. 77].

43. *Leggett v. Avery*, 101 U. S. 256, 25 L. ed. 865; *Westinghouse Electric, etc., Co. v. Stanley Electric Mfg. Co.*, 115 Fed. 810; *Putnam v. Hutchinson*, 12 Fed. 127, 11 Biss. 233; *Edgerton v. Furst, etc., Mfg. Co.*, 9 Fed. 450, 10 Biss. 402; *Atwater Mfg. Co. v. Beecher Mfg. Co.*, 8 Fed. 608.

44. *American Shoe-Tip Co. v. National Shoe-Toe Protector Co.*, 1 Fed. Cas. No. 317, 2 Ban. & A. 551, 11 Off. Gaz. 740; *Hayden v. James*, 11 Fed. Cas. No. 6,260; *Hussey v. Bradley*, 12 Fed. Cas. No. 6,946, 5 Blatchf. 134, 2 Fish. Pat. Cas. 362.

45. *Eachus v. Broomall*, 115 U. S. 429, 6 S. Ct. 229, 29 L. ed. 419; *Heald v. Rice*, 104 U. S. 737, 26 L. ed. 910; *James v. Campbell*, 104 U. S. 356, 26 L. ed. 786; *Brainard v. Cramme*, 12 Fed. 621, 20 Blatchf. 530; *New v. Warren*, 22 Off. Gaz. 587.

46. *Wing v. Anthony*, 106 U. S. 142, 1 S. Ct. 93, 27 L. ed. 110; *James v. Campbell*, 104 U. S. 356, 26 L. ed. 786.

46a. *In re Heroult*, 29 App. Cas. (D. C.) 42.

47. *Giant Powder Co. v. California Powder Works*, 98 U. S. 126, 25 L. ed. 77; *Tucker v. Dana*, 7 Fed. 213; *Badische Anilin, etc., Fabrik v. Hamilton Mfg. Co.*, 2 Fed. Cas. No. 721, 3 Ban. & A. 235, 13 Off. Gaz. 273; *Badische Anilin, etc., Fabrik v. Higgin*, 2 Fed. Cas. No. 722, 3 Ban. & A. 462, 15 Blatchf. 290, 14 Off. Gaz. 414; *Tucker v. Burditt*, 24 Fed. Cas. No. 14,216, 4 Ban. & A. 569; *Hunter v. Carrick*, 11 Can. Sup. Ct. 300 [affirming 10 Ont. App. 449 (reversing 28 Grant Ch. (U. C.) 489)]; *Auer Incandescent Light Mfg. Co. v. O'Brien*, 5 Can. Exch. 243.

Process reissued for product declared invalid in the following cases see *Leggett v. Standard Oil Co.*, 149 U. S. 287, 13 S. Ct. 902, 37 L. ed. 737; *Giant Powder Co. v. California Powder Works*, 98 U. S. 126, 25 L. ed. 77; *Vacuum Oil Co. v. Buffalo Lubricating Oil Co.*, 20 Fed. 850; *Kelleher v. Daring*, 14 Fed. Cas. No. 7,653, 3 Ban. & A. 438, 4 Cliff. 424, 14 Off. Gaz. 673.

48. *In re Lacroix*, 30 App. Cas. (D. C.) 299; *In re Denton*, 12 App. Cas. (D. C.) 504; *In re Hatchman*, 3 Mackey (D. C.) 288; *Corbin Cabinet Lock Co. v. Eagle Lock Co.*, 150 U. S. 38, 14 S. Ct. 28, 37 L. ed. 989; *Dobson v. Lees*, 137 U. S. 258, 11 S. Ct. 71, 34 L. ed. 652; *Crawford v. Heysinger*, 123 U. S. 589, 8 S. Ct. 399, 31 L. ed. 269; *Beecher Mfg. Co. v. Atwater Mfg. Co.*, 114 U. S. 523, 5 S. Ct. 1007, 29 L. ed. 232; *Union Metallic Cartridge Co. v. U. S. Cartridge Co.*, 112 U. S. 624, 5 S. Ct. 475, 28 L. ed. 828; *Goodyear Dental Vulcanite Co. v. Davis*, 102 U. S. 222, 26 L. ed. 149; *Leggett v. Avery*, 101 U. S. 256, 25 L. ed. 865; *Franklin v. Illinois Moulding Co.*, 128 Fed. 48 [affirmed in 138 Fed. 58, 70 C. C. A. 484]; *American Soda-Fountain Co. v. Swietusch*, 85 Fed. 968, 29 C. C. A. 506; *Dobson v. Lees*, 30 Fed. 625; *Boland v. Thompson*, 26 Fed. 633, 23 Blatchf. 440; *Arnheim v. Finster*, 26 Fed. 277; *Arnheim v. Finster*, 24 Fed. 276; *Streit v. Lauter*, 11 Fed. 309; *Giant Powder Co. v. California Powder Works*, 10 Fed. Cas. No. 5,379, 2 Ban. & A. 131, 3 Sawy. 448 [reversed on other grounds in 98 U. S. 126, 25 L. ed. 77]; *Wicks v. Stevens*, 29 Fed. Cas. No. 17,616, 2 Ban. & A. 318, 2 Woods 310.

Actual mistake in canceling claim may be corrected. *Morey v. Lockwood*, 8 Wall. (U. S.) 230, 19 L. ed. 339; *Dunbar v. Eastern Elevating Co.*, 75 Fed. 567; *Hutchinson v. Everett*, 33 Fed. 502.

49. U. S. Rev. St. (1878) § 4916 [U. S. Comp. St. (1901) p. 3393]; *McCormick Harvesting Mach. Co. v. Aultman-Miller Co.*, 169 U. S. 606, 18 S. Ct. 443, 42 L. ed. 875; *Allen v. Culp*, 166 U. S. 501, 17 S. Ct. 644, 41 L. ed. 1093; *Forbes v. Barstow Stove Co.*, 9 Fed. Cas. No. 4,923, 2 Cliff. 379.

Grounds of refusal of reissue in terms may show that original patent is void. *Peck v. Collins*, 103 U. S. 660, 26 L. ed. 512.

50. *Forbes v. Barstow Stove Co.*, 9 Fed. Cas. No. 4,923, 2 Cliff. 379.

51. *Peck v. Collins*, 103 U. S. 660, 26 L. ed. 512; *Franklin v. Illinois Moulding Co.*, 128 Fed. 48 [affirmed in 138 Fed. 58, 70 C. C. A. 484]; *Brown v. Hinkley*, 4 Fed. Cas. No.



the reissue be void, the patentee may fall back on his original patent has not been decided by the supreme court, although the question has been raised.<sup>52</sup> It has been held in the circuit court that, if the reissue is void for want of authority to make it, the surrender is ineffective for want of authority to accept it.<sup>53</sup> Suit cannot be maintained on the original after application for reissue and before the grant.<sup>54</sup>

**E. Applications and Proceedings Thereon** — 1. **IN GENERAL.** Where the application should put forth facts entitling the patentee to a reissue<sup>55</sup> it is not indispensable that the petitioner should use the exact phraseology of the statute if he employs language which actually conveys its legal meaning.<sup>56</sup> It must be signed and sworn to by the inventor if he is alive and must be acquiesced in by assignees.<sup>57</sup> The proceedings thereon are the same as in the case of original applications except that a filing fee of thirty dollars is charged and no final fee is required.<sup>58</sup>

**2. DIVISIONAL REISSUES.** Several reissues may be granted for parts of the thing patented upon the payment of separate fees and other due proceedings had.<sup>59</sup>

**F. Reissues of Reissued Patents.** A reissue may be granted of a reissued patent as well as of the original,<sup>60</sup> and a second reissue may return to the language of the original patent and be identical therewith.<sup>61</sup>

**G. Conclusiveness and Effect of Patent Office Decisions** — 1. **IN GENERAL.** The grant of a reissue by the patent office raises a presumption that the patentee

2,012, 6 Fish. Pat. Cas. 370, 3 Off. Gaz. 384; Reedy v. Scott, 10 Am. & Eng. Pat. Cas. 133.

52. See Allen v. Culp, 166 U. S. 501, 17 S. Ct. 644, 41 L. ed. 1093; Eby v. King, 158 U. S. 366, 15 S. Ct. 972, 39 L. ed. 1018.

53. French v. Rogers, 9 Fed. Cas. No. 5,103, 1 Fish. Pat. Cas. 133. See also Woodworth v. Hall, 30 Fed. Cas. No. 18,016, 2 Robb Pat. Cas. 495, 1 Woodb. & M. 248.

54. Moffitt v. Garr, 1 Black (U. S.) 273, 17 L. ed. 207 [affirming 17 Fed. Cas. No. 9,690, 1 Bond 315, 1 Fish. Pat. Cas. 6101]; Burrell v. Hackley, 35 Fed. 833. Compare Robbins v. Illinois Watch Co., 50 Fed. 542 [affirmed in 52 Fed. 215, 3 C. C. A. 42].

55. Eby v. King, 158 U. S. 366, 15 S. Ct. 972, 39 L. ed. 1018, in which it was said to be doubtful whether the commissioner acquired any jurisdiction, where there is only a bare statement that the patentee wishes to surrender his patent and obtain a reissue.

56. Gold, etc., Tel. Co. v. Wiley, 17 Fed. 234.

57. U. S. Rev. St. (1878) § 4895 [U. S. Comp. St. (1901) p. 3385]; Holloway v. Whiteley, 4 Wall. (U. S.) 522, 18 L. ed. 335; Selden v. Stockwell Self-Lighting Gas Burner Co., 9 Fed. 390, 19 Blatchf. 544. And see *supra*, VIII, A, 3.

Licensee need not join in application. Meyer v. Bailey, 17 Fed. Cas. No. 9,516, 2 Ban. & A. 73, 8 Off. Gaz. 437.

Assignee may file where inventor is dead. Wooster v. Handy, 21 Fed. 51.

Guardian of insane person may file application. Whitcomb v. Spring Valley Coal Co., 47 Fed. 652.

Absence of oath has been held not fatal. Hartshorn v. Eagle Shade Roller Co., 18 Fed. 90.

58. U. S. Rev. St. (1878) §§ 4916, 4934 [U. S. Comp. St. (1901) pp. 3393, 3400].

Subject to reexamination see McCormick

Harvesting Mach. Co. v. Aultman-Miller Co., 169 U. S. 606, 18 S. Ct. 443, 42 L. ed. 875; Allen v. Culp, 166 U. S. 501, 17 S. Ct. 644, 41 L. ed. 1093; Peck v. Collins, 103 U. S. 660, 26 L. ed. 512; Holloway v. Whiteley, 4 Wall. (U. S.) 522, 18 L. ed. 335; Wilson v. Singer, 30 Fed. Cas. No. 17,835.

59. U. S. Rev. St. (1878) § 4916 [U. S. Comp. St. (1901) p. 3393]; International Terra-Cotta Lumber Co. v. Maurer, 44 Fed. 618; Selden v. Stockwell Self-Lighting Gas Burner Co., 9 Fed. 390, 19 Blatchf. 544; Tucker v. Dana, 7 Fed. 213; Badische Anilin, etc., Fabrik v. Hamilton Mfg. Co., 2 Fed. Cas. No. 721, 3 Ban. & A. 235, 13 Off. Gaz. 273; Pennsylvania Salt Mfg. Co. v. Thomas, 19 Fed. Cas. No. 10,956, 5 Fish. Pat. Cas. 148, 8 Phila. (Pa.) 144; *Ex p. Selden*, 21 Fed. Cas. No. 12,638; Tucker v. Burditt, 24 Fed. Cas. No. 14,216, 4 Ban. & A. 569; Wheeler v. Clipper Mower, etc., Co., 29 Fed. Cas. No. 17,493, 10 Blatchf. 181, 6 Fish. Pat. Cas. 1, 2 Off. Gaz. 442; Wheeler v. McCormick, 29 Fed. Cas. No. 17,499, 11 Blatchf. 334, 6 Fish. Pat. Cas. 551, 4 Off. Gaz. 692.

60. Schneider v. Bassett, 13 Fed. 351; Selden v. Stockwell Self-Lighting Gas Burner Co., 9 Fed. 390, 19 Blatchf. 544; French v. Rogers, 9 Fed. Cas. No. 5,103, 1 Fish. Pat. Cas. 133; Giant Powder Co. v. California Powder Works, 10 Fed. Cas. No. 5,379, 2 Ban. & A. 131, 3 Sawy. 448 [reversed in 98 U. S. 126, 25 L. ed. 77]; Morse, etc., Tel. Case, 17 Fed. Cas. No. 9,861; Swift v. Whisen, 23 Fed. Cas. No. 13,700, 2 Bond 115, 3 Fish. Pat. Cas. 343; Union Paper Collar Co. v. White, 24 Fed. Cas. No. 14,396, 2 Ban. & A. 60, 7 Off. Gaz. 877, 11 Phila. (Pa.) 479.

61. Sawyer Spindle Co. v. Eureka Spindle Co., 33 Fed. 836 [affirmed in 145 U. S. 637, 12 S. Ct. 980, 36 L. ed. 849]; Celluloid Mfg. Co. v. Zylonite Brush, etc., Co., 27 Fed. 291; Giant Powder Co. v. Safety Nitro Powder Co., 19 Fed. 509.



was entitled to it and therefore the reissue is *prima facie* valid.<sup>62</sup> Except as to matters appearing on the face of the papers showing excess of jurisdiction by the patent it is conclusive.<sup>63</sup>

**2. AS TO GROUNDS FOR REISSUE.** The conclusion of the patent office officials as to inadvertence, accident, or mistake and as to regularity of proceedings is conclusive in the absence of a showing of fraud.<sup>64</sup>

**3. AS TO IDENTITY.** The grant of a reissue raises a presumption that it covers the same invention which was sought and intended to be claimed in the original, but such presumption is not conclusive and is to be decided from the face of the papers.<sup>65</sup>

62. Crown Cork, etc., Co. v. Aluminum Stopper Co., 108 Fed. 845, 48 C. C. A. 72; Beach v. Hobbs, 92 Fed. 146, 34 C. C. A. 248; Washburn, etc., Mfg. Co. v. Haish, 4 Fed. 900, 10 Biss. 65; Allen v. Blunt, 1 Fed. Cas. No. 217, 2 Robb Pat. Cas. 530, 2 Woodb. & M. 121; American Diamond Rock Boring Co. v. Sheldon, 1 Fed. Cas. No. 296, 4 Ban. & A. 551, 17 Blatchf. 208; American Nicholson Pavement Co. v. Elizabeth, 1 Fed. Cas. No. 311, 6 Fish. Pat. Cas. 424, 3 Off. Gaz. 522 [modified in 97 U. S. 126, 24 L. ed. 1000]; Blake v. Stafford, 3 Fed. Cas. No. 1,504, 6 Blatchf. 195, 3 Fish. Pat. Cas. 294; Eickemeyer Hat Blocking Mach. Co. v. Pearce, 8 Fed. Cas. No. 4,312, 10 Blatchf. 403, 6 Fish. Pat. Cas. 219, 3 Off. Gaz. 150; Forbes v. Barstow Stove Co., 9 Fed. Cas. No. 4,923, 2 Cliff. 379; Jordan v. Dobson, 13 Fed. Cas. No. 7,519, 2 Abb. 398, 4 Fish. Pat. Cas. 232, 7 Phila. (Pa.) 533; Middletown Tool Co. v. Judd, 17 Fed. Cas. No. 9,536, 3 Fish. Pat. Cas. 141; Poppenhusen v. Falke, 19 Fed. Cas. No. 11,279, 4 Blatchf. 493, 2 Fish. Pat. Cas. 181.

63. Seymour v. Osborne, 11 Wall. (U. S.) 516, 20 L. ed. 33; Spaeth v. Barney, 22 Fed. 828; Giant Powder Co. v. California Vigorit Powder Co., 4 Fed. 720, 6 Sawy. 508; Bird-sall v. McDonald, 3 Fed. Cas. No. 1,434, 1 Ban. & A. 165, 6 Off. Gaz. 682; Blake v. Stafford, 3 Fed. Cas. No. 1,504, 6 Blatchf. 195, 3 Fish. Pat. Cas. 294; Chicago Fruit-House Co. v. Busch, 5 Fed. Cas. No. 2,669, 2 Biss. 472, 4 Fish. Pat. Cas. 395; Judson v. Bradford, 14 Fed. Cas. No. 7,564, 3 Ban. & A. 539, 16 Off. Gaz. 171; Metropolitan Washing-Mach. Co. v. Providence Tool Co., 17 Fed. Cas. No. 9,507, Holmes 161 [affirmed in 20 Wall. 342, 22 L. ed. 303]; Milligan, etc., Glue Co. v. Upton, 17 Fed. Cas. No. 9,607, 1 Ban. & A. 497, 4 Cliff. 237, 6 Off. Gaz. 837; Parham v. American Buttonhole, etc., Co., 18 Fed. Cas. No. 10,713, 4 Fish. Pat. Cas. 468; Stevens v. Pritchard, 23 Fed. Cas. No. 13,407, 2 Ban. & A. 390, 4 Cliff. 417, 10 Off. Gaz. 505; Thomas v. Shoe Mach. Mfg. Co., 23 Fed. Cas. No. 13,911, 3 Ban. & A. 557, 16 Off. Gaz. 541; Wells v. Gill, 29 Fed. Cas. No. 17,394, 6 Fish. Pat. Cas. 89, 2 Off. Gaz. 590; Wells v. Jaques, 29 Fed. Cas. No. 17,398, 1 Ban. & A. 60, 5 Off. Gaz. 364.

64. Mahn v. Harwood, 112 U. S. 354, 5 S. Ct. 174, 6 S. Ct. 451, 28 L. ed. 665; Stimpson v. West Chester R. Co., 4 How. (U. S.) 380, 11 L. ed. 1020; Justi v. Clark, 108 Fed. 659, 47 C. C. A. 565 [affirming 100 Fed. 855]; Beach v. Hobbs, 82 Fed. 916; As-

mus v. Alden, 27 Fed. 684; Western Union Tel. Co. v. Baltimore, etc., Tel. Co., 25 Fed. 30; Selden v. Stockwell Self-Lighting Gas Burner Co., 9 Fed. 390, 19 Blatchf. 544; Smith v. Merriam, 6 Fed. 713; Christman v. Rumsey, 3 Fed. Cas. No. 2,704, 4 Ban. & A. 506, 17 Blatchf. 148, 17 Off. Gaz. 903, 58 How. Pr. (N. Y.) 114; Day v. Goodyear, 7 Fed. Cas. No. 3,678; Hoffheins v. Brandt, 12 Fed. Cas. No. 6,575, 3 Fish. Pat. Cas. 218; Kerosene Lamp Heater Co. v. Littell, 14 Fed. Cas. No. 7,724, 3 Ban. & A. 312, 13 Off. Gaz. 1009; Middleton Tool Co. v. Judd, 17 Fed. Cas. No. 9,536, 3 Fish. Pat. Cas. 141; Miller, etc., Mfg. Co. v. Du Brul, 17 Fed. Cas. No. 9,597, 2 Ban. & A. 618, 12 Off. Gaz. 351; Sloat v. Spring, 22 Fed. Cas. No. 12,948a; Swift v. Whisen, 23 Fed. Cas. No. 13,700, 2 Bond 115, 3 Fish. Pat. Cas. 343; Thomas v. Shoe Mach. Mfg. Co., 23 Fed. Cas. No. 13,911, 3 Ban. & A. 557, 16 Off. Gaz. 541.

**Limitation of rule.**—Error manifest from the record will be considered. Westinghouse Electric, etc., Mfg. Co. v. Stanley Electric Mfg. Co., 115 Fed. 810; Peoria Target Co. v. Cleveland Target Co., 53 Fed. 227, 7 C. C. A. 197 [affirming 47 Fed. 728]; Featherstone v. George R. Bidwell Cycle Co., 57 Fed. 631, 6 C. C. A. 487.

**In Canada** the ruling of the commissioner of patents that the patent was defective or inoperative is conclusive. Auer Incandescent Light Mfg. Co. v. O'Brien, 5 Can. Exch. 243.

65. O'Reilly v. Morse, 15 How. (U. S.) 62, 14 L. ed. 601; Dederick v. Cassell, 9 Fed. 306; Allen v. Blunt, 1 Fed. Cas. No. 217, 2 Robb Pat. Cas. 530, 2 Woodb. & M. 121; American Nicholson Pavement Co. v. Elizabeth, 1 Fed. Cas. No. 311, 6 Fish. Pat. Cas. 424, 3 Off. Gaz. 522 [modified in 97 U. S. 126, 24 L. ed. 1000]; Andrews v. Wright, 1 Fed. Cas. No. 382, 3 Ban. & A. 329, 6 Reporter 193, 13 Off. Gaz. 969; Bantz v. Elsas, 2 Fed. Cas. No. 967, 1 Ban. & A. 351, 6 Off. Gaz. 117; Blake v. Stafford, 3 Fed. Cas. No. 1,504, 6 Blatchf. 195, 3 Fish. Pat. Cas. 294; French v. Rogers, 9 Fed. Cas. No. 5,103, 1 Fish. Pat. Cas. 133; Guidet v. Barber, 11 Fed. Cas. No. 5,857, 5 Off. Gaz. 149; House v. Young, 12 Fed. Cas. No. 6,738, 3 Fish. Pat. Cas. 335; Hussey v. Bradley, 12 Fed. Cas. No. 6,946, 5 Blatchf. 134, 2 Fish. Pat. Cas. 362; Hussey v. McCormick, 12 Fed. Cas. No. 6,948, 1 Biss. 300, 1 Fish. Pat. Cas. 509; Jordan v. Dobson, 13 Fed. Cas. No. 7,519, 2 Abb. 398, 4 Fish. Pat. Cas. 232, 7 Phila. (Pa.) 533; Poppenhusen v. Falke, 19 Fed.



## H. Validity, Construction, and Operation of Reissues<sup>66</sup> — 1. VALIDITY.

Aside from the questions of new matter and estoppel, the validity of a reissue is determined by the same considerations as the original patent,<sup>67</sup> and, upon the questions of anticipation and public use and sale, relates back to the date of the original application for patent.<sup>68</sup> Fraud will invalidate the reissue,<sup>69</sup> but clerical error,<sup>70</sup> or irregularities of procedure in matters not vital,<sup>71</sup> will not. One claim in a reissue may be void without necessarily invalidating the other claims, and in such case it is proper to disclaim the void claim,<sup>72</sup> and a reissue is not invalid merely because the claim of the original patent was valid.<sup>73</sup>

2. CONSTRUCTION AND OPERATION — a. In General. As respects the construction and operation of reissues the same rules apply as in original patents.<sup>74</sup>

Cas. No. 11,279, 4 Blatchf. 493, 2 Fish. Pat. Cas. 181; *Reissner v. Anness*, 20 Fed. Cas. No. 11,688, 3 Ban. & A. 176, 13 Off. Gaz. 870; *Sloat v. Spring*, 22 Fed. Cas. No. 12,948a; *Stevens v. Pritchard*, 23 Fed. Cas. No. 13,407, 2 Ban. & A. 390, 4 Cliff. 417, 10 Off. Gaz. 505; *Thomas v. Shoe Mach. Mfg. Co.*, 24 Fed. Cas. No. 13,911, 3 Ban. & A. 557, 16 Off. Gaz. 541; U. S., etc., *Felting Co. v. Haven*, 28 Fed. Cas. No. 16,788, 2 Ban. & A. 164, 3 Dill. 131, 9 Off. Gaz. 253; *Woodworth v. Edwards*, 30 Fed. Cas. No. 18,014, 2 Robb Pat. Cas. 610, 3 Woodb. & M. 120.

That identity is determined by comparison of original and reissue see *Hoskin v. Fisher*, 125 U. S. 217, 8 S. Ct. 834, 31 L. ed. 759; *Russell v. Dodge*, 93 U. S. 460, 23 L. ed. 973; *Stimpson v. West Chester R. Co.*, 4 How. (U. S.) 380, 11 L. ed. 1020; *Searls v. Worden*, 11 Fed. 501; *Flower v. Rayner*, 5 Fed. 793; *Allen v. Blunt*, 1 Fed. Cas. No. 217, 2 Robb Pat. Cas. 598, 2 Woodb. & M. 121; *American Diamond Rock Boring Co. v. Sheldon*, 1 Fed. Cas. No. 296, 4 Ban. & A. 603, 17 Blatchf. 303; *Bridge v. Brown*, 4 Fed. Cas. No. 1,857, *Holmes* 53; *Cahart v. Austin*, 4 Fed. Cas. No. 2,288, 2 Cliff. 528, 2 Fish. Pat. Cas. 543; *Goodyear v. Berry*, 10 Fed. Cas. No. 5,556, 2 Bond 189, 3 Fish. Pat. Cas. 439; *Graham v. Mason*, 10 Fed. Cas. No. 5,671, 4 Cliff. 88, 5 Fish. Pat. Cas. 1; *Johnson v. Beard*, 13 Fed. Cas. No. 7,371, 2 Ban. & A. 50, 8 Off. Gaz. 435; *Middleton Tool Co. v. Judd*, 17 Fed. Cas. No. 9,536, 3 Fish. Pat. Cas. 141; *Reissner v. Anness*, 20 Fed. Cas. No. 11,688, 3 Ban. & A. 176, 13 Off. Gaz. 870; *Sickles v. Evans*, 22 Fed. Cas. No. 12,839, 2 Cliff. 203, 2 Fish. Pat. Cas. 417; *Thomas v. Shoe Mach. Mfg. Co.*, 23 Fed. Cas. No. 13,911, 3 Ban. & A. 557, 16 Off. Gaz. 541; *Tucker v. Tucker Mfg. Co.*, 25 Fed. Cas. No. 14,227, 2 Ban. & A. 401, 4 Cliff. 397, 10 Off. Gaz. 464; *Woodward v. Dinsmore*, 30 Fed. Cas. No. 18,003, 4 Fish. Pat. Cas. 163.

The question of identity is one of law for the court. *Heald v. Rice*, 104 U. S. 737, 26 L. ed. 910; *Seymour v. Osborne*, 11 Wall. (U. S.) 516, 20 L. ed. 33.

That original patent must be introduced for comparison see *Doherty v. Haynes*, 7 Fed. Cas. No. 3,963, 1 Ban. & A. 289, 4 Cliff. 291, 6 Off. Gaz. 118; *Johnson v. Beard*, 13 Fed. Cas. No. 7,371, 2 Ban. & A. 50, 8 Off. Gaz. 435.

66. Identity of invention see *supra*, VIII, C.

67. U. S. Rev. St. (1878) § 4916 [U. S. Comp. St. (1901) p. 3393] *Shaw v. Cooper*, 7 Pet. (U. S.) 292, 8 L. ed. 639; *Forsyth v. Clapp*, 9 Fed. Cas. No. 4,949, 6 Fish. Pat. Cas. 528, *Holmes* 278, 4 Off. Gaz. 527.

68. U. S. Stamping Co. v. King, 7 Fed. 860, 17 Blatchf. 55; *Bloomer v. Stolley*, 3 Fed. Cas. No. 1,559, *Fish. Pat. Rep.* 376, 5 McLean 158; *House v. Young*, 12 Fed. Cas. No. 6,738, 3 Fish. Pat. Cas. 335; *Hussey v. Bradley*, 12 Fed. Cas. No. 6,946, 5 Blatchf. 134, 2 Fish. Pat. Cas. 362; *Smith v. Pearce*, 22 Fed. Cas. No. 13,089, 2 McLean 176, 2 Robb Pat. Cas. 13; *Stanley v. Whipple*, 22 Fed. Cas. No. 13,286, 2 McLean 35, 2 Robb Pat. Cas. 1; *Woodworth v. Hall*, 30 Fed. Cas. No. 18,016, 2 Robb Pat. Cas. 495, 1 Woodb. & M. 248.

69. *Odell v. Stout*, 22 Fed. 159; *Poppenhusen v. Falke*, 19 Fed. Cas. No. 11,280, 5 Blatchf. 46, 2 Fish. Pat. Cas. 213; *Singer v. Walmsley*, 22 Fed. Cas. No. 12,900, 1 Fish. Pat. Cas. 558; *Swift v. Whisen*, 22 Fed. Cas. No. 13,700, 2 Bond 115, 3 Fish. Pat. Cas. 343.

70. *Bignall v. Harvey*, 4 Fed. 334, 18 Blatchf. 353; *Kendricks v. Emmons*, 14 Fed. Cas. No. 7,695, 2 Ban. & A. 208, 9 Off. Gaz. 201; *Robertson v. Secombe Mfg. Co.*, 20 Fed. Cas. No. 11,928, 10 Blatchf. 481, 6 Fish. Pat. Cas. 268, 3 Off. Gaz. 412.

71. *Dental Vulcanite Co. v. Wetherbee*, 7 Fed. Cas. No. 3,810, 2 Cliff. 555, 3 Fish. Pat. Cas. 87.

72. *Gage v. Herring*, 107 U. S. 640, 2 S. Ct. 819, 27 L. ed. 601; *Rawson, etc., Mfg. Co. v. C. W. Hunt Co.*, 147 Fed. 239, 77 C. C. A. 381; *Worden v. Searls*, 21 Fed. 406; *Havemeyer v. Randall*, 21 Fed. 404; *Dryfoos v. Wiese*, 19 Fed. 315; *Fetter v. Newhall*, 17 Fed. 841, 21 Blatchf. 445; *Wood v. Packer*, 17 Fed. 650; *Schillinger v. Greenway Brewing Co.*, 17 Fed. 244, 21 Blatchf. 383; *Cote v. Moffitt*, 15 Fed. 345; *Starrett v. Athol Mach. Co.*, 14 Fed. 910; *Tyler v. Galloway*, 12 Fed. 567, 20 Blatchf. 445; *Collins Co. v. Coes*, 3 Fed. 225.

73. *Wilson v. Coon*, 6 Fed. 611, 18 Blatchf. 532.

74. U. S. Rev. St. (1878) § 4916 [U. S. Comp. St. (1901) p. 3393]; *Grant v. Townsend*, 10 Fed. Cas. No. 5,701; *Parham v. American Buttonhole Overseaming, etc., Mach. Co.*, 18 Fed. Cas. No. 10,713, 4 Fish. Pat. Cas. 468.

If possible the reissue will be sustained. *Brainard v. Cramme*, 12 Fed. 621, 20 Blatchf.



**b. Retroactive Operation.** An infringer of the claims of a reissue can be held only for acts committed after the reissue is granted.<sup>75</sup> But the fact that he was using the invention before the reissue was granted does not relieve him from liability for using it subsequent to the reissue.<sup>76</sup>

## IX. DISCLAIMERS.

**A. In General.** The patentee, his heirs or assigns, whether of the whole or any particular interest therein, may upon payment of the fee fixed by law make his disclaimer of such parts of the thing patented as he shall not choose to claim or hold under the patent.<sup>77</sup> It must indicate the interest of the disclaimant,<sup>78</sup> and must be in writing attested by one or more witnesses and must be recorded in the patent office.<sup>79</sup>

**B. Subject-Matter of Disclaimer.** The separate claims of a patent may be eliminated by disclaimer, but they cannot be amended and transformed into other claims, and matter cannot be added to the specification under guise of disclaimer.<sup>80</sup>

530; *Ely v. Monson, etc., Mfg. Co.*, 8 Fed. Cas. No. 4,431, 4 Fish. Pat. Cas. 64.

75. U. S. Rev. St. (1878) § 4916 [U. S. Comp. St. (1901) p. 3393]; *Brown v. Hinkley*, 4 Fed. Cas. No. 2,012, 6 Fish. Pat. Cas. 370, 3 Off. Gaz. 384; *Perry v. Skinner*, 1 Jur. 433, 6 L. J. Exch. 124, M. & H. 122, 2 M. & W. 471; 35 Vict. c. 26, § 19; 38 Vict. c. 14, § 1.

76. *Agawam Woolen Co. v. Jordan*, 7 Wall. (U. S.) 583, 19 L. ed. 177; *Stimpson v. West Chester R. Co.*, 4 How. (U. S.) 380, 11 L. ed. 1020; *Bliss v. Brooklyn*, 3 Fed. Cas. No. 1,544, 8 Blatchf. 533, 4 Fish. Pat. Cas. 596; *Bloomer v. Stolley*, 3 Fed. Cas. No. 1,559, Fish. Pat. Rep. 376, 5 McLean 158; *Carr v. Rice*, 5 Fed. Cas. No. 2,440, 1 Fish. Pat. Cas. 198; *Goodyear v. Day*, 10 Fed. Cas. No. 5,566; *Howe v. Williams*, 12 Fed. Cas. No. 6,778, 2 Cliff. 245, 2 Fish. Pat. Cas. 395; *Hussey v. Bradley*, 12 Fed. Cas. No. 6,946, 5 Blatchf. 134, 2 Fish. Pat. Cas. 362.

77. U. S. Rev. St. (1878) § 4917 [U. S. Comp. St. (1901) p. 3393]; *Sessions v. Romadka*, 145 U. S. 29, 12 S. Ct. 799, 36 L. ed. 609; *Collins Co. v. Coes*, 130 U. S. 56, 9 S. Ct. 514, 32 L. ed. 858; *Hailes v. Albany Stove Co.*, 123 U. S. 582, 8 S. Ct. 262, 31 L. ed. 284; *Union Metallic Cartridge Co. v. U. S. Cartridge Co.*, 112 U. S. 624, 5 S. Ct. 475, 28 L. ed. 828; *Dunbar v. Meyers*, 94 U. S. 187, 24 L. ed. 34; *Smith v. Nichols*, 21 Wall. (U. S.) 112, 22 L. ed. 566; *Cambria Iron Co. v. Carnegie Steel Co.*, 96 Fed. 850, 37 C. C. A. 693 [reversing 89 Fed. 721]; *Schwarzwalder v. New York Filter Co.*, 66 Fed. 152, 13 C. C. A. 380; *Matthews v. Spangenberg*, 19 Fed. 823, 20 Blatchf. 482; *Aiken v. Dolan*, 1 Fed. Cas. No. 110, 3 Fish. Pat. Cas. 197; *Whitney v. Emmett*, 2 Fed. Cas. No. 17,585, *Baldw.* 303, 1 Robb Pat. Cas. 567; *McCormick v. Seymour*, 15 Fed. Cas. No. 8,727, 3 Blatchf. 209; *Tuck v. Bramhill*, 24 Fed. Cas. No. 14,213, 6 Blatchf. 95, 3 Fish. Pat. Cas. 400.

In Canada the law is like that in the United States. St. 35 Vict. c. 26, § 20.

**English practice.**—Application to the patent office for leave to amend by disclaimer may be made at any time where suit is not

pending (*In re Hall*, 21 Q. B. D. 137, 57 L. J. Q. B. 494, 59 L. T. Rep. N. S. 37, 36 Wkly. Rep. 892), and amendment may be made pending suit in order of court (*Cropper v. Smith*, 28 Ch. D. 148, 54 L. J. Ch. 287, 52 L. T. Rep. N. S. 94, 33 Wkly. Rep. 338; *Yates v. Armstrong*, 77 L. T. Rep. N. S. 267; *Singer v. Hasson*, 50 L. T. Rep. N. S. 326); master of rolls may expunge disclaimer improperly filed (*In re Berdan*, L. R. 20 Eq. 346, 44 L. J. Ch. 544, 23 Wkly. Rep. 823); amendment permitted by court pending suit on conditions (*Deeley v. Perkes*, [1896] A. C. 496, 65 L. J. Ch. 912; *Ludington Cigarette Mach. Co. v. Baron Cigarette Mach. Co.*, [1900] 1 Ch. 508, 69 L. J. Ch. 321, 82 L. T. Rep. N. S. 173, 48 Wkly. Rep. 505; *Gaulard v. Lindsay*, 38 Ch. D. 38, 57 L. J. Ch. 687, 52 L. T. Rep. N. S. 44; *Haslam Foundry, etc., Co. v. Goodfellow*, 37 Ch. D. 118, 56 L. J. Ch. 245, 57 L. T. Rep. N. S. 788, 36 Wkly. Rep. 391; *Bray v. Gardner*, 34 Ch. D. 668, 56 L. J. Ch. 497, 56 L. T. Rep. N. S. 292, 35 Wkly. Rep. 341; *Fusee Vesta Co. v. Bryant*, 34 Ch. D. 458, 56 L. J. Ch. 187, 56 L. T. Rep. N. S. 110, 35 Wkly. Rep. 267; *In re Gaulard*, 57 L. J. Ch. 209, 5 Rep. Pat. Cas. 192; *Lang v. Whitecross Co.*, 62 L. T. Rep. N. S. 119 [affirmed in 89 L. T. J. 251]; and assignee may disclaim (*Spilsbury v. Clough*, 2 Q. B. 466, 2 G. & D. 17, 6 Jur. 579, 11 L. J. Q. B. 109, 42 E. C. L. 763; *Wallington v. Dale*, 23 L. J. Exch. 49).

78. *Silsby v. Foote*, 14 How. (U. S.) 218, 14 L. ed. 394; *Brooks v. Jenkins*, 4 Fed. Cas. No. 1,953, Fish. Pat. Rep. 41, 3 McLean 432.

79. U. S. Rev. St. (1878) § 4917 [U. S. Comp. St. (1901) p. 3393]; *Hovey v. Stevens*, 12 Fed. Cas. No. 6,746, 2 Robb Pat. Cas. 567, 3 Woodb. & M. 17.

80. *Hailes v. Albany Stove Co.*, 123 U. S. 582, 8 S. Ct. 262, 31 L. ed. 284; *Union Metallic Cartridge Co. v. U. S. Cartridge Co.*, 112 U. S. 624, 5 S. Ct. 475, 28 L. ed. 828; *Westinghouse Air Brake Co. v. New York Air Brake Co.*, 139 Fed. 265; *Otis Elevator Co. v. Portland Co.*, 127 Fed. 557, 62 C. C. A. 339 [affirming 119 Fed. 928]; *Torrant v. Duluth Lumber Co.*, 30 Fed. 830;



A disclaimer may extend to a part of the specification as well as to a claim or one feature of a claim,<sup>81</sup> and part of a reissued patent may be disclaimed.<sup>82</sup> A disclaimer can eliminate only matter which is clearly severable from the balance, and which can be removed without changing the balance.<sup>83</sup> Elements of a combination claim cannot be eliminated.<sup>84</sup> Where a reissue is void because too broad the original patent cannot be revived by merely filing a disclaimer of all extensions thereof.<sup>85</sup>

**C. Time For Disclaimer.** Disclaimer should be filed without unreasonable delay, and, unless filed before suit is brought, no costs can be recovered by the patentee.<sup>86</sup> Disclaimer may, however, be made after as well as before suit;<sup>87</sup> the failure to file before suit affecting costs only and not the decree.<sup>88</sup> Whether a delay in filing a disclaimer is unreasonable is a question of law.<sup>89</sup>

**D. Effect of Failure to Disclaim.** It is not necessary to enter disclaimer

*Hailes v. Albany Stove Co.*, 16 Fed. 240, 21 Blatchf. 271; *Thomas v. Welch*, L. R. 1 C. P. 192, 12 Jur. N. S. 316, 35 L. J. C. P. 200; *Ralston v. Smith*, 11 C. B. N. S. 471, 8 Jur. N. S. 100, 31 L. J. C. P. 102, 103 E. C. L. 471 [affirmed in 20 C. B. N. S. 28, 11 H. L. Cas. 223, 35 L. J. C. P. 49, 13 L. T. Rep. N. S. 1, 11 Eng. Reprint 1318]; *Tetley v. Easton*, 2 C. B. N. S. 706, 26 L. J. C. P. 269, 89 E. C. L. 706; *Seed v. Higgins*, 8 H. L. Cas. 550, 6 Jur. N. S. 1264, 30 L. J. Q. B. 314, 3 L. T. Rep. N. S. 101, 11 Eng. Reprint 544.

Limitation to particular use is proper. *Thompson v. N. T. Bushnell Co.*, 96 Fed. 238, 37 C. C. A. 456 [reversing 88 Fed. 81].

That the patentee cannot add a feature to the invention claimed see *Albany Steam Trap Co. v. Worthington*, 79 Fed. 966, 25 C. C. A. 258; *White v. E. P. Gleason Mfg. Co.*, 17 Fed. 159, 21 Blatchf. 364; *Hailes v. Albany Stove Co.*, 16 Fed. 240, 21 Blatchf. 271; *Coburn v. Schroeder*, 11 Fed. 425, 20 Blatchf. 392.

That the patentee may claim combination and disclaim separate elements see *Black v. Thorne*, 3 Fed. Cas. No. 1,465, 10 Blatchf. 66, 5 Fish. Pat. Cas. 550, 2 Off. Gaz. 388.

81. *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 22 S. Ct. 698, 46 L. ed. 968 [reversing 96 Fed. 850, 37 C. C. A. 593].

82. *Hurlbut v. Schillinger*, 130 U. S. 456, 9 S. Ct. 584, 32 L. ed. 1011; *Gage v. Herring*, 107 U. S. 640, 2 S. Ct. 819, 27 L. ed. 601; *Tyler v. Galloway*, 12 Fed. 567, 20 Blatchf. 445; *Collins Co. v. Coes*, 3 Fed. 225; *Schillinger v. Gunther*, 21 Fed. Cas. No. 12,458, 4 Ban. & A. 479, 17 Blatchf. 66, 16 Off. Gaz. 905.

83. *Hailes v. Albany Stove Co.*, 123 U. S. 582, 8 S. Ct. 262, 31 L. ed. 284; *Manhattan Gen. Constr. Co. v. Helios-Upton Co.*, 135 Fed. 785; *Schillinger v. Gunther*, 21 Fed. Cas. No. 12,458, 4 Ban. & A. 479, 17 Blatchf. 66, 16 Off. Gaz. 905.

84. *Cerealine Mfg. Co. v. Bates*, 77 Fed. 883; *Batten v. Clayton*, 2 Fed. Cas. No. 1,105; *Westlake v. Cartter*, 29 Fed. Cas. No. 17,451, 6 Fish. Pat. Cas. 519, 4 Off. Gaz. 636.

85. *McMurray v. Mallory*, 111 U. S. 97, 4 S. Ct. 375, 28 L. ed. 365.

86. U. S. Rev. St. (1878) § 4922 [U. S. Comp. St. (1901) p. 3396]; *Roemer v. Neumann*, 132 U. S. 103, 10 S. Ct. 12, 33 L. ed.

277; *Silsby v. Foote*, 20 How. (U. S.) 378, 15 L. ed. 822; *Reed v. Cutter*, 20 Fed. Cas. No. 11,645, 2 Robb Pat. Cas. 81, 1 Story 590.

Reasonable delay illustrated see *O'Reilly v. Morse*, 15 How. (U. S.) 62, 14 L. ed. 601; *Thompson v. N. T. Bushnell Co.*, 96 Fed. 238, 37 C. C. A. 456; *Christman v. Rumsey*, 5 Fed. Cas. No. 2,704, 4 Ban. & A. 506, 17 Blatchf. 148, 17 Off. Gaz. 903, 58 How. Pr. (N. Y.) 114.

English practice.—Amendment by disclaimer pending suit is for discretion of the judge. *Deeley v. Perkes*, [1896] A. C. 496, 65 L. J. Ch. 912; *Brooks v. Lycett's Saddle, etc., Accessory Co.*, [1904] 1 Ch. 512, 73 L. J. Ch. 319; *In re Geipel*, [1904] 1 Ch. 239, 73 L. J. Ch. 215, 90 L. T. Rep. N. S. 70, 52 Wkly. Rep. 339; *In re Geipel*, [1903] 2 Ch. 715, 73 L. J. Ch. 47, 89 L. T. Rep. N. S. 127, 52 Wkly. Rep. 63; *Ludington's Cigarette Mach. Co. v. Baron Cigarette Mach. Co.*, [1900] 1 Ch. 508, 69 L. J. Ch. 321, 82 L. T. Rep. N. S. 173, 48 Wkly. Rep. 505; *In re Owen*, [1899] 1 Ch. 157, 68 L. J. Ch. 63, 79 L. T. Rep. N. S. 458, 47 Wkly. Rep. 180; *In re Gaulard*, 57 L. J. Ch. 209, 5 Rep. Pat. Cas. 192; *Yates v. Armstrong*, 77 L. T. Rep. N. S. 267; *In re Lang*, 7 Rep. Pat. Cas. 469. Suit instituted after petition to amend is no bar. *Wolfe v. Automatic Picture Gallery*, [1903] 1 Ch. 18, 72 L. J. Ch. 34, 87 L. T. Rep. N. S. 539 [affirming 51 Wkly. Rep. 121]. Disclaimer pending suit does not include "correction and explanation," but only elimination. *In re Owen, supra*; *In re Gaulard, supra*; *In re Lang, supra*.

87. *Smith v. Nichols*, 21 Wall. (U. S.) 112, 22 L. ed. 566; *Libbey v. Mt. Washington Glass Co.*, 26 Fed. 757; *Myers v. Frame*, 17 Fed. Cas. No. 9,991, 8 Blatchf. 446, 4 Fish. Pat. Cas. 493; *Wyeth v. Stone*, 30 Fed. Cas. No. 18,107, 2 Robb Pat. Cas. 23, 1 Story 273.

88. *Sessions v. Romadka*, 145 U. S. 29, 12 S. Ct. 799, 36 L. ed. 609; *Plecker v. Poorman*, 147 Fed. 528; *Stutz v. Armstrong*, 20 Fed. 843; *Hall v. Wiles*, 11 Fed. Cas. No. 5,954, 2 Blatchf. 194, Fish. Pat. Rep. 433.

89. *Seymour v. McCormick*, 19 How. (U. S.) 96, 15 L. ed. 557. Compare *Brooks v. Jenkins*, 4 Fed. Cas. No. 1,963, Fish. Pat. Rep. 41, 3 McLean 432.



except as to substantial or material parts.<sup>90</sup> The failure to disclaim invalid claims will not prevent recovery of damages for the infringement of valid claims in the patent where the patentee was not guilty of fraud and where there was no unreasonable neglect or delay in entering disclaimer.<sup>91</sup> Unreasonable delay, however, will be a good defense to the suit.<sup>92</sup>

**E. Effect of Disclaimer.** In determining the meaning of a disclaimer, the same rules are to be observed as in construing any other written instrument, the purpose being to carry out the intention of the person executing it as indicated by its language when construed with reference to the proceedings of which it forms a part.<sup>93</sup> A disclaimer limits the patent in so far as the disclaimant is concerned to the matter therein which is not disclaimed.<sup>94</sup> It is effective only as to the party filing it,<sup>95</sup> and a disclaimer in one patent does not affect another.<sup>96</sup>

## X. CONSTRUCTION AND OPERATION OF LETTERS PATENT.<sup>97</sup>

**A. In General — 1. GENERAL RULES OF CONSTRUCTION RELATING TO CONTRACTS APPLICABLE.** A patent is subject to the same general rules of construction that apply to other contracts.<sup>98</sup> The entire instrument, including the drawings and specifications, is to be considered in arriving at its intent and meaning.<sup>99</sup>

90. *Hall v. Wiles*, 11 Fed. Cas. No. 5,954, 2 Blatchf. 194, Fish. Pat. Rep. 433; *Peek v. Frame*, 19 Fed. Cas. No. 10,904, 5 Fish. Pat. Cas. 211.

91. Affects only costs. *Hotchkiss v. Oliver*, 5 Den. (N. Y.) 314; *Seymour v. McCormick*, 19 How. (U. S.) 96, 15 L. ed. 557; *Kittle v. Hall*, 30 Fed. 239; *Schillinger v. Gunther*, 21 Fed. Cas. No. 12,458, 4 Ban. & A. 479, 17 Blatchf. 66, 16 Off. Gaz. 905; *Tuck v. Bramhill*, 23 Fed. Cas. No. 14,213, 6 Blatchf. 95, 3 Fish. Pat. Cas. 400.

Disclaimer by attorney in prosecuting application distinguished. *Mann v. Bayliss*, 16 Fed. Cas. No. 9,034, 10 Off. Gaz. 113.

English practice.—Patent void unless disclaimer entered. *Cannington v. Nuttall*, L. R. 5 H. L. 205, 40 L. J. Ch. 739; *In re Dellwick*, [1896] 2 Ch. 705, 65 L. J. Ch. 905.

92. *Rice v. Garnhart*, 34 Wis. 453, 17 Am. Rep. 448; *Brooks v. Jenkins*, 4 Fed. Cas. No. 1,953, Fish. Pat. Rep. 41, 3 McLean 432; *Hall v. Wiles*, 10 Fed. Cas. No. 5,954, 2 Blatchf. 194, Fish. Pat. Rep. 433; *Hovey v. Stevens*, 12 Fed. Cas. No. 6,745, 2 Robb Pat. Cas. 479, 1 Woodb. & M. 479; *McCormick v. Seymour*, 15 Fed. Cas. No. 8,727, 3 Blatchf. 209; *Parker v. Stiles*, 18 Fed. Cas. No. 10,749, Fish. Pat. Rep. 319, 5 McLean 319; *Reed v. Cutter*, 20 Fed. Cas. No. 11,645, 2 Robb Pat. Cas. 81, 1 Story 590.

93. *Graham v. Earl*, 82 Fed. 737, 92 Fed. 155, 34 C. C. A. 267.

A construction which would render the disclaimer nugatory must be essentially wrong and cannot be accepted. *Atlantic Giant Powder Co. v. Hulings*, 21 Fed. 519.

Disclaimer before issue of patent entitled to great weight. *Brown Folding Mach. Co. v. Stonematz Printers' Mach. Co.*, 58 Fed. 571, 7 C. C. A. 374 [affirming 57 Fed. 601].

94. *Dunbar v. Meyers*, 94 U. S. 187, 24 L. ed. 34; *Silsby v. Foote*, 20 How. (U. S.) 378, 15 L. ed. 953; *Manhattan Gen. Constr. Co. v. Helios Upton Co.*, 135 Fed. 785; *Graham v. Earl*, 92 Fed. 155, 34 C. C. A. 267;

*Schwarzwalder v. New York Filter Co.*, 66 Fed. 152, 13 C. C. A. 380; *Atlantic Giant Powder Co. v. Hulings*, 21 Fed. 519.

95. *Potter v. Holland*, 20 Fed. Cas. No. 11,329, 4 Blatchf. 206, 1 Fish. Pat. Cas. 327; *Wyeth v. Stone*, 30 Fed. Cas. No. 18,107, 2 Robb Pat. Cas. 23, 1 Story 273.

96. *Washburn, etc., Mfg. Co. v. Beat 'Em All Barbed-Wire Co.*, 143 U. S. 275, 12 S. Ct. 443, 36 L. ed. 154; *Hill v. Dunklee*, 12 Fed. Cas. No. 6,489, *McArthur Pat. Cas.* 475.

97. Decisions of United States as to construction as precedents for other courts see *COURTS*, 11 Cyc. 752.

98. *O. H. Jewell Filter Co. v. Jackson*, 140 Fed. 340, 72 C. C. A. 304; *National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co.*, 106 Fed. 693, 45 C. C. A. 544; *Elgin Co-operative Butter-Tub Co. v. Creamery Package Mfg. Co.*, 80 Fed. 293, 25 C. C. A. 426; *Harris v. Allen*, 15 Fed. 106; *Whitney v. Emmett*, 29 Fed. Cas. No. 17,535, *Baldw.* 303, 1 Robb Pat. Cas. 567; *Came v. Consolidated Car Heating Co.*, 11 Quebec K. B. 103.

Terms given ordinary meaning see *Clark v. Adie*, 2 App. Cas. 423, 46 L. J. Ch. 598, 27 L. T. Rep. N. S. 1, 26 Wkly. Rep. 45; *Grossley v. Beverley*, 9 B. & C. 63, 17 E. C. L. 38, 3 C. & P. 513, 14 E. C. L. 690, 7 L. J. K. B. O. S. 127, M. & M. 283, 1 Russ. & M. 166 note, 5 Eng. Ch. 166 note, 39 Eng. Reprint 65; *Elliott v. Turner*, 2 C. B. 446, 15 L. J. C. P. 49, 52 E. C. L. 446.

To make up a claim two patents cannot be read together. *Rose v. Hirsh*, 77 Fed. 469, 23 C. C. A. 246.

99. *Hogg v. Emerson*, 6 How. (U. S.) 437, 12 L. ed. 505, 11 How. 587, 13 L. ed. 824; *O. H. Jewell Filter Co. v. Jackson*, 140 Fed. 340, 72 C. C. A. 304; *Holt v. Kendall*, 26 Fed. 622; *Aiken v. Dolan*, 1 Fed. Cas. No. 110, 3 Fish. Pat. Cas. 197; *Bell v. Daniels*, 3 Fed. Cas. No. 1,247, 1 Bond 212, 1 Fish. Pat. Cas. 372; *Carver v. Baintree Mfg. Co.*, 5 Fed. Cas. No. 2,485, 2 Robb Pat. Cas. 141, 2 Story 432; *Davoll v. Brown*, 7 Fed. Cas. No.



**2. LIBERALLY CONSTRUED.** Patents are to be liberally construed so as to secure to the inventor the real invention which he intends to secure by his patent, and technical defects or inaccuracies will not be permitted to prevent this result.<sup>1</sup> The description of the patent, however, must be so certain as to be understood by those acquainted with the subject-matter.<sup>2</sup> There should not be a liberality of construction which permits the inventor to couch his specification in such ambiguous terms that its claims may be expanded or contracted to suit the exigency;<sup>3</sup> and where an inventor divides up his invention so as to present certain elements in different patents, he is thereby limited to a more strict and narrow construction than might have been otherwise necessary.<sup>4</sup>

**3. PLAIN MEANING NOT VARIED.** The plain and clear meaning of the terms

3,662, 2 Robb Pat. Cas. 303, 1 Woodb. & M. 53; Earle v. Sawyer, 8 Fed. Cas. No. 4,247, 4 Mason 1, 1 Robb Pat. Cas. 490; Evans v. Eaton, 8 Fed. Cas. No. 4,559, 1 Robb Pat. Cas. 68, Pet. C. C. 322; Foss v. Herbert, 9 Fed. Cas. No. 4,957, 1 Biss. 121, 2 Fish. Pat. Cas. 31; Hamilton v. Ives, 11 Fed. Cas. No. 5,982, 6 Fish. Pat. Cas. 244, 3 Off. Gaz. 30; Howes v. Nute, 12 Fed. Cas. No. 6,790, 4 Cliff. 173, 4 Fish. Pat. Cas. 263; Ingels v. Mast, 13 Fed. Cas. No. 7,035, 2 Ban. & A. 24, 1 Flipp. 424, 7 Off. Gaz. 836; Kittle v. Merriam, 14 Fed. Cas. No. 7,857, 2 Curt. 475; Sloat v. Spring, 22 Fed. Cas. No. 12,948a; Washburn v. Gould, 29 Fed. Cas. No. 17,214, 2 Robb Pat. Cas. 206, 3 Story 122; Russell v. Cowley, 1 C. M. & R. 864.

1. Ruete v. Elwell, 15 App. Cas. (D. C.) 21; Ives v. Hamilton, 92 U. S. 426, 23 L. ed. 491; Winans v. Denmead, 15 How. (U. S.) 220, 14 L. ed. 717; Eck v. Kutz, 132 Fed. 758; Nutter v. Mossberg, 128 Fed. 55 [affirmed in 135 Fed. 95, 68 C. C. A. 257]; Severy Process Co. v. Harper, 113 Fed. 581; Gaisman v. Gallert, 105 Fed. 955; Huntington Dry-Pulverizer Co. v. Whitaker Cement Co., 89 Fed. 323; Salomon v. Garvin Mach. Co., 84 Fed. 195; Red Jacket Mfg. Co. v. Davis, 82 Fed. 432, 27 C. C. A. 204; Consolidated Fastener Co. v. Columbian Fastener Co., 79 Fed. 795; Beach v. Inman, 75 Fed. 840; McBride v. Kingman, 72 Fed. 908; Loring v. Booth, 52 Fed. 150; Robbins v. Aurora Watch Co., 43 Fed. 521; Fitch v. Bragg, 8 Fed. 588; Consolidated Safety-Valve Co. v. Crosby Steam-Gauge, etc., Co., 7 Fed. 768; Ames v. Howard, 1 Fed. Cas. No. 326, 1 Robb Pat. Cas. 689, 1 Sumn. 482; Blake v. Stafford, 3 Fed. Cas. No. 1,504, 6 Blatchf. 195, 3 Fish. Pat. Cas. 294; Blanchard v. Sprague, 3 Fed. Cas. No. 1,516, 1 Cliff. 288; Burden v. Corning, 4 Fed. Cas. No. 2,143, 2 Fish. Pat. Cas. 477; Coffin v. Ogden, 5 Fed. Cas. No. 2,950, 7 Blatchf. 61, 3 Fish. Pat. Cas. 640 [affirmed in 18 Wall. 120, 21 L. ed. 821]; Davoll v. Brown, 7 Fed. Cas. No. 3,662, 2 Robb Pat. Cas. 303, 1 Woodb. & M. 53; Francis v. Mellor, 9 Fed. Cas. No. 5,039, 5 Fish. Pat. Cas. 153, 1 Off. Gaz. 48, 8 Phila. (Pa.) 157; Goodyear v. Barry, 10 Fed. Cas. No. 5,556, 2 Bond 189, 3 Fish. Pat. Cas. 439; Goodyear v. New Jersey Central R. Co., 10 Fed. Cas. No. 5,563, 1 Fish. Pat. Cas. 626, 2 Wall. Jr. 356; Imlay v. Norwich, etc., R. Co., 13 Fed. Cas. No. 7,012, 4 Blatchf. 227, 1 Fish. Pat. Cas. 340; Ingels v. Mast, 13 Fed. Cas. No. 7,033, 6 Fish.

Pat. Cas. 415; Parker v. Sears, 18 Fed. Cas. No. 10,748, 1 Fish. Pat. Cas. 93; Parker v. Stiles, 18 Fed. Cas. No. 10,749, Fish. Pat. Rep. 319, 5 McLean 44; Pike v. Potter, 19 Fed. Cas. No. 11,162, 3 Fish. Pat. Cas. 55; Potter v. Holland, 19 Fed. Cas. No. 11,330, 4 Blatchf. 238, 1 Fish. Pat. Cas. 382; Ryan v. Goodwin, 21 Fed. Cas. No. 12,186, 1 Robb Pat. Cas. 725, 3 Sumn. 514; Waterbury Brass Co. v. New York Brass Co., 29 Fed. Cas. No. 17,256, 3 Fish. Pat. Cas. 43; Whipple v. Middlesex Co., 29 Fed. Cas. No. 17,520, 4 Fish. Pat. Cas. 41; Woodman v. Stimpson, 30 Fed. Cas. No. 17,979, 3 Fish. Pat. Cas. 98 [reversed on other grounds in 10 Wall. 117, 19 L. ed. 866]; Bickford v. Skewes, 1 Q. B. 938, 1 G. & D. 736, 6 Jur. 167, 41 E. C. L. 848; Neilson v. Betts, L. R. 5 H. L. 1, 40 L. J. Ch. 317, 19 Wkly. Rep. 1121.

That terms are given reasonable, not technically exact, meaning see Kip-Armstrong Co. v. King Phillip Mills, 130 Fed. 28 [reversed on other grounds in 132 Fed. 975, 66 C. C. A. 45]; U. S. Repair, etc., Co. v. Assyrian Asphalt Co., 96 Fed. 235; Union R. Co. v. Sprague Electric R., etc., Co., 88 Fed. 82, 31 C. C. A. 391; A. B. Dick Co. v. Wichelman, 80 Fed. 519; American Sulphite Co. v. Howland Falls Pulp Co., 80 Fed. 395, 25 C. C. A. 500; Johnson v. Brooklyn Heights R. Co., 75 Fed. 668; Thompson v. Jennings, 75 Fed. 572, 21 C. C. A. 486; Grier v. Castle, 17 Fed. 523; Chandler v. Ladd, 5 Fed. Cas. No. 2,593, McArthur Pat. Cas. 493.

That regard should be had for things, not names, see Daylight Prism Co. v. Marcus Prism Co., 110 Fed. 980; Palmer Pneumatic Tire Co. v. Lozier, 84 Fed. 659.

Subtle distinctions will not be made.—Davoll v. Brown, 7 Fed. Cas. No. 3,662, 2 Robb Pat. Cas. 303, 1 Woodb. & M. 53; Henderson v. Cleveland Co-operative Stove Co., 11 Fed. Cas. No. 6,351, 2 Ban. & A. 604, 12 Off. Gaz. 4.

Claim to result will be construed to cover means where possible. Expanded Metal Co. v. St. Louis Bd. of Education, 103 Fed. 287; Henderson v. Cleveland Co-operative Stove Co., 11 Fed. Cas. No. 6,351, 2 Ban. & A. 604, 12 Off. Gaz. 4.

2. Davoll v. Brown, 7 Fed. Cas. No. 3,662, 2 Robb Pat. Cas. 303, 1 Woodb. & M. 53.

3. Parker v. Sears, 18 Fed. Cas. No. 10,748, 1 Fish. Pat. Cas. 93.

4. New Departure Bell Co. v. Bevin Bros. Mfg. Co., 64 Fed. 859 [reversed on other



employed cannot be varied by construction.<sup>5</sup> The construction must be in conformity with the self-imposed limitations which are contained in the claims.<sup>6</sup>

4. **INTENTION OF INVENTOR.** The intention of the parties in formulating the patent is entitled to great consideration when it can be determined from the record.<sup>7</sup> The court will look to the manifest design in order to remove any ambiguity arising from the terms employed; but this ambiguity must not be such as would perplex any ordinary mechanic in the art to which it applies.<sup>8</sup>

5. **PROCEEDINGS IN PATENT OFFICE.** The proceedings in the patent office pending an application are not as a general rule admissible as evidence tending to enlarge, diminish, or vary the language of the claim of the patent.<sup>9</sup> An amendment of the claim which comes in incidentally and in reference to an incidental matter does not necessarily exclude a liberal interpretation when the invention is a broad one.<sup>10</sup> Matters which have been duly disclaimed after issue of the patent cease to be a part of the invention, and the patent is then to be construed as though they had never been included in the description of the invention or the claim of the specification.<sup>11</sup> Any correspondence between the inventor and the patent office prior to the grant of the patent is inadmissible to enlarge, diminish, or vary the language of the patent afterward issued,<sup>12</sup> at least where its terms are not

grounds in 73 Fed. 469, 19 C. C. A. 534]; Electrical Accumulator Co. v. Brush Electric Co., 52 Fed. 130, 2 C. C. A. 682.

5. Westinghouse Air Brake Co. v. New York Air Brake Co., 119 Fed. 874, 56 C. C. A. 404; Schreiber, etc., Mfg. Co. v. Adams Co., 117 Fed. 830, 54 C. C. A. 128; Bracewell v. Passaic Print Works, 107 Fed. 467; Peifer v. Brown, 106 Fed. 938; U. S. Glass Co. v. Atlas Glass Co., 88 Fed. 493; Edison Electric Light Co. v. E. G. Bernard Co., 88 Fed. 267; Chemical Rubber Co. v. Raymond Rubber Co., 68 Fed. 570 [affirmed in 71 Fed. 179, 18 C. C. A. 31]; Holtzer v. Consolidated Electric Mfg. Co., 60 Fed. 748 [reversed on other grounds in 67 Fed. 907, 15 C. C. A. 63]; Duff Mfg. Co. v. Forgie, 57 Fed. 748 [affirmed in 59 Fed. 772, 8 C. C. A. 261]; Yale Lock Mfg. Co. v. James, 20 Fed. 903; Many v. Sizer, 16 Fed. Cas. No. 9,057, 1 Fish. Pat. Cas. 31; Rich v. Close, 20 Fed. Cas. No. 11,757, 8 Blatchf. 41, 4 Fish. Pat. Cas. 279; Wintermute v. Redington, 30 Fed. Cas. No. 17,896, 1 Fish. Pat. Cas. 239.

Evidence cannot change instrument see Clark v. Adie, 2 App. Cas. 423, 46 L. J. Ch. 598, 37 L. T. Rep. N. S. 1, 26 Wkly. Rep. 45.

6. New Departure Bell Co. v. Bevin Bros. Mfg. Co., 64 Fed. 859; Judd v. Fowler, 61 Fed. 821, 10 C. C. A. 100; Groth v. International Postal Supply Co., 61 Fed. 284, 9 C. C. A. 507.

The remedy for unnecessary limitations is by reissue not by construction. Pittsburg Meter Co. v. Pittsburg Supply Co., 109 Fed. 644, 48 C. C. A. 580.

7. Thomson-Houston Electric Co. v. Black River Traction Co., 135 Fed. 759, 68 C. C. A. 461; Paxton v. Brinton, 107 Fed. 137; Kursesheidt Mfg. Co. v. Naday, 103 Fed. 948; Electric Smelting, etc., Co. v. Carborundum Co., 102 Fed. 618, 42 C. C. A. 537; Magic Light Co. v. Economy Gas-Lamp Co., 97 Fed. 87; Blount Mfg. Co. v. Bardsley, 75 Fed. 674, 21 C. C. A. 495; Duff Mfg. Co. v. Forgie, 57 Fed. 748 [affirmed in 59 Fed. 772, 8 C. C. A. 261]; Bradley v. Dull, 19 Fed. 913; Giant

Powder Co. v. California Vigorit Powder Co., 4 Fed. 720, 6 Sawy. 508; Roberts v. Schreiber, 2 Fed. 855; Carew v. Boston Elastic Fabric Co., 5 Fed. Cas. No. 2,397, 3 Cliff. 356, 5 Fish. Pat. Cas. 90, 1 Off. Gaz. 91; Evans v. Eaton, 8 Fed. Cas. No. 4,559, Pet. C. C. 322, 1 Robb Pat. Cas. 68; Page v. Ferry, 18 Fed. Cas. No. 10,602, 1 Fish. Pat. Cas. 298; Pike v. Potter, 19 Fed. Cas. No. 11,162, 3 Fish. Pat. Cas. 55; Union Paper-Bag Co. v. Nixon, 24 Fed. Cas. No. 14,386, 6 Fish. Pat. Cas. 402, 4 Off. Gaz. 31.

Subsequent declarations of patentee cannot vary instrument. Union Paper-Bag Mach. Co. v. Pultz, etc., Co., 24 Fed. Cas. No. 14,392, 3 Ban. & A. 403, 15 Blatchf. 160, 15 Off. Gaz. 423.

Mistake as to theory of operation is not binding.—U. S. Mitis Co. v. Midvale Steel Co., 135 Fed. 103.

8. Union Paper-Bag Co. v. Nixon, 24 Fed. Cas. No. 14,386, 6 Fish. Pat. Cas. 402, 4 Off. Gaz. 31.

9. Goodyear Dental Vulcanite Co. v. Gardiner, 11 Fed. Cas. No. 5,591, 3 Cliff. 408, 4 Fish. Pat. Cas. 224.

10. Heywood Bros., etc., Co. v. Syracuse Rapid Transit R. Co., 152 Fed. 453. See also Heap v. Greene, 91 Fed. 792, 34 C. C. A. 86; Reece Button-Hole Mach. Co. v. Globe Button-Hole Mach. Co., 61 Fed. 958, 10 C. C. A. 194.

Amendment of specifications leaving claim unchanged.—Claims of a patent are not limited by the amendment of the specifications more particularly describing the device shown in the drawings to meet the objections of the patent office, where the claims themselves are left unchanged. Manhattan Gen. Constr. Co. v. Helios-Upton Co., 135 Fed. 785.

11. Dunbar v. Myers, 94 U. S. 187, 24 L. ed. 34; Manhattan Gen. Constr. Co. v. Helios-Upton Co., 135 Fed. 785; Bracewell v. Passaic Print Works, 107 Fed. 467.

12. Goodyear Dental Vulcanite Co. v. Davis, 102 U. S. 222, 26 L. ed. 149; Cahoon v. Ring, 4 Fed. Cas. No. 2,292, 1 Cliff. 592, 1 Fish. Pat. Cas. 397; Goodyear Dental Vul-



ambiguous.<sup>13</sup> But it has been held that when the patent bears on its face a particular construction, such a construction may be confirmed by what the patentee said when he was making his application.<sup>14</sup> Formal admissions imposed upon the applicant as a condition precedent to the allowance of a patent are binding.<sup>15</sup> Argumentative statements of counsel in the course of proceedings in the patent office do not estop the patentee from claiming what is clearly granted by the patent.<sup>16</sup> Mere remarks by the examiner in the course of the proceedings do not estop the patentee from claiming the construction shown by the specification and original claim.<sup>17</sup> Where it is in evidence from the record of the patent office that a certain construction was there contemplated, and that the patent would not otherwise have been granted, no objection can be made to the same construction of it by the court on the ground that such construction is narrow, and will render the patent practically useless.<sup>18</sup>

**6. OPINION OF EXPERTS.** The court is not bound by the opinions of experts in patent cases and may reject them where they do not seem reasonable.<sup>19</sup>

**7. STATE OF THE ART.** A patent is to be construed in the light of the state of the art at the time it was granted,<sup>20</sup> and it has been very generally held that in

canite Co. v. Gardiner, 10 Fed. Cas. No. 5,591, 3 Cliff. 408, 4 Fish. Pat. Cas. 224; Piper v. Brown, 19 Fed. Cas. No. 11,180, 4 Fish. Pat. Cas. 175, Holmes 20 [reversed on other grounds in 91 U. S. 37, 23 L. ed. 200]. But see Pike v. Potter, 19 Fed. Cas. No. 11,162, 3 Fish. Pat. Cas. 55, holding that the correspondence between the patent office and the patentee is evidence, at least in a court of equity, for the purpose of showing the limitation placed by the patentee upon his claims.

**Argumentative suggestion.**—The language of the patent as issued may not be contradicted by mere argumentative suggestions made by the applicant in his communications to the patent office, especially where no change is made in the claim. Victor Talking Mach. Co. v. American Graphophone Co., 151 Fed. 601, 81 C. C. A. 145.

**13. Sugar Apparatus Mfg. Co. v. Yaryan Mfg. Co.,** 43 Fed. 140.

**Language of solicitor employed to obtain patent.**—Where the specifications of the application and of the letters patent are not ambiguous and are capable of a definite construction, the language of a solicitor employed to obtain the patent, used in a communication with the patent office to convey an idea of his own, will not override the language of the patent, especially where there is no evidence to show that the idea was ever adopted by the patent office. Wirt v. Brown, 32 Fed. 283.

**14. Goodyear Dental Vulcanite Co. v. Davis,** 102 U. S. 222, 26 L. ed. 149. See also Victor Talking Mach. Co. v. American Graphophone Co., 151 Fed. 601, 81 C. C. A. 145.

**15. Welsbach Light Co. v. Cremo Incandescent Light Co.,** 151 Fed. 1023, 81 C. C. A. 683 [affirming 145 Fed. 521]; Victor Talking Mach. Co. v. American Graphophone Co., 151 Fed. 601, 81 C. C. A. 145, holding that when claims are rejected on references cited against them, the applicant is called upon to exercise his election between insistence and appeal, or desistance and acquiescence, and, if he acquiesces, the public is entitled

to the benefit of the limitations and admissions imposed upon him as a condition precedent to the allowance of the patent.

Where the patent is not for a broad invention but merely for a change of form, admissions contained in a file-wrapper and its contents in respect to amendments made upon the citation of references involving the issue of novelty constitute an estoppel against the patentee in the interpretation of his claims. Richardson v. American Pin Co., 73 Fed. 476.

**16. Britton v. White Mfg. Co.,** 61 Fed. 93. See also Consolidated Fastener Co. v. Columbian Fastener Co., 79 Fed. 795.

**The use of an unsound and unsuccessful argument by the inventor's solicitor with respect to a rejected claim will not have the effect of imposing a constructive limitation upon the claim allowed.** Société Anonyme Usine J. Cléret v. Rehfuß, 75 Fed. 657.

**The claims of a patent are not narrowed by statements made on an argument by counsel before the patent office to obtain a reconsideration after the application has been rejected, where no changes are made in the claims.** Boyer v. Keller Tool Co., 127 Fed. 130, 62 C. C. A. 244.

**17. Acme Flexible Clasp Co. v. Cary Mfg. Co.,** 96 Fed. 344, 99 Fed. 500. See also Consolidated Fastener Co. v. Columbian Fastener Co., 79 Fed. 795.

**18. Geis v. Kimber,** 36 Fed. 105.

**19. Computing Scale Co. v. Keystone Store-Service Co.,** 88 Fed. 788; Norton v. Jensen, 49 Fed. 859, 1 C. C. A. 452; Union Paper-Bag Co. v. Nixon, 24 Fed. Cas. No. 14,386, 6 Fish. Pat. Cas. 402, 4 Off. Gaz. 31.

**20. Simplex Railway Appliance Co. v. Wands,** 115 Fed. 517, 53 C. C. A. 171; Allen v. Grimes, 89 Fed. 869; New Departure Bell Co. v. Corbin, 88 Fed. 901; Miller Co. v. Meriden Bronze Co., 80 Fed. 523; Elgin Co-operative Butter-Tub Co. v. Creamery Package Mfg. Co., 80 Fed. 293, 25 C. C. A. 426; Rowlett v. Anderson, 76 Fed. 827; Missouri Lamp, etc., Mfg. Co. v. Stempel, 75 Fed. 583; Koch v. Bolz, 42 Fed. 454; Parsons v. Colgate, 15 Fed. 600, 21 Blatchf. 171; Neacy v.



respect of the state of the art the court may take judicial notice of matters of common knowledge.<sup>21</sup>

**8. PATENT AS NOTICE.** Everyone is bound to take notice of a patent, since the record thereof in the patent office is legal notice to all the world.<sup>22</sup>

**9. QUESTIONS FOR COURT AND JURY.** The scope and meaning of a patent is a matter of law for the court, and the application of the law to the facts of the case is for the jury.<sup>23</sup> It is for the court to construe the patent and instruct the jury as to its meaning.<sup>24</sup>

**B. Limitation of Claims — 1. IN GENERAL.** The protection furnished by a patent is measured by what is set forth in the claims.<sup>25</sup> Everything not covered

Allis, 13 Fed. 874; *Barker v. Todd*, 13 Fed. 473; *Scott v. Evans*, 11 Fed. 726; *Root v. Lamb*, 7 Fed. 222; *Giant Powder Co. v. California Vigorite Powder Co.*, 4 Fed. 720, 6 Sawy. 508; *Estabrook v. Dunbar*, 8 Fed. Cas. No. 4,535, 2 Ban. & A. 427, 10 Off. Gaz. 909; *Huggins v. Hubby*, 12 Fed. Cas. No. 6,839; *Mann v. Bayliss*, 16 Fed. Cas. No. 9,034, 10 Off. Gaz. 113, 789; *Pitts v. Wemple*, 19 Fed. Cas. No. 11,194, 1 Biss. 87, 5 Fish. Pat. Cas. 10; *Sprague v. Adriance*, 22 Fed. Cas. No. 13,248, 3 Ban. & A. 124, 14 Off. Gaz. 308. And see *infra*, X, B, 6, 7.

Evidence as to meaning of terms admitted see *Betts v. Menzies*, 10 H. L. Cas. 117, 9 Jur. N. S. 29, 31 L. J. Q. B. 233, 7 L. T. Rep. N. S. 110, 11 Wkly. Rep. 1, 11 Eng. Reprint 970.

Particular patents construed to be limited by the prior art in order to sustain them at all.—*Dunham v. Dennison Mfg. Co.*, 154 U. S. 103, 14 S. Ct. 986, 38 L. ed. 924; *Pope Mfg. Co. v. Gormully, etc.*, Mfg. Co., 144 U. S. 238, 12 S. Ct. 641, 36 L. ed. 419; *Phoenix Caster Co. v. Spiegel*, 133 U. S. 360, 10 S. Ct. 409, 33 L. ed. 663; *Ashcroft v. Boston, etc.*, R. Co., 97 U. S. 189, 24 L. ed. 982; *Brill v. Peckham Motor Truck, etc.*, 108 Fed. 267, 47 C. C. A. 315; *Consolidated Store-Service Co. v. Siegel Cooper Co.*, 107 Fed. 716, 46 C. C. A. 599; *Sprague Electric R., etc.*, Co. v. *Nassau Electric R. Co.*, 102 Fed. 761, 42 C. C. A. 612; *Santa Clara Valley Mill, etc.*, Co. v. *Prescott*, 102 Fed. 501, 42 C. C. A. 477; *Empire Target Co. v. Cleveland Target Co.*, 102 Fed. 354, 42 C. C. A. 393; *Rauh v. Guinzburg*, 101 Fed. 1007, 42 C. C. A. 139; *Dodge v. Ohio Valley Pulley Works*, 101 Fed. 581; *Regina Music-Box Co. v. Hasse*, 97 Fed. 617; *Ball, etc.*, *Fastener Co. v. A. Edgarton Mfg. Co.* 96 Fed. 489, 37 C. C. A. 523; *Davey Pegging-Mach. Co. v. Prouty*, 96 Fed. 336; *Electric Gas Lighting Co. v. Fuller*, 59 Fed. 1003, 8 C. C. A. 442; *Curtis v. Atlanta St. R. Co.*, 56 Fed. 596; *St. Paul Plow-Works v. Deere*, 54 Fed. 501; *Overman v. Warwick Cycle Mfg. Co.*, 54 Fed. 496 [affirmed in 61 Fed. 986, 10 C. C. A. 222]; *National Harrow Co. v. Hanby*, 54 Fed. 493; *Briggs v. Central Ice Co.* 54 Fed. 376 [affirmed in 60 Fed. 87, 8 C. C. A. 480]; *Blair Camera Co. v. Barker*, 53 Fed. 483; *Baumer v. Will*, 53 Fed. 373; *Pettibone v. Stanford*, 53 Fed. 118, 3 C. C. A. 469; *Actiebolaget Separator v. Sharpless*, 50 Fed. 87; *Ricks v. Craig*, 48 Fed. 169; *Zan v. Quong Sang Lung*, 47 Fed. 901; *Johnson Co. v. Pacific Rolling Mills Co.*, 47 Fed. 586 [affirmed in

51 Fed. 762, 2 C. C. A. 506]; *Firman v. New Haven Clock Co.*, 44 Fed. 205; *Root v. Sioux City Cable R. Co.*, 42 Fed. 500; *Reed v. Smith*, 40 Fed. 882; *Hatch v. Towne*, 35 Fed. 139; *Dodds v. Stoddard*, 17 Fed. 645; *Putnam v. Von Hofe*, 6 Fed. 897, 19 Blatchf. 63; *Decker v. Griffith*, 7 Fed. Cas. No. 3,725, 2 Ban. & A. 178, 13 Blatchf. 187, 8 Off. Gaz. 944.

**21.** *Richards v. Chase Elevator Co.*, 159 U. S. 477, 16 S. Ct. 53, 40 L. ed. 225; *Black Diamond Coal-Min. Co. v. Excelsior Coal Co.*, 156 U. S. 611, 15 S. Ct. 482, 39 L. ed. 553; *Slawson v. Grand St., etc.*, R. Co., 107 U. S. 649, 2 S. Ct. 663, 27 L. ed. 576; *Terhune v. Phillips*, 99 U. S. 592, 25 L. ed. 293; *Brown v. Piper*, 91 U. S. 37, 23 L. ed. 200; *American Fibre-Chamois Co. v. Buckskin-Fibre Co.*, 72 Fed. 508, 18 C. C. A. 662; *Butte City St. R. Co. v. Pacific Cable R. Co.*, 60 Fed. 410, 9 C. C. A. 41.

**22.** *Eclipse Bicycle Co. v. Farrow*, 16 App. Cas. (D. C.) 468; *National Car-Brake Shoe Co. v. Terre Haute Car, etc., Co.*, 19 Fed. 514.

**23.** *Teese v. Phelps*, 23 Fed. Cas. No. 13,819, McAllister 48.

**24.** *Simplex R. Appliance Co. v. Wands*, 115 Fed. 517, 53 C. C. A. 171; *Batten v. Clayton*, 2 Fed. Cas. No. 1,105; *Cahoon v. Ring*, 4 Fed. Cas. No. 2,292, 1 Cliff. 592, 1 Fish. Pat. Cas. 397; *Conover v. Roach*, 6 Fed. Cas. No. 3,125, 4 Fish. Pat. Cas. 12; *Davis v. Palmer*, 7 Fed. Cas. No. 3,645, 2 Brock. 298, 1 Robb Pat. Cas. 518; *Emerson v. Hogg*, 8 Fed. Cas. No. 4,440, 2 Blatchf. 1, Fish. Pat. Rep. 77; *Parker v. Hulme*, 18 Fed. Cas. No. 10,740, 1 Fish. Pat. Cas. 44; *Serrell v. Collins*, 21 Fed. Cas. No. 12,672, 1 Fish. Pat. Cas. 289; *Vance v. Campbell*, 28 Fed. Cas. No. 16,837, 1 Fish. Pat. Cas. 483 [reversed on other grounds in 1 Black 427, 17 L. ed. 168].

That question may be submitted to jury where there is parol evidence as to meaning of terms see *Silsby v. Foote*, 14 How. (U. S.) 218, 14 L. ed. 394; *Davoll v. Brown*, 7 Fed. Cas. No. 3,662, 2 Robb Pat. Cas. 303, 1 Woodb. & M. 53; *Ransom v. New York*, 20 Fed. Cas. No. 11,573, 1 Fish. Pat. Cas. 252; *Washburn v. Gould*, 29 Fed. Cas. No. 17,214, 2 Robb Pat. Cas. 206, 3 Story 122.

**25.** *Grant v. Walter*, 148 U. S. 547, 13 S. Ct. 699, 37 L. ed. 552; *White v. Dunbar*, 119 U. S. 47, 7 S. Ct. 72, 30 L. ed. 303; *Yale Lock Mfg. Co. v. Greenleaf*, 117 U. S. 554, 6 S. Ct. 846, 29 L. ed. 952; *Western Electric Mfg. Co. v. Ansonia Brass, etc., Co.*, 114 U. S. 447, 5 S. Ct. 941, 29 L. ed. 210;



by the claim is disclaimed,<sup>26</sup> and the patentee is bound by limitations contained therein.<sup>27</sup> While terms used must be so construed where possible to sustain the patent and protect the real invention,<sup>28</sup> limitations not stated in a claim will not

Lehigh Valley R. Co. v. Mellon, 104 U. S. 112, 26 L. ed. 639; U. S. Peg-Wood, etc., Co. v. B. F. Sturtevant Co., 125 Fed. 378, 60 C. C. A. 244; General Fire Extinguisher Co. v. Mallers, 110 Fed. 529, 49 C. C. A. 138; Simonds Rolling-Mach. Co. v. Hathorn Mfg. Co., 90 Fed. 201; Griffith v. Shaw, 89 Fed. 313; Kelly v. Clow, 89 Fed. 297, 32 C. C. A. 205; New Departure Bell Co. v. Corbin, 88 Fed. 901; U. S. Glass Co. v. Atlas Glass Co., 88 Fed. 493; Tiemann v. Kraatz, 85 Fed. 437, 29 C. C. A. 257; Walder v. Ulrich, 83 Fed. 477; Monroe v. McGreer, 81 Fed. 954; Olmsted v. Andrews, 77 Fed. 835, 23 C. C. A. 488; Thomas v. Rocker Spring Co., 77 Fed. 420, 23 C. C. A. 211; Long v. Pope Mfg. Co., 75 Fed. 835, 21 C. C. A. 533; Missouri Lamp, etc., Co. v. Stempel, 75 Fed. 533; McBride v. Kingman, 72 Fed. 908; National Mach. Co. v. Wheeler, etc., Mfg. Co., 72 Fed. 185; Kennedy v. Solar Refining Co., 69 Fed. 715; Wells v. Curtis, 66 Fed. 318, 13 C. C. A. 494; Reece Button-Hole Mach. Co. v. Globe Button-Hole Mach. Co., 61 Fed. 958, 10 C. C. A. 194; Stutz v. Robson, 54 Fed. 506; Brush Electric Co. v. Ft. Wayne Electric Light Co., 40 Fed. 826; Delaware Coal, etc., Co. v. Packer, 1 Fed. 851; McMillan v. Rees, 1 Fed. 722; Tinker v. Wilber Eureka Mower, etc., Mfg. Co., 1 Fed. 138; Johnson v. Root, 13 Fed. Cas. No. 7,411, 1 Fish. Pat. Cas. 351; Kidd v. Spence, 14 Fed. Cas. No. 7,755, 4 Fish. Pat. Cas. 37; Rich v. Close, 20 Fed. Cas. No. 11,757, 8 Blatchf. 41, 4 Fish. Pat. Cas. 279; Whipple v. Baldwin Mfg. Co., 29 Fed. Cas. No. 17,514, 4 Fish. Pat. Cas. 29.

Forms coming within the terms of a claim as well as the form disclosed are included within the claim. National Enameling, etc., Co. v. New England Enameling Co., 151 Fed. 19, 80 C. C. A. 485 [reversing 139 Fed. 643]; Manhattan Gen. Constr. Co. v. Helios-Upton Co., 135 Fed. 785; Oehrle v. William H. Horstmann Co., 131 Fed. 487; Albright v. Langfeld, 131 Fed. 473; Smeeth v. Perkins, 125 Fed. 285, 60 C. C. A. 199; National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co., 106 Fed. 693, 45 C. C. A. 544; Krajewski v. Pharr, 105 Fed. 514, 44 C. C. A. 572; Metallic Extraction Co. v. Brown, 104 Fed. 345, 43 C. C. A. 568; U. S. Mitis Co. v. Carnegie Steel Co., 89 Fed. 343; American Dunlop Tire Co. v. Erie Rubber Co., 66 Fed. 558; Consolidated Bunging Apparatus Co. v. Metropolitan Brewing Co., 60 Fed. 93, 8 C. C. A. 485; Sugar Apparatus Mfg. Co. v. Yaryan Mfg. Co., 43 Fed. 140; Roemer v. Neuman, 26 Fed. 102. See *supra*, V, B, 3.

26. Kinloch Tel. Co. v. Western Electric Co., 113 Fed. 652, 51 C. C. A. 362; McBride v. Kingman, 97 Fed. 217, 38 C. C. A. 123; Adams Electric R. Co. v. Lindell R. Co., 77 Fed. 432, 23 C. C. A. 223.

Where an alleged element or characteristic feature of an invention is not necessarily inherent in the invention itself, the failure of

the patentee to refer to it is persuasive evidence that it is not within the scope of his invention, and, not being disclosed to the public, it should not be read into the patent. Edison Gen. Electric Co. v. Crouse-Hinds Electric Co., 152 Fed. 437, 81 C. C. A. 579 [reversing 146 Fed. 539].

Error in reference to prior art.—If a patentee in his specification describes in appropriate language a real invention and properly sets forth his claim to that invention, he is not to be deprived of it merely because he has inadvertently erred in his reference to the prior art. Babcock, etc., Co. v. North American Dredging Co., 151 Fed. 265.

27. Coupe v. Royer, 155 U. S. 565, 15 S. Ct. 199, 39 L. ed. 263; Wright v. Yuengling, 155 U. S. 47, 15 S. Ct. 1, 39 L. ed. 64; Watson v. Cincinnati, etc., R. Co., 132 U. S. 161, 10 S. Ct. 45, 33 L. ed. 295; Yale Lock Mfg. Co. v. Sargent, 117 U. S. 373, 6 S. Ct. 931, 29 L. ed. 950; Fay v. Cordesman, 109 U. S. 408, 3 S. Ct. 236, 27 L. ed. 979; Durfee v. Bawo, 118 Fed. 853; Peifer v. Brown, 106 Fed. 938; Consolidated Store-Service Co. v. Seybold, 105 Fed. 978, 45 C. C. A. 152; Dodge v. Ohio Valley Pulley Works, 101 Fed. 581; Starrett v. J. Stevens Arms, etc., Co., 100 Fed. 93, 40 C. C. A. 289; Seabury v. Johnson, 76 Fed. 456; Muller v. Lodge, etc., Mach. Tool Co., 69 Fed. 738 [affirmed in 77 Fed. 621, 23 C. C. A. 357]; Pettibone v. Stanford, 53 Fed. 118, 3 C. C. A. 469; Celluloid Mfg. Co. v. Arlington Mfg. Co., 52 Fed. 740, 3 C. C. A. 269; Williams v. Stolzenbach, 23 Fed. 39; Le Fever v. Remington, 13 Fed. 86, 21 Blatchf. 80; Fuller v. Yentzer, 9 Fed. Cas. No. 5,151, 1 Ban. & A. 520, 6 Biss. 203 [affirmed in 94 U. S. 288, 24 L. ed. 1031]; Hawes v. Gage, 11 Fed. Cas. No. 6,237, 5 Off. Gaz. 494; Rich v. Lippincott, 20 Fed. Cas. No. 11,758, 2 Fish. Pat. Cas. 1, 1 Pittsb. (Pa.) 31.

A patent cannot be given a construction broader than its terms, in order to cover something which might have been claimed, but was not. Universal Brush Co. v. Sonn, 154 Fed. 665, 83 C. C. A. 422 [reversing 146 Fed. 517].

Statements of function in claims are binding. Masseth v. Larkin, 111 Fed. 409; Thomson Meter Co. v. National Meter Co., 106 Fed. 519.

28. Johnson v. Willimantic Linen Co., 33 Conn. 436; Miel v. Young, 29 App. Cas. (D. C.) 481; Andrews v. Nilson, 27 App. Cas. (D. C.) 451; Consolidated Rubber Tire Co. v. Firestone Tire, etc., Co., 151 Fed. 237, 80 C. C. A. 589 [affirming 147 Fed. 739]; Estabrook v. Dunbar, 8 Fed. Cas. No. 4,535, 2 Ban. & A. 427, 10 Off. Gaz. 909; Goodyear Dental Vulcanite Co. v. Davis, 10 Fed. Cas. No. 5,589, 3 Ban. & A. 115, 12 Off. Gaz. No. 14 [affirmed in 102 U. S. 222, 26 L. ed. 149]; Henderson v. Cleveland Co-Operative Store Co., 11 Fed. Cas. No. 6,351, 2 Ban. & A. 604, 12 Off. Gaz. 4. See *supra*, X, A, 2.



be read into a claim for the purpose of making out a case of novelty or infringement.<sup>29</sup>

**2. CLAIMS CONSTRUED BY SPECIFICATIONS.** The meanings of terms used in the claim are to be determined by reference to the specification,<sup>30</sup> and specific references in the claim to the specification is not necessary in order to warrant its consideration.<sup>31</sup> While specifications may be looked to to determine the meaning of the claim,<sup>32</sup> they cannot change the claim.<sup>33</sup>

A strict construction should not be resorted to, if the result would be a limitation on the actual invention, unless it is required by the language of the claim. *Wagner Type-writer Co. v. Wyckoff*, 151 Fed. 585, 81 C. C. A. 129 [modifying 138 Fed. 108].

29. *McCarty v. Lehigh Valley R. Co.*, 160 U. S. 110, 16 S. Ct. 240, 40 L. ed. 358; *Wollensak v. Sargent*, 151 U. S. 221, 14 S. Ct. 291, 38 L. ed. 137; *Western Electric Mfg. Co. v. Ansonia Brass Co.*, 114 U. S. 447, 5 S. Ct. 941, 29 L. ed. 210; *Electric Smelting, etc., Co. v. Pittsburg Reduction Co.*, 125 Fed. 926, 60 C. C. A. 636; *Metallic Extraction Co. v. Brown*, 110 Fed. 665, 49 C. C. A. 147; *Santa Clara Valley Mill, etc., Co. v. Prescott*, 102 Fed. 501, 42 C. C. A. 477; *Parsons v. Seelye*, 100 Fed. 455, 40 C. C. A. 486; *Lappin Brake-Shoe Co. v. Corning Brake-Shoe Co.*, 94 Fed. 162; *Wilson v. McCormick Harvesting Mach. Co.*, 92 Fed. 167, 34 C. C. A. 280; *Western Electric Co. v. Citizens' Tel. Co.*, 89 Fed. 670; *Doig v. Sutherland*, 87 Fed. 991; *Stearns v. Russell*, 85 Fed. 218, 29 C. C. A. 121; *Paul Boynton Co. v. Morris*, 82 Fed. 440 [affirmed in 87 Fed. 225, 30 C. C. A. 617]; *Royer v. Schultz Belting Co.*, 28 Fed. 850; *Roemer v. Neumann*, 26 Fed. 102; *Couse v. Johnson*, 6 Fed. Cas. No. 3,288, 4 Ban. & A. 501, 16 Off. Gaz. 719. *Compare Sanders v. Hancock*, 128 Fed. 424, 63 C. C. A. 166; *Canda v. Michigan Malleable Iron Co.*, 123 Fed. 95; *Wellman v. Midland Steel Co.*, 106 Fed. 221; *Miller v. Mawhinney Last Co.*, 96 Fed. 248.

30. *Andrews v. Nilson*, 27 App. Cas. (D. C.) 451; *Knapp v. Morss*, 150 U. S. 221, 14 S. Ct. 81, 37 L. ed. 1059; *McClain v. Ortmeier*, 141 U. S. 419, 12 S. Ct. 76, 35 L. ed. 800; *Haines v. McLaughlin*, 135 U. S. 584, 10 S. Ct. 876, 34 L. ed. 290; *Howe Mach. Co. v. National Needle Co.*, 134 U. S. 388, 10 S. Ct. 570, 33 L. ed. 963; *Snow v. Lake Shore, etc., R. Co.*, 121 U. S. 617, 7 S. Ct. 1343, 30 L. ed. 1004; *White v. Dunbar*, 119 U. S. 47, 7 S. Ct. 72, 30 L. ed. 303; *Yale Lock Co. v. Greenleaf*, 117 U. S. 554, 6 S. Ct. 846, 29 L. ed. 952; *Lehigh Valley R. Co. v. Mellon*, 104 U. S. 112, 26 L. ed. 639; *Merrill v. Yeomans*, 94 U. S. 568, 24 L. ed. 235; *Fuller v. Yentzer*, 94 U. S. 288, 24 L. ed. 103; *Hailes v. Van Wormer*, 20 Wall. (U. S.) 353, 22 L. ed. 241; *Mitchell v. Tilghman*, 19 Wall. (U. S.) 287, 22 L. ed. 125; *Turrill v. Michigan Southern, etc., R. Co.*, 1 Wall. (U. S.) 491, 17 L. ed. 668; *Robins Conveying Belt Co. v. American Road Mach. Co.*, 145 Fed. 923, 76 C. C. A. 461 [affirming 142 Fed. 221]; *Stillwell-Bierce, etc., Co. v. Enfaula Cotton Oil Co.*, 117 Fed. 410, 54 C. C. A. 584; *Lyons v. Drucker*, 106 Fed. 416, 45 C. C. A. 368;

*Crown Cork, etc., Co. v. Aluminum Stopper Co.*, 100 Fed. 849; *Soehner v. Favorite Store, etc., Co.*, 84 Fed. 182, 28 C. C. A. 317; *Adams Electric R. Co. v. Lindell R. Co.*, 77 Fed. 432, 23 C. C. A. 223; *Gould Coupler Co. v. Trojan Car-Coupler Co.*, 74 Fed. 794, 21 C. C. A. 97; *American Fibre-Chamois Co. v. Port Huron Fibre-Garment Mfg. Co.*, 72 Fed. 516, 18 C. C. A. 670; *Chemical Rubber Co. v. Raymond Rubber Co.*, 68 Fed. 570; *Groth v. International Postal Supply Co.*, 61 Fed. 284, 9 C. C. A. 507; *La Rue v. Western Electric Co.*, 28 Fed. 85; *Hancock Inspirator Co. v. Jenks*, 21 Fed. 911; *Evans v. Kelly*, 13 Fed. 903, 9 Biss. 251; *Matthews v. Shoneberger*, 4 Fed. 635, 18 Blatchf. 357; *Holly v. Vergennes Mach. Co.*, 4 Fed. 74, 18 Blatchf. 327; *Bryan v. Stevens*, 4 Fed. Cas. No. 2,066a; *Carter v. Messenger*, 5 Fed. Cas. No. 2,478, 11 Blatchf. 34; *Coffin v. Ogden*, 6 Fed. Cas. No. 2,950, 7 Blatchf. 61, 3 Fish. Pat. Cas. 640 [affirmed in 18 Wall. 120, 21 L. ed. 821]; *Estabrook v. Dunbar*, 8 Fed. Cas. No. 4,535, 2 Ban. & A. 427, 10 Off. Gaz. 909; *Francis v. Mellar*, 9 Fed. Cas. No. 5,039, 5 Fish. Pat. Cas. 153, 1 Off. Gaz. 48, 8 Phila. (Pa.) 157; *Hayden v. Suffolk Mfg. Co.*, 11 Fed. Cas. No. 6,261, 4 Fish. Pat. Cas. 86 [affirmed in 3 Wall. 315, 18 L. ed. 76]; *Johnson v. Root*, 13 Fed. Cas. No. 7,411, 1 Fish. Pat. Cas. 351; *King v. Gedney*, 14 Fed. Cas. No. 7,795, *McArthur Pat. Cas.* 443; *Morris v. Barrett*, 17 Fed. Cas. No. 9,827, 1 Bond 254, 1 Fish. Pat. Cas. 461; *Parker v. Stiles*, 18 Fed. Cas. No. 10,749, *Fish. Pat. Rep.* 319, 5 McLean 44; *Pitts v. Wemple*, 19 Fed. Cas. No. 11,194, 1 Biss. 87, 5 Fish. Pat. Cas. 10; *Ransom v. New York*, 20 Fed. Cas. No. 11,573, 1 Fish. Pat. Cas. 252; *Roberts v. Dickey*, 20 Fed. Cas. No. 11,899, 4 Fish. Pat. Cas. 532, 1 Off. Gaz. 4, 4 Brewst. (Pa.) 260; *Whipple v. Baldwin Mfg. Co.*, 29 Fed. Cas. No. 17,514, 4 Fish. Pat. Cas. 29.

Provisional specification cannot be used to enlarge the meaning of the complete specification. *Mackelcan v. Rennie*, 13 C. B. N. S. 52, 106 E. C. L. 52.

31. *National Meter Co. v. Neptune Meter Co.*, 122 Fed. 75; *Francis v. Mellar*, 9 Fed. Cas. No. 5,039, 5 Fish. Pat. Cas. 153, 1 Off. Gaz. 48, 8 Phila. (Pa.) 157.

32. *Krajewski v. Pharr*, 105 Fed. 514, 44 C. C. A. 572; *Electric Smelting, etc., Co. v. Carborundum Co.*, 102 Fed. 618, 42 C. C. A. 537; *Melvin v. Potter*, 91 Fed. 151; *Bennett v. Schooley*, 75 Fed. 392.

33. *Coburn Trolley-Track Mfg. Co. v. Chandler*, 91 Fed. 260; *Campbell Printing-Press, etc., Co. v. Duplex Printing-Press Co.*, 86 Fed. 315; *Kidd v. Horry*, 33 Fed. 712 [affirmed in 145 U. S. 643, 12 S. Ct. 983, 36



3. EFFECT OF WORDS "SUBSTANTIALLY AS DESCRIBED" IN CLAIM. Such words as "substantially as described" placed at the end of a claim do not have the effect of limiting the claim to precisely what is described and shown,<sup>34</sup> but mean merely that the specification and drawings are to be looked to in determining the meaning and scope of the terms used.<sup>35</sup> The words do limit the claim if necessary to sustain it or to cover the real invention.<sup>36</sup> They are implied in all claims whether they are actually present or not.<sup>37</sup>

4. REFERENCE LETTERS. The use in the claims of letters of reference appearing in the drawing as representing parts of the apparatus is not to be regarded as limiting the claim to the precise form of those parts unless such limitation is necessary in order to make the claim patentable over the prior art.<sup>38</sup>

5. EQUIVALENTS. A patentee is entitled to hold as infringer not merely one who makes or uses a device having the specific elements disclosed and claimed by him, but any one who makes or uses a device having elements which are known equivalents of those claimed.<sup>39</sup> The things, however, must be known equivalents

L. ed. 857]; *Railway Register Mfg. Co. v. Third Ave. R. Co.*, 33 Fed. 31 [*affirmed* in 149 U. S. 783, 13 S. Ct. 1051, 37 L. ed. 964]; *Becker v. Hastings*, 22 Fed. 827; *McKesson v. Carnrick*, 9 Fed. 44, 19 Blatchf. 158; *Detmold v. Reeves*, 7 Fed. Cas. No. 3,831, 1 Fish. Pat. Cas. 127.

34. *Hobbs v. Beach*, 180 U. S. 383, 21 S. Ct. 409, 45 L. ed. 586; *McCarty v. Lehigh Valley R. Co.*, 160 U. S. 110, 16 S. Ct. 240, 40 L. ed. 358; *American Can Co. v. Hickmott Asparagus Canning Co.*, 142 Fed. 141, 73 C. C. A. 359; *Boyer v. Keller Tool Co.*, 127 Fed. 130, 62 C. C. A. 244; *General Electric Co. v. International Specialty Co.*, 126 Fed. 755, 61 C. C. A. 329; *Lowrie v. H. A. Meldrum Co.*, 124 Fed. 761 [*reversed* on other grounds in 130 Fed. 886, 65 C. C. A. 194]; *Diamond Drill, etc., Co. v. Kelly*, 120 Fed. 289; *Beach v. Hobbs*, 92 Fed. 146, 34 C. C. A. 248; *Boynton Co. v. Morris Chute Co.*, 87 Fed. 225, 30 C. C. A. 617; *Goshen Sweeper Co. v. Bissell Carpet-Sweeper Co.*, 72 Fed. 67, 19 C. C. A. 13; *Westinghouse v. New York Air-Brake Co.*, 59 Fed. 581 [*modified* in 63 Fed. 962, 11 C. C. A. 528]; *Lorillard v. McDowell*, 15 Fed. Cas. No. 8,510, 2 Ban. & A. 531, 11 Off. Gaz. 640, 13 Phila. (Pa.) 461.

35. *Brown v. Davis*, 116 U. S. 237, 6 S. Ct. 379, 29 L. ed. 659; *Seymour v. Osborne*, 11 Wall. (U. S.) 516, 20 L. ed. 33; *Scott v. Fisher Knitting Mach. Co.*, 139 Fed. 137 [*reversed* on other grounds in 145 Fed. 915, 76 C. C. A. 447]; *Fruit-Cleaning Co. v. Fresno Home-Packing Co.*, 94 Fed. 845; *Campbell v. Richardson*, 76 Fed. 976, 22 C. C. A. 669; *Columbus Watch Co. v. Robbins*, 64 Fed. 384, 12 C. C. A. 174; *Westinghouse v. Edison Electric Light Co.*, 63 Fed. 588, 11 C. C. A. 342; *Bortree v. Jackson*, 43 Fed. 136; *Gottfried v. Phillip Best Brewing Co.*, 10 Fed. Cas. No. 5,633, 5 Ban. & A. 4, 17 Off. Gaz. 675; *Knight v. Gavit*, 14 Fed. Cas. No. 7,884.

36. *Schaum v. Riehl*, 124 Fed. 320; *Parsons v. Seelye*, 92 Fed. 1005; *Brill v. St. Louis Car Co.*, 90 Fed. 666, 33 C. C. A. 213; *Campbell Printing-Press, etc., Co. v. Duplex Printing-Press Co.*, 86 Fed. 315; *Adams Electric R. Co. v. Lindell R. Co.*, 77 Fed. 432, 23 C. C. A. 223; *Davis v. Parkman*, 71

Fed. 961, 18 C. C. A. 398; *Carter Mach. Co. v. Hanes*, 70 Fed. 859; *Boyden Power-Brake Co. v. Westinghouse Air-Brake Co.*, 70 Fed. 816, 17 C. C. A. 430 [*reversed* on other grounds in 170 U. S. 537, 18 S. Ct. 707, 42 L. ed. 1136]; *Lee v. Pillsbury*, 49 Fed. 747; *Rapid Service Store R. Co. v. Taylor*, 43 Fed. 249; *Bruce v. Marder*, 10 Fed. 750, 20 Blatchf. 355; *Vance v. Campbell*, 28 Fed. Cas. No. 16,837, 1 Fish. Pat. Cas. 483 [*reversed* on other grounds in 1 Black 427, 17 L. ed. 168].

37. *National Meter Co. v. Neptune Meter Co.*, 122 Fed. 75 [*reversed* on other grounds in 127 Fed. 563, 62 C. C. A. 345]; *Beach v. Hobbs*, 82 Fed. 916; *Francis v. Mellor*, 9 Fed. Cas. No. 5,039, 5 Fish. Pat. Cas. 153, 1 Off. Gaz. 48, 8 Phila. (Pa.) 157; *Metropolitan Wringing-Mach. Co. v. Young*, 17 Fed. Cas. No. 9,508, 2 Ban. & A. 460, 14 Blatchf. 46; *Westinghouse v. Gardner, etc., Air-Brake Co.*, 29 Fed. Cas. No. 17,450, 2 Ban. & A. 55, 9 Off. Gaz. 538.

38. *Brunswick-Balke-Collender Co. v. Rosatto*, 159 Fed. 729; *Electric Candy Mach. Co. v. Morris*, 156 Fed. 972; *Kelsey Heating Co. v. James Spear Stove, etc., Co.*, 155 Fed. 976; *National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co.*, 106 Fed. 693, 45 C. C. A. 544; *Bonnette Arc Lawn Sprinkler Co. v. Koehler*, 82 Fed. 428, 27 C. C. A. 200; *Muller v. Lodge, etc., Mach. Tool Co.*, 77 Fed. 621, 23 C. C. A. 357; *Schreiber, etc., Co. v. Grimm*, 72 Fed. 671, 19 C. C. A. 67; *McCormick Harvesting Mach. Co. v. Aultman*, 69 Fed. 371, 16 C. C. A. 259; *Delemater v. Heath*, 58 Fed. 414, 7 C. C. A. 279; *Brown v. Stilwell, etc., Mfg. Co.*, 57 Fed. 731, 741, 6 C. C. A. 528.

Improvements of narrow character.—The use of letters in a claim to describe a patented invention, which is merely an improvement of a narrow character, will limit the inventor to the elements so designated, as shown in the drawings and specifications to which the letters refer, which are by such reference, in effect, incorporated in the claim. *Ross-Moyer Lfg. Co. v. Randall*, 104 Fed. 355, 43 C. C. A. 578.

39. *Dolbear v. American Bell Tel. Co.*, 126 U. S. 1, 8 S. Ct. 778, 31 L. ed. 863; *Diamond*



of each other at the time of the patent.<sup>40</sup> What is regarded as an equivalent depends upon the circumstances of the particular case.<sup>41</sup>

**6. PIONEER INVENTIONS.**<sup>42</sup> Where the invention is broad and meritorious and makes a radical advance in the art, the field of equivalents is equally broad and the claim will receive a broad and liberal interpretation.<sup>43</sup> A patent original in its character is entitled to a broader construction than one which is for a mere improvement.<sup>44</sup>

**7. IMPROVEMENTS.** Where the invention is a narrow specific improvement upon prior inventions, the field of equivalents is restricted and the patent must be narrowly construed.<sup>45</sup> One who merely makes and secures a patent for a slight

Match Co. v. Ruby Match Co., 127 Fed. 341; Klauder-Weldon Dyeing Mach. Co. v. Steadwell Dyeing Mach. Co., 122 Fed. 640 [affirmed in 128 Fed. 724, 63 C. C. A. 322]; Union Steam-Pump Co. v. Battle Creek Steam-Pump Co., 104 Fed. 337, 43 C. C. A. 560; Bundy Mfg. Co. v. Detroit Time-Register Co., 94 Fed. 524, 36 C. C. A. 375; Thrall v. Poole, 89 Fed. 718; Delemater v. Heath, 58 Fed. 414, 7 C. C. A. 279; Rodebaugh v. Jackson, 37 Fed. 882; Burden v. Corning, 4 Fed. Cas. No. 2,143, 2 Fish. Pat. Cas. 477; Corliss v. Wheeler, etc., Mfg. Co., 4 Fed. Cas. No. 2,233, 2 Fish. Pat. Cas. 199; Hayden v. Suffolk Mfg. Co., 11 Fed. Cas. No. 6,261, 4 Fish. Pat. Cas. 86 [affirmed in 3 Wall. 315, 18 L. ed. 76]; McComb v. Brodie, 15 Fed. Cas. No. 8,708, 5 Fish. Pat. Cas. 384, 1 Woods 153, 2 Off. Gaz. 117; Murphy v. Eastham, 17 Fed. Cas. No. 9,949, 5 Fish. Pat. Cas. 306, Holmes 113, 2 Off. Gaz. 61. And see *infra*, X, B, 6.

Equivalents in process see Schwarzwalder v. New York Filter Co., 66 Fed. 152, 13 C. C. A. 380; Bridge v. Brown, 4 Fed. Cas. No. 1,857, Holmes 53.

Equivalent ingredients of composition see Blount v. Societe Anonyme du Filtre Chamberland Systeme Pasteur, 53 Fed. 98, 3 C. C. A. 455; Francis v. Mellor, 9 Fed. Cas. No. 5,039, 5 Fish. Pat. Cas. 153, 1 Off. Gaz. 48, 8 Phila. (Pa.) 157; Goodyear v. Berry, 10 Fed. Cas. No. 5,556, 2 Bond 189, 3 Fish. Pat. Cas. 439; Matthews v. Skates, 16 Fed. Cas. No. 9,291, 1 Fish. Pat. Cas. 602.

**40.** Folger v. Dow Portable Electric Co., 128 Fed. 45 [affirmed in 133 Fed. 295, 68 C. C. A. 551]; Severy Process Co. v. Harper, 113 Fed. 581; Magic Light Co. v. Economy Gas-Lamp Co., 97 Fed. 87, 38 C. C. A. 56; Kelly v. Springfield R. Co., 92 Fed. 614, 34 C. C. A. 570; Gerard v. Diebold Safe, etc., Co., 61 Fed. 209, 9 C. C. A. 451, 54 Fed. 889, 4 C. C. A. 644; Colgate v. Law Tel. Co., 6 Fed. Cas. No. 2,993a, 5 Ban. & A. 437; McCormick v. Manny, 15 Fed. Cas. No. 8,724, 6 McLean 539 [affirmed in 20 How. 402, 15 L. ed. 930].

**41.** Rich v. Baldwin, 133 Fed. 920, 66 C. C. A. 464; Dowagiac Mfg. Co. v. Brennan, 118 Fed. 143 [reversed on other grounds in 127 Fed. 143, 62 C. C. A. 257]; Adams Co. v. Schreiber, etc., Mfg. Co., 111 Fed. 182 [reversed on other grounds in 117 Fed. 830, 54 C. C. A. 128]; Brammer v. Schroeder, 106 Fed. 918, 46 C. C. A. 41; National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co., 106 Fed. 693, 45 C. C. A. 544;

Carter Mach. Co. v. Hanes, 70 Fed. 859; Erie Rubber Co. v. American Dunlop Tire Co., 70 Fed. 58, 16 C. C. A. 632; Pittsburgh Reduction Co. v. Cowles Electric Smelting, etc., Co., 55 Fed. 301; Norton v. Jensen, 49 Fed. 859, 1 C. C. A. 452; Celluloid Mfg. Co. v. Cellonite Mfg. Co., 42 Fed. 900; Michaelis v. Roessler, 34 Fed. 325; Bridgeport Wood Finishing Co. v. Hooper, 5 Fed. 63, 18 Blatchf. 459.

**42.** The word "pioneer" is commonly understood to denote a patent covering a function never before performed, a wholly novel device, or one of such novelty and importance as to mark a distinct step in the progress of the art, as distinguished from a mere improvement or perfection of what has gone before. Westinghouse v. Boyden Power-Brake Co., 170 U. S. 537, 561, 18 S. Ct. 707, 42 L. ed. 1136.

**43.** Tecktonius v. Scott, 110 Wis. 441, 86 N. W. 672; Boyden Power-Brake Co. v. Westinghouse, 170 U. S. 537, 18 S. Ct. 707, 42 L. ed. 1136; Sessions v. Romadka, 145 U. S. 29, 12 S. Ct. 799, 36 L. ed. 609; Morley Sewing Mach. Co. v. Lancaster, 129 U. S. 263, 9 S. Ct. 299, 32 L. ed. 715; Marconi Wireless Tel. Co. v. De Forest Wireless Tel. Co., 138 Fed. 657; Dowagiac Mfg. Co. v. Minnesota Moline Plow Co., 118 Fed. 136, 55 C. C. A. 86; Metallic Extraction Co. v. Brown, 104 Fed. 345, 43 C. C. A. 568; Ford v. Bancroft, 98 Fed. 309, 39 C. C. A. 91; King Ax Co. v. Hubbard, 97 Fed. 795, 38 C. C. A. 423; Penfield v. Chambers Bros. Co., 92 Fed. 630, 34 C. C. A. 579; Muller v. Lodge, etc., Mach. Tool Co., 77 Fed. 621, 23 C. C. A. 357; Tuttle v. Claflin, 76 Fed. 227, 22 C. C. A. 138; Reminder Lock Co. v. Adler, 71 Fed. 183; Bowers v. Von Schmidt, 63 Fed. 572; Groth v. International Postal Supply Co., 61 Fed. 284, 9 C. C. A. 507; Harmon v. Struthers, 57 Fed. 637; Troy Laundry Mach. Co. v. Sharp, 54 Fed. 712; Dederick v. Seigmund, 51 Fed. 233, 2 C. C. A. 169; Norton v. Jensen, 49 Fed. 859, 1 C. C. A. 452; Torrant v. Duluth Lumber Co., 30 Fed. 830; May v. Fond du Lac, 27 Fed. 691; Standard Measuring Mach. Co. v. Teague, 15 Fed. 390; Hammerschlag v. Scamoni, 7 Fed. 584; Knapp v. Joubert, 7 Fed. 219, 19 Blatchf. 148; Cornell v. Downer, etc., Brewing Co., 6 Fed. Cas. No. 3,236, 2 Ban. & A. 514, 7 Biss. 346, 11 Off. Gaz. 331.

**44.** May v. Fond du Lac, 27 Fed. 691.

**45.** Singer Mfg. Co. v. Cramer, 192 U. S. 265, 24 S. Ct. 201, 48 L. ed. 437; Wright v. Yuengling, 155 U. S. 47, 15 S. Ct. 1, 39 L. ed.



improvement on an old device or combination, which performed the same functions before as after the improvement, is protected against those only who use the very device or improvement he describes or claims, or mere colorable evasions of it.<sup>46</sup> The term "mechanical equivalent," when applied to a slight and almost immaterial improvement in the progress of an art, has a very narrow and limited meaning.<sup>47</sup>

**8. COMBINATION.** Every element included in a combination claim must be regarded as material, and therefore the claim covers nothing less than the entire combination.<sup>48</sup>

**9. AMENDMENT IN PATENT OFFICE.** Limitations placed in a claim by amendment in response to rejections by the patent office must be regarded as material,

64; *Knapp v. Morss*, 150 U. S. 221, 14 S. Ct. 81, 37 L. ed. 1059; *Chicago, etc., R. Co. v. Sayles*, 97 U. S. 554, 24 L. ed. 1053; *Hardison v. Brinkman*, 156 Fed. 962; *Kenney Mfg. Co. v. J. L. Mott Iron Works*, 137 Fed. 431; *Rich v. Baldwin*, 133 Fed. 920, 66 C. C. A. 464; *Weisgerber v. Clowney*, 131 Fed. 477; *Folger v. Dow Portable Electric Co.*, 128 Fed. 45 [affirmed in 133 Fed. 295, 68 C. C. A. 551]; *Sander v. Rose*, 121 Fed. 835, 58 C. C. A. 171; *General Fire Extinguisher Co. v. Mallers*, 110 Fed. 528; *Goodyear Shoe Mach. Co. v. Spaulding*, 110 Fed. 393, 49 C. C. A. 88; *Thomas-Houston Electric Co. v. Lorain Steel Co.*, 107 Fed. 711, 46 C. C. A. 593; *Davey Pegging Mach. Co. v. Pronty*, 107 Fed. 505, 46 C. C. A. 439; *Brammer v. Schroeder*, 106 Fed. 918, 46 C. C. A. 41; *National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co.*, 106 Fed. 693, 45 C. C. A. 544; *Winslow v. Bronson*, 106 Fed. 178; *Kursheedt Mfg. Co. v. Naday*, 103 Fed. 948; *Reineke v. Dixon-Woods Co.*, 102 Fed. 349, 42 C. C. A. 388; *Noonan v. Chester Park Athletic Club Co.*, 99 Fed. 90, 39 C. C. A. 426; *Nutter v. Brown*, 98 Fed. 892, 39 C. C. A. 332; *McBride v. Kingman*, 97 Fed. 217, 38 C. C. A. 123; *Westinghouse Air-Brake Co. v. New York Air-Brake Co.*, 96 Fed. 991, 37 C. C. A. 649; *Union Switch, etc., Co. v. Philadelphia, etc., R. Co.*, 96 Fed. 761, 37 C. C. A. 580; *Taber Bas-Relief Photograph Co. v. Marceau*, 87 Fed. 871; *MacColl v. Crompton Loom Works*, 87 Fed. 731 [affirmed in 95 Fed. 987]; *Hart, etc., Mfg. Co. v. Anchor Electric Co.*, 82 Fed. 911; *Norton v. Jensen*, 81 Fed. 494; *Adams Electric R. Co. v. Lindell R. Co.*, 77 Fed. 432, 23 C. C. A. 223; *Murphy Mfg. Co. v. Excelsior Car-Roof Co.*, 76 Fed. 965, 22 C. C. A. 658; *Edison Electric Light Co. v. Electrical Engineering, etc., Co.*, 72 Fed. 274; *Carter Mach. Co. v. Hanes*, 70 Fed. 859; *Wright, etc., Wire-Cloth Co. v. Clinton Wire-Cloth Co.*, 67 Fed. 790, 14 C. C. A. 646; *Wells v. Curtis*, 66 Fed. 318, 13 C. C. A. 494; *Stirratt v. Excelsior Mfg. Co.*, 61 Fed. 980, 10 C. C. A. 216; *Standard Folding-Bed Co. v. Osgood*, 51 Fed. 675 [reversed on other grounds in 58 Fed. 583, 7 C. C. A. 382]; *Jones Co. v. Munger Improved Cotton Mach. Mfg. Co.*, 49 Fed. 61, 1 C. C. A. 158; *Wright v. Postel*, 44 Fed. 352; *Schmid v. Scovill Mfg. Co.*, 37 Fed. 345; *Hill v. Sawyer*, 31 Fed. 282, 24 Blatchf. 430; *Hoff v. Iron-Clad Mfg. Co.*, 31 Fed. 45; *Johnston Ruffler Co. v. Avery Mach. Co.*, 28 Fed. 193; *Oseola Mfg. Co. v. Pie*, 28 Fed. 83; *Tobey Furniture Co. v.*

*Colby*, 26 Fed. 100; *Buzzell v. Andrews*, 25 Fed. 822; *Root v. Lamb*, 7 Fed. 222; *Crompton v. Belknap Mills*, 6 Fed. Cas. No. 3,406, 3 Fish. Pat. Cas. 536; *Fuller v. Yentzer*, 9 Fed. Cas. No. 5,151, 1 Ban. & A. 520, 6 Biss. 203 [affirmed in 94 U. S. 288, 24 L. ed. 103]; *Rapp v. Bard*, 20 Fed. Cas. No. 11,577, 1 Fish. Pat. Cas. 196; *Union Sugar Refinery v. Matthiesson*, 24 Fed. Cas. No. 14,399, 3 Cliff. 639, 2 Fish. Pat. Cas. 600; *Yuengling v. Johnson*, 30 Fed. Cas. No. 18,195, 3 Ban. & A. 99, 1 Hughes 607; *Crompton v. Belknap Mills*, 30 Fed. Cas. No. 18,285, 3 Fish. Pat. Cas. 356.

Patentee entitled to reasonable range of equivalents see *Levy v. Harris*, 124 Fed. 69 [affirmed in 130 Fed. 711, 65 C. C. A. 113]; *McSherry Mfg. Co. v. Dowagiac Mfg. Co.*, 101 Fed. 716, 41 C. C. A. 627; *Tatum v. Gregory*, 41 Fed. 142; *Wollensack v. Reiher*, 28 Fed. 424.

46. *Chicago, etc., R. Co. v. Sayles*, 97 U. S. 554, 24 L. ed. 1053; *McCormick v. Talcott*, 20 How. (U. S.) 402, 15 L. ed. 930; *Brammer v. Schroeder*, 106 Fed. 918, 46 C. C. A. 41; *Adams Electric R. Co. v. Lindell R. Co.*, 77 Fed. 432, 23 C. C. A. 223; *Stirratt v. Excelsior Mfg. Co.*, 61 Fed. 980, 10 C. C. A. 216.

47. *Brammer v. Schroeder*, 106 Fed. 918, 46 C. C. A. 41.

48. *Wollensack v. Sargent*, 151 U. S. 221, 14 S. Ct. 291, 38 L. ed. 137; *Snow v. Lake Snore, etc., R. Co.*, 121 U. S. 617, 7 S. Ct. 1343, 30 L. ed. 1004; *Bragg v. Fitch*, 121 U. S. 478, 7 S. Ct. 978, 30 L. ed. 1008; *Electric R. Signal Co. v. Hall R. Signal Co.*, 114 U. S. 87, 5 S. Ct. 1069, 29 L. ed. 96; *Rowell v. Lindsay*, 113 U. S. 97, 5 S. Ct. 507, 28 L. ed. 906; *Fay v. Cordesman*, 109 U. S. 408, 3 S. Ct. 236, 27 L. ed. 979; *Case v. Brown*, 2 Wall. (U. S.) 320, 17 L. ed. 817; *U. S. Peg Wood, etc., Co. v. B. F. Sturtevant*, 122 Fed. 476 [affirmed in 125 Fed. 382, 60 C. C. A. 248]; *Muller v. Lodge, etc., Mach. Tool Co.*, 77 Fed. 621, 23 C. C. A. 357; *Thomson-Houston Electric Co. v. Kelsey Electric R. Specialty Co.*, 75 Fed. 1005, 22 C. C. A. 1; *Mott Iron-Works Co. v. Standard Mfg. Co.*, 53 Fed. 819, 4 C. C. A. 28; *Stewart v. Mahoney*, 5 Fed. 302; *Brooks v. Jenkins*, 4 Fed. Cas. No. 1,953, Fish. Pat. Rep. 41, 3 McLean 432; *Parham v. American Buttonhole, etc., Co.*, 18 Fed. Cas. No. 10,713, 4 Fish. Pat. Cas. 478; *Prouty v. Draper*, 20 Fed. Cas. No. 11,446, 2 Rapp Pat. Cas. 75, 1 Story 568 [affirmed in 16 Pet. 336, 10 L. ed. 985]. And see *infra*, XIII, A, 5.



and therefore the claim cannot be given the meaning which it would have had without amendment.<sup>49</sup> The rule applies to cases in which the original claim is narrower than the patent as well as to cases in which it is broader.<sup>50</sup> So it applies, although the objections to the claim were unfounded and the limitation unnecessary.<sup>51</sup> Mere formal amendments, however, will not limit the patent;<sup>52</sup> and in any event the patent will not be limited by the amendment beyond what is necessary,<sup>53</sup> nor construed as a disclaimer of the patentee's actual invention, if

49. *Hubbell v. U. S.*, 179 U. S. 86, 21 S. Ct. 28, 45 L. ed. 100; *McCarty v. Lehigh Valley R. Co.*, 160 U. S. 110, 16 S. Ct. 240, 40 L. ed. 358; *Lehigh Valley R. Co. v. Kearney*, 158 U. S. 461, 15 S. Ct. 871, 39 L. ed. 1055; *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.*, 152 U. S. 425, 14 S. Ct. 627, 38 L. ed. 500; *Knapp v. Morss*, 150 U. S. 221, 14 S. Ct. 81, 37 L. ed. 1059; *Royer v. Coupe*, 146 U. S. 524, 13 S. Ct. 166, 36 L. ed. 1073; *Phoenix Caster Co. v. Spiegel*, 133 U. S. 360, 10 S. Ct. 409, 33 L. ed. 663; *McCormick v. Whitmer*, 129 U. S. 1, 9 S. Ct. 213, 32 L. ed. 593; *Crawford v. Heysinger*, 128 U. S. 589, 8 S. Ct. 399, 31 L. ed. 269; *Sutter v. Robinson*, 119 U. S. 530, 7 S. Ct. 376, 30 L. ed. 492; *Shepard v. Carrigan*, 116 U. S. 593, 6 S. Ct. 493, 29 L. ed. 723; *Sargent v. Hall Safe, etc.*, Co., 114 U. S. 63, 5 S. Ct. 1021, 29 L. ed. 67; *American Stove Co. v. Cleveland Foundry Co.*, 158 Fed. 978; *St. Louis St. Flushing Mach. Co. v. American St. Flushing Mach. Co.*, 156 Fed. 574, 84 C. C. A. 340; *Good Form Mfg. Co. v. White*, 153 Fed. 759; *Greene v. Buckley*, 135 Fed. 520, 68 C. C. A. 70; *Hale v. World Mfg. Co.*, 127 Fed. 964, 62 C. C. A. 596; *Ludington Novelty Co. v. Leonard*, 119 Fed. 937 [affirmed in 127 Fed. 155, 62 C. C. A. 269]; *General Fire Extinguisher Co. v. Mellers*, 110 Fed. 528; *Millard v. Chase*, 108 Fed. 399, 47 C. C. A. 429; *Reineke v. Dixon-Woods Co.*, 102 Fed. 349, 42 C. C. A. 388; *Campbell Printing-Press, etc., Co. v. Duplex Printing-Press Co.*, 101 Fed. 282, 41 C. C. A. 351; *National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co.*, 99 Fed. 758; *Anthony v. Gennert*, 99 Fed. 95; *Irwin v. Hasselman*, 97 Fed. 964, 38 C. C. A. 587; *Coburn Trolley-Track Mfg. Co. v. Chandler*, 97 Fed. 333, 38 C. C. A. 201; *Magic Light Co. v. Economy Gas-Lamp Co.*, 97 Fed. 87, 38 C. C. A. 56; *Norton v. Jensen*, 90 Fed. 415, 33 C. C. A. 141; *Carnegie Steel Co. v. Cambria Iron Co.*, 89 Fed. 721 [reversed on other grounds in 96 Fed. 850, 37 C. C. A. 593]; *Griffith v. Shaw*, 89 Fed. 313; *Kelly v. Clow*, 89 Fed. 297, 32 C. C. A. 205; *Perkins Electric Switch Mfg. Co. v. Gibbs Electric Mfg. Co.*, 87 Fed. 922; *Stearns v. Russell*, 85 Fed. 218, 29 C. C. A. 121; *Olmsted v. Andrews*, 77 Fed. 835, 23 C. C. A. 488; *Wheaton v. Norton*, 70 Fed. 833, 17 C. C. A. 447; *Kennedy v. Solar Refining Co.*, 69 Fed. 715; *Reece Button-Hole Mach. Co. v. Globe Button-Hole Mach. Co.*, 61 Fed. 958, 10 C. C. A. 194; *McCormack Harvesting Mach. Co. v. Aultman*, 58 Fed. 773; *Temple Pump Co. v. Goss Pump, etc., Mfg. Co.*, 58 Fed. 196, 7 C. C. A. 174; *Merritt v. Middleton*, 55 Fed. 976 [affirmed in 61 Fed. 680, 10 C. C. A. 101]; *Mott Iron-Works Co. v. Standard Mfg. Co.*, 53 Fed.

819, 4 C. C. A. 28; *Gamewell Fire-Alarm Tel. Co. v. Municipal Signal Co.*, 52 Fed. 471; *Douglas v. Abraham*, 50 Fed. 420; *Shaw Stocking Co. v. Pearson*, 48 Fed. 234; *Falls Rivet Co. v. Wolfe*, 40 Fed. 465; *Brahn v. Ramapo Iron-Works*, 35 Fed. 63; *Romer v. Peddie*, 27 Fed. 702; *New York Belting, etc., Co. v. Sibley*, 15 Fed. 386. And see *supra*, X, A, 5.

**Qualification of acquiescence.**—The applicant cannot qualify the effect of acquiescence by statements. *Norton v. Jensen*, 81 Fed. 494; *Thomas v. Rocker Spring Co.*, 77 Fed. 420, 23 C. C. A. 211.

**Liberal construction of claim as granted.**—While it is settled law that a patentee who has acquiesced in the rejection of a broad claim by substituting a narrower one cannot insist upon a construction of the latter to cover that which was rejected, yet such rule does not debar him from a liberal construction of the claim as granted, nor from the benefit of the doctrine of equivalents. *Heywood Bros., etc., Co. v. Syracuse Rapid Transit R. Co.*, 152 Fed. 453.

**Amendments as to incidental matters.**—If there was no amendment narrowing a claim of a patent in respect to the essential feature of the invention disclosed therein, amendments made in reference to an incidental matter intended to perfect the claim or device impose no restriction on the rights of the patentee in respect to equivalents. *Heywood Bros., etc., Co. v. Syracuse Rapid Transit R. Co.*, 152 Fed. 453.

50. *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.*, 152 U. S. 425, 14 S. Ct. 627, 38 L. ed. 500.

51. *Safety Oiler Co. v. Scovill Mfg. Co.*, 110 Fed. 203; *Brill v. St. Louis Car Co.*, 90 Fed. 666, 33 C. C. A. 213; *Truman v. Deere Implement Co.*, 80 Fed. 109; *Smith v. Macbeth*, 67 Fed. 137, 14 C. C. A. 241; *Ball, etc., Fastener Co. v. Ball Glove Fastening Co.*, 58 Fed. 818, 7 C. C. A. 498; *Reece Buttonhole Mach. Co. v. Globe Buttonhole Mach. Co.*, 54 Fed. 884 [reversed on other grounds in 61 Fed. 958, 10 C. C. A. 194]; *Blades v. Rand*, 27 Fed. 93 [affirmed in 136 U. S. 631, 10 S. Ct. 1065, 34 L. ed. 553].

52. *Welsbach Light Co. v. Cremo Incandescent Light Co.*, 145 Fed. 521 [affirmed in 151 Fed. 1023, 81 C. C. A. 683]; *Diamond Drill, etc., Co. v. Kelly*, 120 Fed. 282 [reversed on other grounds in 123 Fed. 882, 59 C. C. A. 370]; *Babcock v. Clarkson*, 58 Fed. 581; *Bunt Bros. Fruit-Packing Co. v. Cassidy*, 53 Fed. 257, 3 C. C. A. 525; *Brush Electric Co. v. Electric Imp. Co.*, 52 Fed. 965.

53. *Eck v. Kutz*, 132 Fed. 758; *National Hollow Brake-Beam Co. v. Interchangeable*



such construction can be avoided without doing violence to the obvious meaning of the language used.<sup>54</sup>

**10. SEPARATE CLAIMS DISTINGUISHED.** The several claims of a patent must be so construed where possible as to give them different meanings.<sup>55</sup>

**11. DESIGNS.** Design patents govern not merely the identical design disclosed, but such as so nearly resemble it in appearance as to deceive ordinary observers.<sup>56</sup> The ordinary principles of construction apply.<sup>57</sup>

## XI. TITLE, CONVEYANCES, AND CONTRACTS.<sup>58</sup>

**A. Assignments and Other Transfers<sup>59</sup> — 1. IN GENERAL — a. Assignability.** Under express statutory provisions patents and interests therein are assignable.<sup>60</sup>

**b. Who May Assign<sup>61</sup> — (1) IN GENERAL.** The patentee, his assigns or legal representatives, may transfer interests in or rights under the patent.<sup>62</sup>

**(ii) JOINT OWNERS.<sup>63</sup>** Where two or more parties own a patent jointly, either may make, use, and sell the invention, or grant to others the right to do so, and this is true without regard to the proportionate interest which the parties own.<sup>64</sup>

Brake-Beam Co., 106 Fed. 693, 45 C. C. A. 544; Bundy Mfg. Co. v. Detroit Time-Register Co., 94 Fed. 524, 36 C. C. A. 375; Heap v. Greene, 91 Fed. 792, 34 C. C. A. 86; Westinghouse v. Boyden Power-Brake Co., 66 Fed. 997; Consolidated Roller-Mill Co. v. Coombs, 39 Fed. 25.

**54. Lake Shore, etc., R. Co. v. National Car-Brake Shoe Co.,** 110 U. S. 229, 4 S. Ct. 33, 28 L. ed. 129; Westinghouse v. Boyden Power-Brake Co., 66 Fed. 997; Reece Button-Hole Mach. Co. v. Globe Button-Hole Mach. Co., 61 Fed. 958, 10 C. C. A. 194.

**55. Ruete v. Elwell,** 15 App. Cas. (D. C.) 21; Diamond Match Co. v. Ruby Match Co., 127 Fed. 341; Thomson-Houston Electric Co. v. Nassau Electric R. Co., 110 Fed. 647; Anderson Foundry, etc., Works v. Potts, 108 Fed. 379, 47 C. C. A. 409; Bresnahan v. Tripp Giant Leveller Co., 102 Fed. 899, 43 C. C. A. 48; Page Woven Wire Fence Co. v. Land, 49 Fed. 936; Tondeur v. Stewart, 28 Fed. 561; Cohansey Glass Mfg. Co. v. Wharton, 28 Fed. 189; Burden v. Corning, 4 Fed. Cas. No. 2,143, 2 Fish. Pat. Cas. 477.

Co-pending applications covering other developments will not limit claims. Manhattan Gen. Constr. Co. v. Helios-Upton Co., 135 Fed. 785.

Later patent for one form may indicate intended scope of claims in first. McCormick Harvesting Mach. Co. v. Aultman, 58 Fed. 773.

**56. Smith v. Whitman Saddle Co.,** 148 U. S. 674, 13 S. Ct. 768, 37 L. ed. 606; Brad-dock Glass Co. v. Macbeth, 64 Fed. 118, 12 C. C. A. 70.

Mechanical constructions are not covered by design patents. Royal Metal Mfg. Co. v. Art Metal Works, 121 Fed. 128 [affirmed in 130 Fed. 778, 66 C. C. A. 88].

Limited to particular design shown.—Design patents cannot be enlarged by the specification but are limited to the particular design shown in the drawings filed. Frank v. Hess, 84 Fed. 170.

Changes of color are immaterial. Whit-tall v. Lowell Mfg. Co., 79 Fed. 787.

**57. U. S. Rev. St. (1878) § 4933** [U. S.

Comp. St. (1901) p. 3399]; Northrup v. Adams, 18 Fed. Cas. No. 10,328, 2 Ban. & A. 567, 12 Off. Gaz. 430; *In re Mygatt*, 12 Off. Gaz. 51.

**58. See supra, I, A, 5.**

Regulation of dealings in patent rights and patented articles see *infra*, XII.

Subject to: Creditors' suits see CREDITORS' SUITS, 12 Cyc. 31. Execution see EXECUTIONS, 17 Cyc. 943.

**59. Insolvency** see INSOLVENCY, 22 Cyc. 1281.

**60. U. S. Rev. St. (1878) § 4898; Campbell v. James,** 2 Fed. 338, 18 Blatchf. 92, holding that all interests in patents are assignable in writing.

Sale of patent right and of article made under patent are distinguished in *Burns v. Sparks*, 82 S. W. 425, 26 Ky. L. Rep. 688.

**61. Agent's power to assign** see PRINCIPAL AND AGENT.

**62. U. S. Rev. St. (1878) § 4898.**

An administrator or executor may assign. *Donoughe v. Hubbard*, 27 Fed. 742; *Elwood v. Christy*, 17 C. B. N. S. 754, 10 Jur. N. S. 1079, 34 L. J. C. P. 130, 11 L. T. Rep. N. S. 342, 13 Wkly. Rep. 54, 112 E. C. L. 754.

One of two administrators may assign. *Wintermute v. Redington*, 30 Fed. Cas. No. 17,896, 1 Fish. Pat. Cas. 239.

Assignment by person of unsound mind is void. *Colburn v. Van Velzer*, 11 Fed. 795, 3 McCrary 650. See, generally, INSANE PERSONS, 22 Cyc. 1194.

Husband and wife may make transfers as if strangers. *Armitage v. Mace*, 96 N. Y. 538; *Adams v. Adams*, 91 N. Y. 381, 43 Am. Rep. 675; *Waterman v. Mackenzie*, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923.

The ability of a married woman to make the instrument of assignment must be found in state laws. *Fetter v. Newhall*, 17 Fed. 841, 21 Blatchf. 445. See, generally, HUSBAND AND WIFE, 21 Cyc. 1310 *et seq.*

**63. Who entitled to royalties** see *infra*, XI, B, 3, a, (III).

**64. Gates v. Fraser,** 9 Ill. App. 624 [affirmed in 118 Ill. 99, 1 N. E. 817]; *Lalance, etc., Mfg. Co. v. National Enameling, etc.,*



But a part owner of a patent has no right to use an infringing device. If he does he is liable to his coöwner for the wrong done.<sup>65</sup> A coöwner cannot maintain a suit for infringement against the grantee.<sup>66</sup> Nor can one joint owner be held accountable to his coöwners for any part of the profits he may make from the manufacture and sale or use of the patented article.<sup>67</sup> The rights of the coöwners may, however, be limited by an express contract.<sup>68</sup>

**2. AGREEMENTS TO ASSIGN** — **a. In General.** An agreement to assign a patent is an executory contract which may be enforced in a court of equity.<sup>70</sup> The agreement to assign may be oral, such an agreement not being within the statute of frauds, nor within section 4898 of the Revised Statutes requiring assignments of patents to be in writing.<sup>71</sup> Specific performance of such an agreement will, however, be refused where the patent is void.<sup>72</sup>

**b. Future Patents.** An agreement to assign patents not yet secured may be enforced if it is sufficiently definite as to the subject-matter. If the parties intend to contract for future inventions, language plainly expressing such a purpose must be used.<sup>73</sup> An assignment of a patent with future improvements

Co., 108 Fed. 77; *Levy v. Dattlebaum*, 63 Fed. 992; *Aspinwall Mfg. Co. v. Gill*, 32 Fed. 697; *Clum v. Brewer*, 5 Fed. Cas. No. 2,900, 2 Curt. 506; *Dunham v. Indianapolis, etc., R. Co.*, 8 Fed. Cas. No. 4,151, 2 Ban. & A. 327, 7 Biss. 223; *May v. Chaffee*, 16 Fed. Cas. No. 9,332, 2 Dill. 385, 5 Fish. Pat. Cas. 160. See also *Paulus v. M. M. Buck Mfg. Co.*, 129 Fed. 594, 64 C. C. A. 162. *Contra*, *Pitts v. Hall*, 19 Fed. Cas. No. 11,193, 3 Blatchf. 201. One of two complainants cannot pending suit make an assignment to or license defendant and thus defeat suit. *Lalance, etc., Mfg. Co. v. Haberman Mfg. Co.*, 93 Fed. 197, 107 Fed. 487.

**English practice.**— Either joint owner may use and must account only for royalties received. *Stears v. Rogers*, [1892] 2 Ch. 13, 61 L. J. Ch. 676, 66 L. T. Rep. N. S. 502 [affirmed in [1893] A. C. 232, 62 L. J. Ch. 671, 68 L. T. Rep. N. S. 726, 1 Reports 173]; *Mathers v. Green*, L. R. 1 Ch. 29, 11 Jur. N. S. 845, 35 L. J. Ch. 1, 13 L. T. Rep. N. S. 420, 5 New Rep. 358, 14 Wkly. Rep. 17; *Hancock v. Bewley, Johns*, 601, 70 Eng. Reprint 559; *Lovell v. Hicks*, 6 L. J. Exch. 85, 2 Y. & C. Exch. 481; *Heyl-Dia v. Edmunds*, 81 L. T. Rep. N. S. 579, 48 Wkly. Rep. 167. Joint owners are partners. *Lovell v. Hicks*, 6 L. J. Exch. 85, 2 Y. & C. Exch. 481. See *Lovell v. Hicks*, 5 L. J. Exch. 101, 2 Y. & C. Exch. 46.

**65.** *Herring v. Gas Consumers' Assoc.*, 9 Fed. 556, 3 McCrary 206.

**66.** *Lalance, etc., Mfg. Co. v. National Enameling, etc., Co.*, 108 Fed. 77; *Pusey, etc., Co. v. Miller*, 61 Fed. 401.

**67.** *Vose v. Singer*, 4 Allen (Mass.) 226, 81 Am. Dec. 696; *De Witt v. Elmira Nobles Mfg. Co.*, 5 Hun (N. Y.) 301 [affirmed in 66 N. Y. 459, 23 Am. Rep. 731]; *Blackledge v. Weir, etc., Mfg. Co.*, 108 Fed. 71, 47 C. C. A. 212. But see *Pusey, etc., Co. v. Miller*, 61 Fed. 401; *Curran v. Burdsall*, 20 Fed. 835; *Herring v. Gas Consumers' Assoc.*, 9 Fed. 556, 3 McCrary 206.

**68.** *Lalance, etc., Mfg. Co. v. National Enameling, etc., Co.*, 108 Fed. 77.

**69.** Assignment of invention or right to patent see *infra*, XI, A, 2, b.

**70.** *Birkery Mfg. Co. v. Jones*, 71 Conn. 113, 40 Atl. 917; *Bates Mach. Co. v. Bates*, 192 Ill. 138, 61 N. E. 518; *Wheeler v. Fishell*, 32 Ill. App. 343; *Macon Knitting Co. v. Leicester Mills Co.*, 65 N. J. Eq. 138, 55 Atl. 401; *Thourot v. Holub*, 81 N. Y. App. Div. 634, 80 N. Y. Suppl. 1083; *Kennedy v. Hazelton*, 128 U. S. 667, 9 S. Ct. 202, 32 L. ed. 576; *Ball, etc., Fastener Co. v. Patent Button Co.*, 136 Fed. 272; *Day v. Candee*, 7 Fed. Cas. No. 3,676, 3 Fish. Pat. Cas. 9; *Pitts v. Hall*, 19 Fed. Cas. No. 11,193, 3 Blatchf. 201; *Hill v. Mount*, 18 C. B. 72, 25 L. J. C. P. 190, 4 Wkly. Rep. 563, 86 E. C. L. 72; *National Soc., etc. v. Gibbs*, [1900] 2 Ch. 280, 69 L. J. Ch. 457, 82 L. T. Rep. N. S. 443, 48 Wkly. Rep. 499.

An agreement by an employee to assign improvements to his employer is binding. *Hulse v. Bonsack Mach. Co.*, 65 Fed. 864, 13 C. C. A. 180.

**71.** *Whitney v. Burr*, 115 Ill. 289, 3 N. E. 434; *Searle v. Hill*, 73 Iowa 367, 35 N. W. 490, 5 Am. St. Rep. 688; *Spears v. Willis*, 151 N. Y. 443, 43 N. E. 849; *Jones v. Reynolds*, 120 N. Y. 213, 24 N. E. 279; *Blakeney v. Goode*, 30 Ohio St. 350; *Dalzell v. Dueber Watch-Case Mfg. Co.*, 149 U. S. 315, 13 S. Ct. 886, 37 L. ed. 749; *Pressed Steel Car Co. v. Hansen*, 128 Fed. 444 [affirmed in 137 Fed. 403, 71 C. C. A. 207, 2 L. R. A. N. S. 1172]; *Cook v. Sterling Electric Co.*, 118 Fed. 45; *Dalglish v. Conboy*, 26 U. C. C. P. 254.

**72.** *Wheeler v. Fishell*, 32 Ill. App. 343; *Watson v. Deeds*, 3 Ind. App. 75, 29 N. E. 151; *Kennedy v. Hazelton*, 128 U. S. 667, 9 S. Ct. 202, 32 L. ed. 576; *Hammond v. Mason, etc., Organ Co.*, 92 U. S. 724, 23 L. ed. 767; *Cowles Electric Smelting, etc., Co. v. Lowrey*, 79 Fed. 331, 24 C. C. A. 616; *Brush Electric Co. v. California Electric Light Co.*, 52 Fed. 945, 3 C. C. A. 368; *Kelly v. Porter*, 17 Fed. 519, 8 Sawy. 482; *Clum v. Brewer*, 5 Fed. Cas. No. 2,909, 2 Curt. 509; *Herbert v. Adams*, 12 Fed. Cas. No. 6,394, 4 Mason 15, 1 Robb Pat. Cas. 505.

**73.** *Burton v. Burton Stock-Car Co.*, 171 Mass. 437, 50 N. E. 1029; *Jones v. Reynolds*, 120 N. Y. 213, 24 N. E. 279; *Tabor v. Hoffman*, 118 N. Y. 30, 23 N. E. 12, 16 Am. St.



passes only improvements on the particular machine secured by the patent and not unrelated inventions.<sup>74</sup> An agreement to assign all future inventions cannot be enforced.<sup>75</sup> An instrument of transfer identifying the invention and requesting the commissioner of patents to issue the patent to the assignee therein operates as an absolute assignment.<sup>76</sup> If the assignment contains no request that the patent issue in the name of the assignee, his title is equitable merely.<sup>77</sup>

**c. Recording.** The law does not require that agreements to assign patents be recorded, and therefore their record is not constructive notice.<sup>78</sup>

**d. Actions.** An agreement to assign may be enforced by suit in equity to compel specific performance,<sup>79</sup> and if the patentee has parted with title and is unable to carry out his contract damages may be recovered.<sup>80</sup>

Rep. 740; *Palmer v. De Witt*, 47 N. Y. 532, 7 Am. Rep. 480; *Nilsson v. De Haven*, 47 N. Y. App. Div. 537, 62 N. Y. Suppl. 506; *Maurice v. Devoil*, 23 W. Va. 247; *Gill v. U. S.*, 160 U. S. 426, 16 S. Ct. 322, 40 L. ed. 480; *Dalzell v. Dueber Watch-Case Mfg. Co.*, 149 U. S. 315, 13 S. Ct. 886, 37 L. ed. 749; *De la Vergne Refrigerating Mach. Co. v. Featherston*, 147 U. S. 219, 13 S. Ct. 283, 37 L. ed. 138; *Solomons v. U. S.*, 137 U. S. 342, 11 S. Ct. 88, 34 L. ed. 667; *Ambler v. Whipple*, 20 Wall. (U. S.) 546, 22 L. ed. 403; *Philadelphia, etc., R. Co. v. Trimble*, 10 Wall. (U. S.) 367, 19 L. ed. 948; *Gayler v. Wilder*, 10 How. (U. S.) 477, 13 L. ed. 504; *McClurg v. Kingsland*, 1 How. (U. S.) 202, 11 L. ed. 102; *Wheaton v. Peters*, 8 Pet. (U. S.) 591, 8 L. ed. 1055; *Shaw v. Cooper*, 7 Pet. (U. S.) 292, 8 L. ed. 689; *Reece Folding Mach. Co. v. Fenwick*, 140 Fed. 287, 72 C. C. A. 39, 2 L. R. A. N. S. 1094; *Regan Vapor-Engine Co. v. Pacific Gas-Engine Co.*, 49 Fed. 68, 1 C. C. A. 169; *Emmons v. Sladdin*, 8 Fed. Cas. No. 4,470, 2 Ban. & A. 199, 9 Off. Gaz. 352; *Maxim Nordenfellt Guns, etc., Co. v. Nordenfellt*, [1893] 1 Ch. 630, 62 L. J. Ch. 273, 68 L. T. Rep. N. S. 833, 41 Wkly. Rep. 604; *Bewley v. Hancock*, 6 De G. M. & G. 391, 2 Jur. N. S. 289, 4 Wkly. Rep. 334, 55 Eng. Ch. 305, 43 Eng. Reprint 1285; *Knowles v. Bovill*, 22 L. T. Rep. N. S. 70; *Watson v. Harris*, 31 Ont. 134. See *Davis, etc., Temperature Controlling Co. v. Tagliabue*, 159 Fed. 712.

It is an executory contract and not an actual transfer. *Regan Vapor-Engine Co. v. Pacific Gas-Engine Co.*, 49 Fed. 68, 1 C. C. A. 169.

**Agreement not contrary to public policy** see *Printing, etc., Co. v. Sampson*, L. R. 19 Eq. 462, 32 L. T. Rep. N. S. 354, 23 Wkly. Rep. 463, 44 L. J. Ch. 705.

**Refusal of one party to carry out the agreement** releases the other from all liability thereunder. *Buck v. Timony*, 79 Fed. 487 [affirmed in 84 Fed. 887, 28 C. C. A. 561].

**A contract for the sale of improvements** includes only those already made unless the contrary is expressed. *Adams v. Turner*, 73 Conn. 38, 46 Atl. 247; *Lamson v. Martin*, 159 Mass. 557, 35 N. E. 78.

**74. Bates Mach. Co. v. Bates**, 192 Ill. 138 61 N. E. 518; *McFarland v. Stanton Mfg. Co.*, 53 N. J. Eq. 649, 33 Atl. 962, 51 Am. St. Rep. 647 [affirming (Ch. 1895) 30 Atl. 1058]; *Allison v. Allison*, 144 N. Y. 21, 38 N. E.

956; *May v. Page*, 60 N. Y. 628; *Bessemer Steel Co. v. Reese*, 122 Pa. St. 392, 15 Atl. 807; *Frick Co. v. Geiser Mfg. Co.*, 100 Fed. 94, 40 C. C. A. 291; *Independent Electric Co. v. Jeffrey*, 76 Fed. 981; *Regan Vapor-Engine Co. v. Pacific Gas-Engine Co.*, 49 Fed. 68, 1 C. C. A. 169; *Aspinwall v. Gill*, 32 Fed. 697 [affirmed in 140 U. S. 669, 11 S. Ct. 1015, 35 L. ed. 597]; *Bunker v. Stevens*, 26 Fed. 245; *Nesmith v. Calvert*, 18 Fed. Cas. No. 10,123, 2 Robb Pat. Cas. 311, 1 Woodb. & M. 34; *Watson v. Harris*, 31 Ont. 134.

**The contract will not be enforced where the invention as patented is different.**—*Bingham v. McMurray*, 30 Can. Sup. Ct. 159.

**75. Bates Mach. Co. v. Bates**, 87 Ill. App. 225 [affirmed in 192 Ill. 138, 61 N. E. 518].

**76. Harrison v. Morton**, 83 Md. 456, 35 Atl. 99; *Johnson v. Wilcox, etc., Sewing Mach. Co.*, 27 Fed. 689, 23 Blatchf. 531; *Wright v. Randel*, 8 Fed. 591, 19 Blatchf. 495; *Gay v. Cornell*, 10 Fed. Cas. No. 5,280, 1 Blatchf. 506, Fish. Pat. Rep. 312; *Rathbone v. Orr*, 20 Fed. Cas. No. 11,585, Fish. Pat. Rep. 355, 5 McLean 131.

**Assignment of provisional protection** gives an equitable title only. *E. M. Powden's Patents Syndicate v. Smith*, [1904] 2 Ch. 86, 73 L. J. Ch. 522, 52 Wkly. Rep. 630.

**77. Harrison v. Morton**, 83 Md. 456, 35 Atl. 99; *Wright v. Randel*, 8 Fed. 591, 19 Blatchf. 495.

**Title vests in the assignee, although patent issues in the name of assignor.**—*Consolidated Electric Light Co. v. Edison Electric Light Co.*, 25 Fed. 719, 23 Blatchf. 412; *U. S. Stamping Co. v. Jewett*, 7 Fed. 869, 18 Blatchf. 469.

**78. English practice.**—Equitable assignment may be recorded but statute refers only to legal transfers. *In re Casey*, [1892] 1 Ch. 104, 61 L. J. Ch. 61, 66 L. T. Rep. N. S. 93, 40 Wkly. Rep. 180 [affirming 65 L. T. Rep. N. S. 40].

**79. See supra, XI, A, 2, a.** See also *Macon Knitting Co. v. Leicester Mills Co.*, 65 N. J. Eq. 138, 55 Atl. 401; *Thourot v. Holub*, 80 N. Y. Suppl. 1083; *Cogent v. Gibson*, 33 Beav. 557, 55 Eng. Reprint 485; *Powell v. Peck*, 11 Can. Sup. Ct. 494 [affirming 8 Ont. App. 498, and reversing 26 Grant Ch. (U. C.) 322]; *Dalglish v. Conboy*, 26 U. C. C. P. 254.

**80. See infra, XI, B, 5, d, (II), (B).** See also *Barret v. Verdery*, 93 Ga. 526, 21 S. E.



**3. REQUISITES AND VALIDITY — a. In General.** The monopoly granted by the patent laws is one entire thing, and cannot be divided into parts except as authorized by law.<sup>81</sup> A patentee or his assigns may by instrument in writing assign, grant, and convey, either: (1) The whole patent, comprising the exclusive right to make, use, and vend the invention throughout the United States; or (2) an undivided part or share of that exclusive right; or (3) the exclusive right under the patent within and throughout a specified part of the United States.<sup>82</sup> A transfer of either of these three kinds of interests is an assignment, properly speaking, and vests in the assignee a title in so much of the patent itself.<sup>83</sup> Any assignment or transfer short of one of these is a mere license giving the licensee no title in the patent.<sup>84</sup> Whether a transfer of a particular right or interest under a patent is an assignment or a license does not depend upon the name by which it calls itself, but upon the legal effect of its provisions.<sup>85</sup> Such an assignment may be either absolute, or by way of mortgage, and liable to be defeated by non-performance of a condition subsequent.<sup>86</sup>

**b. Form and Contents.** The assignment of a patent must be an assignment in writing signed by the patentee, his assigns or legal representatives,<sup>87</sup> and like

64; *Lord v. Owen*, 35 Ill. App. 382; *Ft. Wayne, etc., R. Co. v. Haberkorn*, 15 Ind. App. 479, 44 N. E. 322; *Kirschmann v. Lediard*, 61 Barb. (N. Y.) 573.

81. *Pope Mfg. Co. v. Gormully, etc., Mfg. Co.*, 144 U. S. 238, 12 S. Ct. 637, 36 L. ed. 419; *Waterman v. MacKenzie*, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923.

The subject-matter of a patent is not partible except in respect to territorial assignment. *Suydam v. Day*, 23 Fed. Cas. No. 13,654, 2 Blatchf. 20, Fish. Pat. Rep. 88.

In England part of a patent may be assigned and the assignee may sue as to that part. *Walton v. Lavater*, 8 C. B. N. S. 162, 6 Jur. N. S. 1251, 29 L. J. C. P. 275, 2 L. T. Rep. N. S. 272, 98 E. C. L. 162; *Dunnicliff v. Mallet*, 7 C. B. N. S. 209, 6 Jur. N. S. 252, 29 L. J. C. P. 70, 1 L. T. Rep. N. S. 514, 8 Wkly. Rep. 260, 97 E. C. L. 209.

82. U. S. Rev. St. (1878) § 4898. See also *Waterman v. MacKenzie*, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923; *Paulus v. M. M. Buck Mfg. Co.*, 129 Fed. 594, 64 C. C. A. 162; *Parker v. Haworth*, 18 Fed. Cas. No. 10,738, 2 Robb Pat. Cas. 725, 4 McLean 370; *Potter v. Holland*, 19 Fed. Cas. No. 11,329, 4 Blatchf. 206, 1 Fish. Pat. Cas. 327.

83. *Waterman v. MacKenzie*, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923.

84. U. S. Rev. St. (1878) § 4919 [U. S. Comp. St. (1901) p. 3394].

Reservation of part of the right in the territory referred to makes the instrument a license, and not an assignment. *Tuttle v. La Dow*, 54 Hun (N. Y.) 149, 7 N. Y. Suppl. 277; *Waterman v. MacKenzie*, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923; *Goodyear v. Day*, 10 Fed. Cas. No. 5,566; *Hatfield v. Smith*, C. D. 1891, 330; *Rice v. Boss*, C. D. 1891, 400; C. D. 1891, 457. See also *infra*, XI, B, 1, a.

85. *Waterman v. MacKenzie*, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923.

Assignment and license defined and distinguished.—*Dalzell v. Dueber Watch-Case Mfg. Co.*, 149 U. S. 315, 13 S. Ct. 886, 37 L. ed. 749; *St. Paul Plow-Works v. Starling*, 140

U. S. 184, 11 S. Ct. 803, 35 L. ed. 404; *Salomons v. U. S.*, 137 U. S. 342, 11 S. Ct. 88, 34 L. ed. 667; *Laver v. Dennett*, 109 U. S. 90, 3 S. Ct. 73, 27 L. ed. 867; *Oliver v. Rumford Chemical Works*, 109 U. S. 75, 3 S. Ct. 61, 27 L. ed. 862; *Hayward v. Andrews*, 108 U. S. 672, 1 S. Ct. 544, 27 L. ed. 271; *Burdell v. Denig*, 92 U. S. 716, 23 L. ed. 764; *Littlefield v. Perry*, 21 Wall. (U. S.) 205, 22 L. ed. 577; *Adams v. Burks*, 17 Wall. (U. S.) 453, 21 L. ed. 700; *Nicholson Pavement Co. v. Jenkins*, 14 Wall. (U. S.) 452, 20 L. ed. 777; *Heaton Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288, 25 C. C. A. 267, 78 Off. Gaz. 171, 35 L. R. A. 267; *Anderson v. Eiler*, 50 Fed. 775, 1 C. C. A. 659.

Reservation of mill right will not prevent legal transfer. *Russell v. Kern*, 58 Fed. 382.

Reservation of right to manufacture does not prevent transfer. *Hamilton v. Kingsbury*, 11 Fed. Cas. No. 5,984, 2 Ban. & A. 346, 15 Blatchf. 64, 14 Off. Gaz. 448.

86. U. S. Rev. St. (1878) § 4898.

Mortgage constitutes transfer of legal title.—*Waterman v. MacKenzie*, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923; *Casey v. Cavaroc*, 96 U. S. 467, 24 L. ed. 779; *Moore v. Marsh*, 7 Wall. (U. S.) 515, 19 L. ed. 37; *Gayler v. Wilder*, 10 How. (U. S.) 477, 13 L. ed. 504; *Conard v. Atlantic Ins. Co.*, 1 Pet. (U. S.) 386, 7 L. ed. 189; *Waterman v. Shipman*, 55 Fed. 982, 5 C. C. A. 371; *Paper Bag Cases*, C. D. 1882, 197; *Littlefield v. Perry*, 7 Off. Gaz. 964.

An assignment in trust carries the legal title. *Campbell v. James*, 4 Fed. Cas. No. 2,361, 4 Ban. & A. 456, 17 Blatchf. 42, 18 Off. Gaz. 979.

87. U. S. Rev. St. (1878) § 4898. See also *Jewett v. Atwood Suspender Co.*, 100 Fed. 647; *Baldwin v. Sibley*, 2 Fed. Cas. No. 805, 1 Cliff. 150; *Newton v. Buck*, 75 Off. Gaz. 673; *Duvergier v. Fellows*, 10 B. & C. 826, 8 L. J. K. B. O. S. 270, 2 M. & P. 384, 21 E. C. L. 346 [affirmed in 1 Cl. & F. 39, 6 Eng. Reprint 831]; *Dalgleish v. Conboy*, 26 U. C. C. P. 254.



any deed must be free from ambiguity;<sup>88</sup> but no particular form of written instrument is required.<sup>89</sup> An instrument worded as a mere license may, on account of the actual interest conveyed, amount to an assignment.<sup>90</sup>

**c. Validity.** The validity of an assignment of a patent is determined by the same considerations as apply to other deeds and contracts.<sup>91</sup>

**4. RECORDING**<sup>92</sup>—**a. In General.** By statute, an assignment, grant, or conveyance must be recorded in the patent office within three months, or it will be void as against any subsequent purchaser without notice.<sup>93</sup> Within that period, the

Consent in writing to transfer by another is valid. *Sherman v. Champlain Transp. Co.*, 31 Vt. 162.

**88.** *Dudley v. Suddoth*, 91 Ala. 349, 8 So. 873; *Hill v. Thuermer*, 13 Ind. 351; *Harmon v. Bird*, 22 Wend. (N. Y.) 113; *Washburn, etc.*, Mfg. Co. v. Haish, 4 Fed. 900, 10 Biss. 65; *Clark v. Scott*, 5 Fed. Cas. No. 2,833, 9 Blatchf. 301, 5 Fish. Pat. Cas. 245, 2 Off. Gaz. 4; *United Nickel Co. v. American Nickel-Plating Works*, 24 Fed. Cas. No. 14,405, 4 Ban. & A. 74.

Mistake in name of the invention transferred is not vital. *Holden v. Curtis*, 2 N. H. 61; *Case v. Morey*, 1 N. H. 347.

Designation of assignee by last name only is sufficient where his identity is certain. *Fisk v. Hollander, MacArthur & M.* (D. C.) 355.

Assignment to a person named "et al." is valid. *Bliss v. Reed*, 102 Fed. 903 [affirmed in 106 Fed. 314, 45 C. C. A. 304].

**89.** *Canda v. Michigan Malleable Iron Co.*, 123 Fed. 95 [modified in 124 Fed. 436]; *D. M. Seehler Carriage Co. v. Deere, etc., Co.*, 113 Fed. 285, 51 C. C. A. 242; *Piaget Novelty Co. v. Headley*, 107 Fed. 134 [affirmed in 103 Fed. 870, 48 C. C. A. 116]; *Jonathan Mills Mfg. Co. v. Whitehurst*, 56 Fed. 589; *Regan Vapor-Engine Co. v. Pacific Gas-Engine Co.*, 49 Fed. 68, 1 C. C. A. 169; *Lowry v. Cowles Electric Co.*, C. D. 1893, 549.

A general transfer of property carries patents. *Philadelphia, etc., R. Co. v. Trimble*, 10 Wall. (U. S.) 367, 19 L. ed. 948; *Shelby Steel Tube Co. v. Delaware Seamless Tube Co.*, 151 Fed. 64 [affirmed in 160 Fed. 928]; *Schaum v. Baker*, 21 Fed. Cas. No. 12,440.

**90.** *Douglass v. Campbell*, 24 Ohio Cir. Ct. 241; *Union Switch, etc., Co. v. Johnson R. Signal Co.*, 61 Fed. 940, 10 C. C. A. 176 [reversing 59 Fed. 20]; *Ritter v. Serrell*, 20 Fed. Cas. No. 11,866, 2 Blatchf. 379; *Lowry v. Cowles Electric Co.*, C. D. 1893, 549; *Rapp v. Killing*, C. D. 1890, 483.

**91.** *Nicholson Pavement Co. v. Jenkins*, 14 Wall. (U. S.) 452, 20 L. ed. 777; *Kansas City Hay-Press Co. v. Devol*, 72 Fed. 717 [reversed on other grounds in 81 Fed. 726, 26 C. C. A. 578]; *National Folding Box, etc., Co. v. American Paper Pail, etc., Co.*, 55 Fed. 488; *Gibson v. Cook*, 10 Fed. Cas. No. 5,393, 2 Blatchf. 144, Fish. Pat. Rep. 415.

Lack of consideration invalidates the assignment of a patent. *Cowles v. Rochester Folding Box Co.*, 81 N. Y. App. Div. 414, 80 N. Y. Suppl. 811 [affirmed in 179 N. Y. 87, 71 N. E. 468].

An assignment by a person of unsound mind is void. *Colburn v. Van Velzer*, 11 Fed. 795, 3 McCrary 650.

Assignment void for fraud see *Goldsmith v. Koopman*, 140 Fed. 618.

**Misrepresentations.**—Misrepresentations by a vendor of a patent right entitle the vendee to rescind where they amount to an untrue statement of some present fact (*Bell v. Felt*, 102 Ill. App. 218; *Lederer v. Yule*, 67 N. J. Eq. 65, 57 Atl. 309; *Lindsay v. Roraback*, 57 N. C. 124; *Hull v. Fields*, 76 Va. 594); but a mere promise or prediction is not sufficient (*Lederer v. Yule, supra*), and misrepresentations amounting to mere "trade talk" will not vitiate a sale (*Des Moines Ins. Co. v. McIntire*, 99 Iowa 50, 68 N. W. 563).

Where the whole transaction is founded upon a mistake of fact, the sale is void. *Burrall v. Jewett*, 2 Paige (N. Y.) 134.

**92.** Agreement for assignment see *supra*, XI, A, 2, c.

Assignment of license see *infra*, XI, B, 1, f.

Record as evidence see *infra*, XIII, C, 14, h.

**93.** U. S. Rev. St. (1878) § 4898.

Purchaser may rely on record see *Gates Iron Works v. Fraser*, 153 U. S. 332, 14 S. Ct. 883, 38 L. ed. 734; *Paulus v. M. M. Buck Mfg. Co.*, 129 Fed. 594, 64 C. C. A. 162; *Secombe v. Campbell*, 2 Fed. 357, 18 Blatchf. 108; *Campbell v. James*, 2 Fed. 338, 18 Blatchf. 92; *Boyd v. McAlpin*, 3 Fed. Cas. No. 1,748, 3 McLean 427, 2 Robb Pat. Cas. 277; *Newell v. West*, 18 Fed. Cas. No. 10,150, 2 Ban. & A. 113, 13 Blatchf. 114, 9 Off. Gaz. 1110, 8 Off. Gaz. 598.

Record within three months fixes title see *Aspinwall Mfg. Co. v. Gill*, 32 Fed. 697 [affirmed in 140 U. S. 669, 11 S. Ct. 1015, 35 L. ed. 597].

**English practice.**—Assignee cannot sue until the deed is recorded. *Chollet v. Hoffman*, 7 E. & B. 686, 3 Jur. N. S. 935, 26 L. J. Q. B. 249, 5 Wkly. Rep. 573, 90 E. C. L. 686. Assignment is good against the assignor, although not recorded. *Hassall v. Wright*, L. R. 10 Eq. 509, 40 L. J. Ch. 145, 18 Wkly. Rep. 821. Purchaser with notice has no equity. *New Ixion Tyre, etc., Co. v. Spilsbury*, [1898] 2 Ch. 484, 67 L. J. Ch. 557, 79 L. T. Rep. N. S. 229 [affirming [1898] 2 Ch. 137, 67 L. J. Ch. 424, 78 L. T. Rep. N. S. 543, 46 Wkly. Rep. 567].

Estoppel to allege failure to record see *Hassall v. Wright*, L. R. 10 Eq. 509, 40 L. J. Ch. 145, 18 Wkly. Rep. 821. High court of justice has jurisdiction over register and may expunge or order correction. *In re Horsley*,



three months, an unrecorded prior assignment will prevail.<sup>94</sup> This statute is merely directory for the protection of *bona fide* purchasers without notice, and does not require the recording of an assignment within three months as a prerequisite to its validity.<sup>95</sup> Hence, as between the parties and as against everyone except a subsequent purchaser without notice, an unrecorded assignment is good.<sup>96</sup> The assignment of a patent not yet issued need not be recorded.<sup>97</sup> Nor is it necessary that an assignment of a patent by a bankruptcy court to the assignee of the owner of the patent be recorded.<sup>98</sup>

**b. Notice.** An unrecorded written assignment is good against a subsequent purchaser having actual or constructive notice of it.<sup>99</sup>

**c. Acknowledgment Before Notary.** If the assignment is acknowledged before a notary public or certain other officers, the certificate of the notary or other officer is *prima facie* evidence of execution.<sup>1</sup> The acknowledgment of an assignment of a patent relates to the date of the assignment.<sup>2</sup>

**5. CONSTRUCTION AND OPERATION — a. In General.** Assignments and grants of patent rights are subject to the same rules of construction as other contracts.<sup>3</sup>

L. R. 8 Eq. 475, 39 L. J. Ch. 157, 21 L. T. Rep. N. S. 345, 17 Wkly. Rep. 1054; *In re* Morey, 25 Beav. 581, 6 Wkly. Rep. 612, 53 Eng. Reprint 759; *In re* Morgan, 24 Wkly. Rep. 245. Master of rolls may expunge entry wrongfully made. *Re* Green, 24 Beav. 145, 53 Eng. Reprint 312; *In re* Horsley, L. R. 4 Ch. 784, 17 Wkly. Rep. 1000.

**Canadian practice.**—Assignment is good between parties without record, but not against subsequent purchasers. *Doyon v. Canadian Fire Extinguishing Co.*, 14 Quebec Super. Ct. 367.

94. *Gibson v. Cook*, 10 Fed. Cas. No. 5,393, 2 Blatchf. 144, Fish. Pat. Rep. 415.

95. *Winfrey v. Gallatin*, 72 Mo. App. 191; *Pitts v. Whitman*, 19 Fed. Cas. No. 11,196, 2 Robb Pat. Cas. 189, 2 Story 609.

96. *Black v. Stone*, 33 Ala. 327; *Peck v. Bacon*, 18 Conn. 377; *Hildreth v. Turner*, 17 Ill. 184; *McKernan v. Hite*, 6 Ind. 428; *Moore v. Bare*, 11 Iowa 198; *Sone v. Palmer*, 28 Mo. 539; *Holden v. Curtis*, 2 N. H. 61; *Horne v. Chatham*, 64 Tex. 36; *Maurice v. Devol*, 23 W. Va. 247; *Shelby Steel Tube Co. v. Delaware Seamless Tube Co.*, 151 Fed. 64; *Boyd v. McAlpin*, 3 Fed. Cas. No. 1,748, 3 McLean 427, 2 Robb Pat. Cas. 277; *Case v. Redfield*, 5 Fed. Cas. No. 2,494, 4 McLean 526, 2 Robb Pat. Cas. 741; *Hall v. Speer*, 11 Fed. Cas. No. 5,947, 1 Pittsb. (Pa.) 513; *Pitts v. Whitman*, 19 Fed. Cas. No. 11,196, 2 Robb Pat. Cas. 189, 2 Story 609; *Turnbull v. Weir Plow Co.*, 24 Fed. Cas. No. 14,244, 1 Ban. & A. 544, 6 Biss. 225, 7 Off. Gaz. 173; *Van Hook v. Wood*, 28 Fed. Cas. No. 16,854.

**Purchaser without consideration.**—An unrecorded assignment is good against a later assignment without consideration. *Saxton v. Aultman*, 15 Ohio St. 471.

97. *Wright v. Randel*, 8 Fed. 591, 19 Blatchf. 495.

98. *Prime v. Brandon Mfg. Co.*, 19 Fed. Cas. No. 11,421, 4 Ban. & A. 379, 16 Blatchf. 453.

99. *Coleman v. Ryan*, 33 Misc. (N. Y.) 715, 68 N. Y. Suppl. 253; *Hapgood v. Rosenstock*, 23 Fed. 86, 23 Blatchf. 95; *Dare v. Boylston*, 6 Fed. 493, 18 Blatchf. 548; *Ashcroft v. Wal-*

worth, 2 Fed. Cas. No. 580, 5 Fish. Pat. Cas. 528, Holmes 152, 2 Off. Gaz. 546; *Continental Windmill Co. v. Empire Windmill Co.*, 6 Fed. Cas. No. 3,142, 8 Blatchf. 295, 4 Fish. Pat. Cas. 428; *Valentine v. Marshal*, 28 Fed. Cas. No. 16,812a.

**Knowledge of facts sufficient to put a party on inquiry will bind him as notice.** *Stanton Mfg. Co. v. McFarland*, (N. J. Ch. 1895) 30 Atl. 1058 [affirmed in 53 N. J. Eq. 649, 33 Atl. 962, 51 Am. St. Rep. 647]; *Auburn Button Co. v. Sylvester*, 72 Hun (N. Y.) 498, 25 N. Y. Suppl. 237 [affirmed in 147 N. Y. 714, 42 N. E. 721]; *Jonathan Mills Mfg. Co. v. Whitehurst*, 72 Fed. 496, 19 C. C. A. 130; *National Heeling-Mach. Co. v. Abbott*, 70 Fed. 54; *Waterman v. Shipman*, 55 Fed. 982, 5 C. C. A. 371; *Kearney v. Lehigh Valley R. Co.*, 27 Fed. 699; *Hamilton v. Kingsbury*, 4 Fed. 428, 17 Blatchf. 460; *Prime v. Brandon Mfg. Co.*, 19 Fed. Cas. No. 11,421, 4 Ban. & A. 379, 16 Blatchf. 453.

**Notice held insufficient** see *Regan Vapor-Engine Co. v. Pacific Gas-Engine Co.*, 49 Fed. 68, 1 C. C. A. 169.

**A purchaser with notice holds in trust for the first assignee.** *Whitney v. Burr*, 115 Ill. 289, 3 N. E. 434; *Pontiac Knit Boot Co. v. Merino Shoe Co.*, 31 Fed. 286.

1. Act March 3, 1897, 29 U. S. St. at L. 693. Act applies to instruments executed before its passage.—*Lanyon Zinc Co. v. Brown*, 115 Fed. 150, 53 C. C. A. 354; *De Laval Separator Co. v. Vermont Farm-Mach. Co.*, 109 Fed. 813.

**The signature of the assignor need not be proved where the assignment is duly acknowledged before a notary.** *New York Pharmaceutical Assoc. v. Tilden*, 14 Fed. 740, 21 Blatchf. 190. Conversely, it is not essential to the validity of an assignment of a patent that it should be acknowledged, where the genuineness of the assignor's signature is proved. *Clancy v. Troy Belting, etc., Co.*, 152 Fed. 188 [reversed on other grounds in 157 Fed. 554].

2. *Murray Co. v. Continental Gin Co.*, 149 Fed. 989, 79 C. C. A. 499.

3. **Intent rather than technical form controls.**—See *Cowles Electric Smelting, etc., Co.*



**b. Warranty.** The assignment of a patent creates an implied warranty of title in the assignor,<sup>4</sup> but no warranty that the patent is valid,<sup>5</sup> or that the invention does not infringe prior patents.<sup>6</sup>

**c. Rights and Interests Conveyed**—(1) *IN GENERAL.* Within the limits of the grant the assignee has the same rights as were formerly possessed by the patentee.<sup>7</sup> An assignment of all the grantor's right, title, and interest in and to a certain patent carries only the existing interest of the grantor at the term of the assignment.<sup>8</sup> Words restricting the grant to such patents as the grantor "holds in his own right" do not exclude patents of which his tenure is not exclusive.<sup>9</sup> An assignment of an invention as described in the specifications filed covers all the devices claimed therein to be patentable, and not merely such as are covered by the patent as ultimately issued.<sup>10</sup> But an assignment of all right, title, and interest in an improvement of a machine already patented conveys no interest in the original patent.<sup>11</sup> An assignee may bring suit in his own name and may transfer the whole or a part of his interest.<sup>12</sup>

*v. Lowrey*, 79 Fed. 331, 24 C. C. A. 616; *Kearney v. Lehigh Valley R. Co.*, 27 Fed. 699.

Contemporaneous instruments referring to same matter construed together see *Hammond v. Mason, etc.*, *Organ Co.*, 92 U. S. 724, 23 L. ed. 767; *Levy v. Dattlebaum*, 63 Fed. 992; *Regan Vapor-Engine Co. v. Pacific Gas-Engine Co.*, 47 Fed. 511 [reversed on other grounds in 49 Fed. 68, 1 C. C. A. 169].

Particular contracts construed see *Standard Combustion Co. v. Farr*, 9 Ohio Dec. (Reprint) 509, 14 Cinc. L. Bul. 201; *Reese's Appeal*, 122 Pa. St. 392, 15 Atl. 807; *Geiser Mfg. Co. v. Frick Co.*, 92 Fed. 189; *Lowry v. Cowles Electric Smelting, etc., Co.*, 56 Fed. 488; *Adrian v. McCormick Harvesting Mach. Co.*, 55 Fed. 288 [affirmed in 56 Fed. 918, 6 C. C. A. 168]; *Siebert Cylinder Oil-Cup Co. v. Beggs*, 32 Fed. 790; *Buckley v. Sawyer Mfg. Co.*, 7 Fed. 358, 2 McCrary 350; *Emigh v. Chicago, etc., R. Co.*, 8 Fed. Cas. No. 4,448, 1 Biss. 400, 2 Fish. Pat. Cas. 387.

4. *Macon Knitting Co. v. Leicester Mills Co.*, 65 N. J. Eq. 138, 55 Atl. 401; *Herzog v. Heyman*, 8 Misc. (N. Y.) 27, 28 N. Y. Suppl. 74; *Carman v. Trude*, 25 How. Pr. (N. Y.) 440; *Faulks v. Kamp*, 3 Fed. 898, 17 Blatchf. 432.

Purchaser must investigate prior claims of which he has notice sufficient to put him on inquiry. *Chambers v. Smith*, 5 Fed. Cas. No. 2,582, 5 Fish. Pat. Cas. 12, 7 Phila. (Pa.) 575.

5. *Connecticut*.—*Bull v. Pratt*, 1 Conn. 342.

*Indiana*.—*Detrick v. McGlone*, 46 Ind. 291.

*Maine*.—*Elmer v. Pennel*, 40 Me. 430.

*Massachusetts*.—*Gilmore v. Aiken*, 118 Mass. 94.

*Michigan*.—*Brazel v. Smith*, 141 Mich. 628, 104 N. W. 1097.

*New Jersey*.—*Barelay v. Charles Roome Parmele Co.*, 70 N. J. Eq. 218, 61 Atl. 715; *Macon Knitting Co. v. Leicester Mills Co.*, 65 N. J. Eq. 138, 55 Atl. 401.

*New York*.—*Nilsson v. De Haven*, 47 N. Y. App. Div. 537, 62 N. Y. Suppl. 506 [affirmed in 168 N. Y. 656, 61 N. E. 1131]. But see *Herzog v. Heyman*, 151 N. Y. 587, 45 N. E. 1127, 56 Am. St. Rep. 646.

*United States*.—*Milligan v. Lalance, etc.*, Mfg. Co., 21 Fed. 570.

*England*.—*Otto v. Singer*, 62 L. T. Rep. N. S. 220.

6. *Rhodes v. Ashurst*, 176 Ill. 351, 52 N. E. 118; *Standard Button Fastening Co. v. Harney*, 155 Mass. 507, 29 N. E. 1148; *Horne v. Hoyle*, 27 Fed. 216.

An express warranty against infringement may be made. *Green v. Watson*, 10 Ont. App. 113 [affirming 2 Ont. 627].

7. U. S. Rev. St. (1878) §§ 4895, 4898 [U. S. Comp. St. (1901) p. 3385]. See also *Waterman v. Mackenzie*, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923; *Gayler v. Wilder*, 10 How. (U. S.) 477, 13 L. ed. 504; *Werderman v. Société Générale d'Electricité*, 19 Ch. D. 246, 45 L. T. Rep. N. S. 514, 30 Wkly. Rep. 33.

After assignment the assignor cannot make or sell the invention and he may be enjoined from so doing. *Bennett v. Wortman*, 2 Ont. L. Rep. 292.

8. *Waterman v. Shipman*, 130 N. Y. 301, 29 N. E. 111; *Regan Vapor-Engine Co. v. Pacific Gas-Engine Co.*, 47 Fed. 511 [reversed on other grounds in 49 Fed. 68, 1 C. C. A. 169]; *Turnbull v. Weir Plow Co.*, 14 Fed. 108, 9 Biss. 334; *Ashcroft v. Walworth*, 2 Fed. Cas. No. 580, 5 Fish. Pat. Cas. 528, *Holmes* 152, 2 Off. Gaz. 546; *Goodyear v. Cary*, 10 Fed. Cas. No. 5,562, 4 Blatchf. 271, 1 Fish. Pat. Cas. 424; *Turnbull v. Weir Plow Co.*, 24 Fed. Cas. No. 14,244, 1 Ban. & A. 544, 6 Biss. 225, 7 Off. Gaz. 173.

9. *Lowry v. Cowles Electric Smelting, etc., Co.*, 56 Fed. 488; *Wetherill v. Passaic Zinc Co.*, 29 Fed. Cas. No. 17,465, 6 Fish. Pat. Cas. 50, 2 Off. Gaz. 471, 9 Phila. (Pa.) 385.

10. *Puetz v. Bransford*, 31 Fed. 458.

11. *Leach v. Dresser*, 69 Me. 129.

12. U. S. Rev. St. (1878) § 4919 [U. S. Comp. St. (1901) p. 3394]; *Waterman v. Mackenzie*, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923; *Boesch v. Graff*, 133 U. S. 697, 10 S. Ct. 378, 33 L. ed. 787; *Rude v. Westcott*, 130 U. S. 152, 9 S. Ct. 463, 32 L. ed. 888; *D. M. Sechler Carriage Co. v. Deere, etc., Co.*, 113 Fed. 285, 51 C. C. A. 242; *Paine v. Trask*, 56 Fed. 233, 5 C. C. A. 497; *Cook v. Bidwell*, 8 Fed. 452.



(II) *RIGHTS IN EXTENDED TERM*.<sup>13</sup> The extent to which an assignee may enjoy the benefits of an extended term of a patent depends entirely upon the stipulations of the contract.<sup>14</sup> The operation of such an instrument is not limited to the term specified in the patent where the instrument contains apt words to show that the parties intended that its operation should be more comprehensive;<sup>15</sup> but in the absence of a specific provision to that effect an assignment of letters patent does not carry with it any interest in a subsequently extended term.<sup>16</sup> Where, however, the conveyance is of the invention, before the issue of letters patent therefor, the assignee is entitled, unless the instrument of assignment shows a different intention, to obtain a renewal at the expiration of the original term.<sup>17</sup>

(III) *RIGHTS IN REISSUE*. Where after assignment a patent is reissued the rights of the assignee are the same under a reissued patent as under the original.<sup>18</sup> But the assignee must consent to or ratify such reissue.<sup>19</sup>

(IV) *AFTER-ACQUIRED TITLE*. Where an instrument of transfer is made when the assignor has no title, an after-acquired title inures to the benefit of the assignee.<sup>20</sup>

(V) *RIGHTS OF ACTION FOR PAST INFRINGEMENT*. The assignee of a patent does not acquire a right of action for past infringement unless so specified in the assignment.<sup>21</sup> But when the assignment includes, expressly or impliedly, all

13. Rights of licensees see *infra*, XI, B, 1, c.

14. *Mitchell v. Hawley*, 16 Wall. (U. S.) 544, 21 L. ed. 322; *Adams v. Bridgewater Iron Co.*, 26 Fed. 324; *Fire Extinguisher Mfg. Co. v. Graham*, 16 Fed. 543; *Aiken v. Dolan*, 1 Fed. Cas. No. 110, 3 Fish. Pat. Cas. 197; *Chase v. Walker*, 5 Fed. Cas. No. 2,630, 3 Fish. Pat. Cas. 120; *Day v. Union India-Rubber Co.*, 7 Fed. Cas. No. 3,691, 3 Blatchf. 488 [affirmed in 20 How. 216, 15 L. ed. 883]; *Van Hook v. Wood*, 28 Fed. Cas. No. 16,855.

15. *Nicholson Pavement Co. v. Jenkins*, 14 Wall. (U. S.) 452, 20 L. ed. 777; *Philadelphia, etc., R. Co. v. Trimble*, 10 Wall. (U. S.) 367, 19 L. ed. 948; *Case v. Redfield*, 5 Fed. Cas. No. 2,494, 4 McLean 526, 2 Robb Pat. Cas. 741; *Chase v. Walker*, 5 Fed. Cas. No. 2,630, 3 Fish. Pat. Cas. 120; *Gear v. Grosvenor*, 10 Fed. Cas. No. 5,291, 6 Fish. Pat. Cas. 314, *Holmes* 215, 3 Off. Gaz. 380; *Gear v. Holmes*, 10 Fed. Cas. No. 5,292, 6 Fish. Pat. Cas. 595; *Goodyear v. Cary*, 10 Fed. Cas. No. 5,562, 4 Blatchf. 271, 1 Fish. Pat. Cas. 424; *Pitts v. Hall*, 19 Fed. Cas. No. 11,193, 3 Blatchf. 201; *Ruggles v. Eddy*, 20 Fed. Cas. No. 12,117, 10 Blatchf. 52, 5 Fish. Pat. Cas. 581; *Sayles v. Dubuque, etc., R. Co.*, 21 Fed. Cas. No. 12,417, 3 Ban. & A. 219, 5 Dill. 561; *Thayer v. Wales*, 23 Fed. Cas. No. 13,872, 5 Fish. Pat. Cas. 130; *Wilson v. Turner*, 30 Fed. Cas. No. 17,845, *Fish. Pat. Rep.* 28, *Taney* 278 [affirmed in 4 How. 712, 11 L. ed. 1171].

16. *Goodyear v. Day*, 6 Duer (N. Y.) 154; *Wilson v. Rousseau*, 4 How. (U. S.) 646, 11 L. ed. 1141; *Bloomer v. Stolley*, 3 Fed. Cas. No. 1,559, *Fish. Pat. Rep.* 376, 5 McLean 158; *Brooks v. Bicknell*, 4 Fed. Cas. No. 1,945, *Fish. Pat. Rep.* 65, 4 McLean 64; *Gear v. Grosvenor*, 10 Fed. Cas. No. 5,291, 6 Fish. Pat. Cas. 314, *Holmes* 215, 3 Off. Gaz. 380; *Gibson v. Cook*, 10 Fed. Cas. No. 5,393, 2 Blatchf. 144, *Fish. Pat. Rep.* 415; *Goodyear v. Hullihen*, 10 Fed. Cas. No. 5,573, 3 Fish.

*Pat. Cas.* 251, 2 *Hughes* 492; *Jenkins v. Nicolson Pavement Co.*, 13 Fed. Cas. No. 7,273, 1 Abb. 567, 4 *Fish. Pat. Cas.* 201 [reversed on other grounds in 14 Wall. 452, 20 L. ed. 777]; *Phelps v. Comstock*, 19 Fed. Cas. No. 11,075, *Fish. Pat. Rep.* 215, 4 McLean 353; *Waterman v. Wallace*, 29 Fed. Cas. No. 17,261, 2 Ban. & A. 126, 13 Blatchf. 128; *Woodworth v. Sherman*, 30 Fed. Cas. No. 18,019, 2 Robb Pat. Cas. 257, 3 *Story* 171.

No right to extension implied.—*Johnson v. Wilcox, etc., Sewing Mach. Co.*, 27 Fed. 689, 23 Blatchf. 531; *Bloomer v. Stolley*, 3 Fed. Cas. No. 1,559, *Fish. Pat. Rep.* 376, 5 McLean 158; *Mowry v. Grand St., etc., R. Co.*, 17 Fed. Cas. No. 9,893, 10 Blatchf. 89, 5 *Fish. Pat. Cas.* 586; *Wetherill v. Passaic Zinc Co.*, 29 Fed. Cas. No. 17,465, 6 *Fish. Pat. Cas.* 50, 2 Off. Gaz. 471, 9 *Phila. (Pa.)* 385.

17. *Hendrie v. Sayles*, 98 U. S. 546, 25 L. ed. 176.

18. U. S. Rev. St. (1878) § 4895 [U. S. Comp. St. (1901) p. 3385]. See also *Gaylord v. Case*, 5 Ohio Dec. (Reprint) 413, 5 Am. L. Rec. 494; *Wilson v. Rousseau*, 4 How. (U. S.) 646, 11 L. ed. 1141; *Potter v. Holland*, 19 Fed. Cas. No. 11,329, 4 Blatchf. 206, 1 *Fish. Pat. Cas.* 327; *Smith v. Mercer*, 22 Fed. Cas. No. 13,078, 5 Pa. L. J. 529.

19. *Burdell v. Denig*, 4 Fed. Cas. No. 2,142, 2 *Fish. Pat. Cas.* 588; *Meyer v. Bailey*, 17 Fed. Cas. No. 9,516, 2 Ban. & A. 73, 8 Off. Gaz. 437.

20. *Gottfried v. Miller*, 104 U. S. 521, 26 L. ed. 851; *Keene Mach. Co. v. Barratt*, 100 Fed. 590, 40 C. C. A. 571; *Curran v. Burd-sall*, 20 Fed. 835; *Faulks v. Kamp*, 3 Fed. 898, 17 Blatchf. 432; *Emmons v. Slaudina*, 8 Fed. Cas. No. 4,470, 2 Ban. & A. 199, 9 Off. Gaz. 352. *Compare Perry v. Corning*, 19 Fed. Cas. No. 11,004, 7 Blatchf. 195.

21. *Superior Drill Co. v. Ney Mfg. Co.*, 98 Fed. 734; *Jones v. Berger*, 58 Fed. 1006;



claims for past infringements, the assignee may sue therefor.<sup>22</sup> Mere intention, however, not signified in the assignment, to include therein claims for infringements previously committed, will not suffice to invest the assignee with any title to those claims.<sup>23</sup>

**d. Covenants, Conditions, and Restrictions**—(i) *IN GENERAL*. Covenants and conditions in an assignment do not prevent it from operating as an absolute assignment where they are conditions subsequent, such as a stipulation as to division of royalty or profits.<sup>24</sup> But conditions precedent must be performed before an assignment will become operative.<sup>25</sup>

(ii) *REMEDY FOR BREACH OF CONDITIONS*—(A) *Rescission or Cancellation*. For the non-payment of royalties or other non-performance of conditions, a forfeiture may be enforced; but in the case of a condition subsequent, the title which had theretofore vested remains in the assignee until the forfeiture is enforced.<sup>26</sup> If it is so stipulated, however, the title will revert to the assignor by operation of law, upon the breach of a condition.<sup>27</sup> The general rules governing the rescission and cancellation of written instruments are applicable to contracts for assignment of patents.<sup>28</sup> A patentee may, by his acquiescence, estop himself to claim the cancellation of an assignment.<sup>29</sup>

(B) *Recovery of Damages*. Either party may recover damages for a breach of a condition or covenant.<sup>30</sup>

*Emerson v. Hubbard*, 34 Fed. 327; *Kaolatype Engraving Co. v. Hoke*, 30 Fed. 444; *May v. Juneau County*, 30 Fed. 241; *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 24 Fed. 604; *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 18 Fed. 638, 21 Blatchf. 519; *Dibble v. Augur*, 7 Fed. Cas. No. 3,879, 7 Blatchf. 86.

The original owner of a patent, who has assigned it, may maintain an action for an infringement committed during the time of his ownership. *Moore v. Marsh*, 7 Wall. (U. S.) 515, 19 L. ed. 37.

*22. May v. Saginaw County*, 32 Fed. 629; *May v. Logan County*, 30 Fed. 250; *Adams v. Bellaire Stamping Co.*, 25 Fed. 270; *Consolidated Oil Well Packer Co. v. Eaton*, 12 Fed. 865; *Merriam v. Smith*, 11 Fed. 588.

*23. Emerson v. Hubbard*, 34 Fed. 327.

*24. Church v. Anti-Kalsomine Co.*, 138 Mich. 211, 101 N. W. 230; *Ford v. Dyer*, 148 Mo. 528, 49 S. W. 1091; *Boesch v. Graff*, 133 U. S. 697, 10 S. Ct. 378, 33 L. ed. 787; *Rude v. Westcott*, 130 U. S. 152, 9 S. Ct. 463, 32 L. ed. 888; *Janney v. Pancoast International Ventilator Co.*, 122 Fed. 535; *D. M. Sechler Carriage Co. v. Deere, etc., Co.*, 113 Fed. 285, 51 C. C. A. 242; *Day v. Stellman*, 7 Fed. Cas. No. 3,690, 1 Fish. Pat. Cas. 487; *Cartwright v. Amatt*, 2 B. & P. 43.

Conveyance on condition as creating trust see *Duff v. Gilliland*, 139 Fed. 16, 71 C. C. A. 428.

A clause appointing the assignee attorney of the patentee, with authority to use his name whenever they deem proper in the management of the business, does not restrict the interest or power of the assignee. *Rude v. Westcott*, 130 U. S. 152, 9 S. Ct. 463, 32 L. ed. 888.

Particular assignments with conditions construed see *Scheurle v. Husbands*, 65 N. J. L. 681, 48 Atl. 1118; *Bell Tel. Co. v. Com.*, 2 Pa. Cas. 299, 3 Atl. 825; *Tecktonius v. Scott*, 110

Wis. 441, 86 N. W. 672; *Holmes v. McGill*, 108 Fed. 238, 47 C. C. A. 296; *Bracher v. Hat-Sweat Mfg. Co.*, 49 Fed. 921.

*25. Thourot v. Holub*, 81 N. Y. App. Div. 634, 80 N. Y. Suppl. 1083; *Arnold Monophase Electric Co. v. Wagner Electric Mfg. Co.*, 148 Fed. 234; *Grier v. Baynes*, 49 Fed. 363; *Hull v. Pitrat*, 45 Fed. 94 [affirmed in 145 U. S. 650, 12 S. Ct. 986, 36 L. ed. 847].

*26. Littlefield v. Perry*, 21 Wall. (U. S.) 205, 22 L. ed. 577; *Stanley Rule, etc., Co. v. Bailey*, 22 Fed. Cas. No. 13,287, 3 Ban. & A. 297, 14 Blatchf. 510.

Where the remedy at law is sufficient, a court of equity will not interfere. *Osborne v. Jullion*, 3 Drew. 596, 26 L. J. Ch. 6, 4 Wkly. Rep. 767, 61 Eng. Reprint 1031.

*27. Pierpoint Boiler Co. v. Penn Iron, etc., Co.*, 75 Fed. 289.

*28. See Morgan v. National Pump Co.*, 74 Mo. App. 155 (holding that mere allegations of insolvency, failure to pay royalty, and failure to perform conditions without allegation of fraud or offer to return consideration are insufficient to justify equitable interposition in rescinding an assignment of a patent); *Dow v. Harkin*, 67 N. H. 383, 29 Atl. 846; *Andrews v. Fielding*, 20 Fed. 123.

*29. Duff v. Gilliland*, 139 Fed. 16, 71 C. C. A. 428 [reversing 135 Fed. 581].

*30. Georgia.*—*Barrett v. Verdery*, 93 Ga. 546, 21 S. E. 64; *Hornsby v. Butts*, 85 Ga. 694, 11 S. E. 846.

*Illinois.*—*Lord v. Owen*, 35 Ill. App. 382.

*Indiana.*—*Ft. Wayne, etc., R. Co. v. Haberkorn*, 15 Ind. App. 479, 44 N. E. 322.

*Massachusetts.*—*Weed v. Draper*, 104 Mass. 28.

*Missouri.*—*Standard Fireproofing Co. v. St. Louis Expanded Metal Fireproofing Co.*, 177 Mo. 559, 76 S. W. 1008.

*New Jersey.*—*Johnson v. Johnson R. Signal Co.*, 57 N. J. Eq. 79, 40 Atl. 193.

*New York.*—*Warth v. Liebovitz*, 179 N. Y.



6. RIGHTS, REMEDIES, AND LIABILITIES OF PARTIES<sup>31</sup> — a. In General. The assignee acquires no other or greater rights than were possessed by the assignor and is bound by the legal consequences of the assignor's acts.<sup>32</sup>

b. As to Each Other — (i) IN GENERAL. In the absence of warranty equity can give no relief to the assignee of a patent found to be void unless fraud is shown.<sup>33</sup> To rescind a contract of sale of a patent right on the ground of false and fraudulent representations, such representations must have been of material facts, constituting an inducement to the contract, whereon the purchaser had a right to rely, and did rely, and was thereby misled to his injury.<sup>34</sup> Fraudulent representations, in order to afford a ground for relief, must be of facts then existing or preëxisting, as distinguished from an opinion, a promise or an assumed future fact. Furthermore these facts must be of a concrete character, as distinguished from a truth or principle.<sup>35</sup> Representations by the seller of a patent that the same is valid and does not interfere with any prior patent must be regarded as matters of opinion, and not as statements of facts,<sup>36</sup> unless it appears that there was a prior patent covering the identical invention, and that the seller was aware thereof.<sup>37</sup> So a statement that letters patent are new and useful, if untrue, is not cause for avoiding a sale of the letters made in reliance on such statement.<sup>38</sup> Nor is a mere false assertion of value, when no warranty is intended, ground of relief to a purchaser, because the assertion is matter of opinion.<sup>39</sup> But a gross misrepresentation of the capacity of a machine and the success in selling and operating it, of which the purchaser was ignorant, has been held sufficient to warrant the rescission of a contract induced thereby.<sup>40</sup>

(ii) LIABILITY FOR, AND RECOVERY OF, CONSIDERATION.<sup>41</sup> In the absence of fraud or warranty the assignee of a patent right cannot refuse to make the payments agreed upon merely because the patent is found to be invalid,<sup>42</sup> or

200, 71 N. E. 734; *Kirschmann v. Lediard*, 61 Barb. 573; *Brusie v. Peck*, 16 N. Y. Suppl. 648 [reversed on other grounds in 135 N. Y. 622, 32 N. E. 76].

*Texas*.—*Clark v. Cyclone Woven Wire Fence Co.*, 22 Tex. Civ. App. 41, 54 S. W. 302.

*Vermont*.—*Vaughan v. Porter*, 16 Vt. 266. 31. Assignment in trust see TRUSTS.

32. *McClurg v. Kingsland*, 1 How. (U. S.) 202, 11 L. ed. 102; *Walter A. Wood Mowing, etc., Mach. Co. v. Deering*, 66 Fed. 547; *Grier v. Baynes*, 46 Fed. 523; *Pennington v. Hunt*, 20 Fed. 195; *Washburn, etc., Mfg. Co. v. Griesche*, 16 Fed. 669, 5 McCrary 246.

Assignee takes only what assignor owned. — *Coleman v. Ryan*, 33 Misc. (N. Y.) 715, 68 N. Y. Suppl. 253; *Abbett v. Zusi*, 1 Fed. Cas. No. 7, 5 Ban. & A. 38. See also *supra*, XI, A, 5, c, (1).

33. *Fowler v. Mallory*, 53 Conn. 420, 3 Atl. 560; *Dillman v. Nadelhoffer*, 19 Ill. App. 375 [affirmed in 119 Ill. 567, 7 N. E. 88]; *Wade v. Ringo*, 122 Mo. 322, 25 S. W. 901; *Cansler v. Eaton*, 55 N. C. 499; *Hiatt v. Twomey*, 21 N. C. 315.

34. *Hull v. Fields*, 76 Va. 594.

35. *Wade v. Ringo*, 122 Mo. 322, 25 S. W. 901.

36. *Dillman v. Nadelhoffer*, 119 Ill. 567, 7 N. E. 88 [affirming 19 Ill. App. 375].

37. *Reeves v. Corning*, 51 Fed. 774.

38. *Dillman v. Nadelhoffer*, 119 Ill. 567, 7 N. E. 88 [affirming 19 Ill. App. 375].

39. *Dillman v. Nadelhoffer*, 119 Ill. 567, 7 N. E. 88 [affirming 19 Ill. App. 375];

*Rockafellow v. Baker*, 41 Pa. St. 319, 80 Am. Dec. 624.

40. *Pierce v. Wilson*, 34 Ala. 596.

41. See COMMERCIAL PAPER, 7 Cye. 694; CONTRACTS, 9 Cye. 369.

42. *Connecticut*.—*Fowler v. Mallory*, 53 Conn. 420, 3 Atl. 560.

*Illinois*.—*Dillman v. Nadelhoffer*, 19 Ill. App. 375 [affirmed in 119 Ill. 567].

*Indiana*.—*Detrick v. McGlone*, 46 Ind. 291.

*Maryland*.—*Schwarzenbach v. Odorless Excavating Apparatus Co.*, 65 Md. 34, 3 Atl. 676, 57 Am. Rep. 301.

*Massachusetts*.—*Gilmore v. Aiken*, 118 Mass. 94.

*Minnesota*.—*Clark v. Smith*, 21 Minn. 539.

*New York*.—*McGill v. Holmes*, 168 N. Y. 647, 61 N. E. 1131.

*North Carolina*.—*Cansler v. Eaton*, 55 N. C. 499; *Hiatt v. Twomey*, 21 N. C. 315.

*United States*.—*Eclipse Bicycle Co. v. Farrow*, 199 U. S. 581, 26 S. Ct. 150, 50 L. ed. 317; *Wilson v. Simpson*, 9 How. 109, 13 L. ed. 66; *Milligan v. Lalance, etc., Mfg. Co.*, 21 Fed. 570.

In the absence of warranty invalidity is no defense. *Saxton v. Dodge*, 57 Barb. (N. Y.) 84; *Smith v. Neale*, 2 C. B. N. S. 67, 3 Jur. N. S. 516, 26 L. J. C. P. 143, 4 Wkly. Rep. 563, 89 E. C. L. 67; *Hall v. Conder*, 2 C. B. N. S. 22, 3 Jur. N. S. 366, 26 L. J. C. P. 138, 89 E. C. L. 22 [affirmed in 2 C. B. N. S. 53, 3 Jur. N. S. 963, 26 L. J. C. P. 288, 5 Wkly. Rep. 742, 89 E. C. L. 53]; *Lawes v. Purser*, 6 E. & B. 930, 3 Jur. N. S. 182, 26 L. J. Q. B. 25, 5 Wkly. Rep. 43, 88 E. C. L. 930; *Smith*



because the patented device infringes another patent;<sup>43</sup> but he may refuse where there is a total failure of consideration flowing from the assignor, as where the patented device is inoperative or useless.<sup>44</sup> But in order to sustain the defense of want of consideration it is not enough that the practical utility of the patent be limited, or that the manufactured article cannot be manufactured and sold at a profit, if it be capable of use.<sup>45</sup> A breach of a warranty given on the sale of a patent right is equivalent to a failure of consideration and furnishes a good defense to an action for the price.<sup>46</sup>

(III) *RECOVERY BACK OF CONSIDERATION BY ASSIGNEE.* Since no warranty is implied in the sale of a patent right the purchaser of such a right cannot, in the absence of fraud, and without an express covenant, recover of his vendor the price paid for it, because it is found to be invalid.<sup>47</sup> He may, however, recover back the purchase-money if the patent right was not that which he agreed to buy, unless he has accepted a deed describing the patent.<sup>48</sup> If a patentee elects to rescind a contract of sale for non-payment of the whole purchase-price the vendee is entitled to recover back the amount paid on the contract.<sup>49</sup>

c. *As to Third Parties.*<sup>50</sup> An assignee of a patent takes the title subject to the equities of other parties who have acquired rights therein, of which he had notice, express or implied.<sup>51</sup> It has been held, however, that in the absence of express

*v. Buckingham*, 21 L. T. Rep. N. S. 819, 18 Wkly. Rep. 314; *Hayne v. Maltby*, 3 T. R. 438; *Liardet v. Hammond Electric Light, etc., Co.*, 31 Wkly. Rep. 710; *Vermilyea v. Canniff*, 12 Ont. 164; *Owens v. Taylor*, 29 Grant Ch. (U. C.) 210.

43. *Fowler v. Mallory*, 53 Conn. 420, 3 Atl. 560; *Rhodes v. Ashurst*, 176 Ill. 351, 52 N. E. 118; *Standard Button Fastening Co. v. Harney*, 155 Mass. 507, 29 N. E. 1148; *Horne v. Hoyle*, 27 Fed. 216. *Compare Herzog v. Heyman*, 151 N. Y. 587, 45 N. E. 1127, 56 Am. St. Rep. 646.

Proof that a patent is void for infringement is not admissible in a suit upon a note given for its conveyance, unless that fact has been determined by a competent court. *Elmer v. Pennel*, 40 Me. 430.

44. *Snyder v. Kurtz*, 61 Iowa 593, 16 N. W. 722; *Scott v. Sweet*, 2 Greene (Iowa) 224; *Groff v. Hansel*, 33 Md. 161; *McDougall v. Fogg*, 2 Bosw. (N. Y.) 387; *Herzog v. Heyman*, 8 Misc. (N. Y.) 27, 28 N. Y. Suppl. 74; *Clough v. Patrick*, 37 Vt. 421; *Cragin v. Fowler*, 34 Vt. 326, 80 Am. Dec. 680.

Question of utility is for jury.—*Rowe v. Blanchard*, 18 Wis. 441, 86 Am. Dec. 783.

45. *Indiana*.—*Hunter v. McLaughlin*, 43 Ind. 38.

*Maine*.—*Elmer v. Pennel*, 40 Me. 430.

*Massachusetts*.—*Howe v. Richards*, 102 Mass. 64.

*Minnesota*.—*Van Norman v. Barbeau*, 54 Minn. 388, 55 N. W. 1112.

*North Carolina*.—*Fair v. Shelton*, 128 N. C. 105, 38 S. E. 290.

Evidence of slight value inadmissible see *Vaughan v. Porter*, 16 Vt. 266.

46. *Hawes v. Twogood*, 12 Iowa 582.

47. *Schwarzenbach v. Odorless Excavating Apparatus Co.*, 65 Md. 34, 3 Atl. 676, 57 Am. Rep. 301; *Foss v. Richardson*, 15 Gray (Mass.) 303; *Hiatt v. Twomey*, 21 N. C. 315.

48. *Foss v. Richardson*, 15 Gray (Mass.) 303.

49. *Bellis v. Henwood*, 6 Pa. Co. Ct. 78.

50. Patent rights as subject to creditors' suits see *CREDITORS' SUITS*, 12 Cyc. 31.

Patent rights as subject to execution see *EXECUTIONS*, 17 Cyc. 943.

Who entitled to sue infringers see *infra*, XIII, C, 7, a, b.

51. *Des Moines Ins. Co. v. McIntire*, 99 Iowa 50, 48 N. W. 565; *New York Phonograph Co. v. Edison*, 136 Fed. 600 [affirmed in 144 Fed. 404, 75 C. C. A. 382]; *Bradford Belting Co. v. Kisinger-Ison Co.*, 113 Fed. 811, 51 C. C. A. 483; *Westinghouse Air-Brake Co. v. Chicago Brake, etc., Co.*, 85 Fed. 786; *Carroll v. Goldschmidt*, 83 Fed. 508, 27 C. C. A. 566; *Sheldon Axle Co. v. Standard Axle Works*, 37 Fed. 789, 3 L. R. A. 656; *Kearney v. Lehigh Valley R. Co.*, 27 Fed. 699; *Hapgood v. Rosenstock*, 23 Fed. 86, 23 Blatchf. 95; *Gottfried v. Miller*, 10 Fed. 471; *Chambers v. Smith*, 5 Fed. Cas. No. 2,582, 5 Fish. Pat. Cas. 12, 7 Phila. (Pa.) 575.

An assignee of a patent is chargeable with notice of every fact in relation to an outstanding interest the possible existence of which is indicated by the recitals of the assignment. *Jonathan Mills Mfg. Co. v. Whitehurst*, 72 Fed. 496, 19 C. C. A. 130; *Waterman v. Shipman*, 55 Fed. 982, 5 C. C. A. 371; *Prime v. Brandon Mfg. Co.*, 19 Fed. Cas. No. 11,421, 4 Ban. & A. 379, 16 Blatchf. 453.

Notice of oral contract.—A purchaser of a patent with notice of a prior oral contract to convey the patent to another will be treated as a trustee for such prior contracting party, and decreed to convey to him. *Whitney v. Burr*, 115 Ill. 289, 3 N. E. 434.

Not subject to equities of which he had no notice.—*Gates Iron Works v. Fraser*, 153 U. S. 332, 14 S. Ct. 883, 38 L. ed. 734 [affirming 42 Fed. 49]; *Davis, etc., Temperature Controlling Co. v. Tagliabue*, 150 Fed. 372 [reversed on other grounds in 159 Fed. 712]; *Faulkner v. Empire State Nail Co.*, 67 Fed. 913, 15 C. C. A. 69 [affirming 55 Fed. 819].



contract he assumes no affirmative obligation to make good the previous contracts of his assignor.<sup>52</sup>

**7. TRANSFER BY SUCCESSION OR INHERITANCE.**<sup>53</sup> Upon the death of the patentee the patent vests in the administrator or executor and not in the heirs.<sup>54</sup>

**B. Licenses and Contracts**<sup>55</sup> — **1. LICENSES** — **a. In General.** A license is any right to make, use, or sell the patented invention which is less than an undivided part interest in the patent itself.<sup>56</sup> A license operates only as a waiver of the monopoly as to the licensee, and estops the licensor from exercising his prohibitory powers in derogation of the privileges conferred by him upon the licensee.<sup>57</sup> It gives no right to bring suit upon the patent and has been defined as the right not to be sued.<sup>58</sup>

**b. Requisites and Validity** — **(i) IN GENERAL.** A license may be express or implied. An express license may be oral or in writing.<sup>59</sup> If in writing no particular form of words is necessary. Anything which confers upon another the right to do an act which otherwise would be illegal is sufficient.<sup>60</sup> Its validity is determined by the same principles that apply to other contracts.<sup>61</sup> A license to

**52.** *Courter v. Crescent Sewing Mach. Co.*, 60 N. J. Eq. 413, 45 Atl. 609; *Bradford Belting Co. v. Kisinger-Ison Co.*, 113 Fed. 811, 51 C. C. A. 483; *Mueller v. Mueller*, 95 Fed. 155, 37 C. C. A. 392.

**53.** Power of administrator to assign patent see *supra*, XI, A, 1, b, (i).

**54.** *Bradley v. Dull*, 19 Fed. 913; *Shaw Relief Valve Co. v. New Bedford*, 19 Fed. 753; *Hodge v. North Missouri R. Co.*, 12 Fed. Cas. No. 6,561, 1 Dill. 104, 4 Fish. Pat. Cas. 161. See also *supra*, IV, F; I, C, 1.

**Surviving partner takes patent.** *Smith v. London, etc.*, R. Co., 2 E. & B. 69, 17 Jur. 1071, 75 E. C. L. 69.

**55.** Regulation of dealings in patent rights and patented articles see *infra*, XII.

**Specific performance of agreements for licenses see SPECIFIC PERFORMANCE.**

**56.** *Eclipse Wind Engine Co. v. Zimmerman Mfg. Co.*, 16 Ind. App. 496, 44 N. E. 1115; *Waterman v. MacKenzie*, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923; *Oliver v. Rumford Chemical Works*, 109 U. S. 75, 3 S. Ct. 61, 27 L. ed. 864; *Gayler v. Wilder*, 10 How. (U. S.) 477, 13 L. ed. 504; *Rice v. Boss*, 46 Fed. 195; *Theberath v. Celluloid Mfg. Co.*, 3 Fed. 143; *Potter v. Holland*, 19 Fed. Cas. No. 11,329, 4 Blatchf. 206, 1 Fish. Pat. Cas. 327; *Sanford v. Messer*, 21 Fed. Cas. No. 12,314, 5 Fish. Pat. Cas. 411, *Holmes* 149, 2 Off. Gaz. 470. And see 35 Vict. c. 26, § 22.

**The separate rights of making, using, or selling may be separately conveyed.** — *Waterman v. MacKenzie*, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923; *Oliver v. Rumford Chemical Works*, 109 U. S. 75, 3 S. Ct. 61, 27 L. ed. 862; *Hayward v. Andrews*, 106 U. S. 672, 1 S. Ct. 544, 27 L. ed. 271; *Mitchell v. Hawley*, 16 Wall. (U. S.) 544, 21 L. ed. 322; *Gayler v. Wilder*, 10 How. (U. S.) 477, 13 L. ed. 504.

**Particular transfers held to constitute licenses** see *Ft. Wayne, etc.*, R. Co. v. *Haberkorn*, 15 Ind. App. 479, 44 N. E. 322; *Standard Button Fastening Co. v. Ellis*, 159 Mass. 448, 54 N. E. 682; *Hurd v. Gere*, 27 N. Y. App. Div. 625, 50 N. Y. Suppl. 235; *Topliff v. Topliff*, 122 U. S. 121, 7 S. Ct. 1057, 30 L. ed.

1110; *Gayler v. Wilder*, 10 How. (U. S.) 477, 13 L. ed. 504; *Atwood Lock Co. v. Yale, etc.*, Mfg. Co., 115 Fed. 332; *Rice v. Boss*, 46 Fed. 195; *Hatfield v. Smith*, 44 Fed. 355; *Ingalls v. Tice*, 14 Fed. 297; *Gamewell Fire-Alarm Tel. Co. v. Brooklyn*, 14 Fed. 255; *Nellis v. Penneck Mfg. Co.*, 13 Fed. 451; *Armstrong v. Hanlenbeck*, 1 Fed. Cas. No. 544, 3 N. Y. Leg. Obs. 43; *Brooks v. Byam*, 4 Fed. Cas. No. 1,948, 2 Robb. Pat. Cas. 161, 2 Story 525; *Farrington v. Gregory*, 8 Fed. Cas. No. 4,688, 4 Fish. Pat. Cas. 221; *Hussey v. Whitley*, 12 Fed. Cas. No. 6,950, 1 Bond 407, 2 Fish. Pat. Cas. 120; *Sanford v. Messer*, 21 Fed. Cas. No. 12,314, 5 Fish. Pat. Cas. 411, *Holmes* 149, 2 Off. Gaz. 470; *Troy Iron, etc., Factory v. Corning*, 24 Fed. Cas. No. 14,195, 1 Blatchf. 467, Fish. Pat. Rep. 290.

**57.** *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288, 25 C. C. A. 267, 35 L. R. A. 728, 78 Off. Gaz. 171; *Bennett v. Iron Clad Mfg. Co.*, 110 N. Y. App. Div. 443, 96 N. Y. Suppl. 968.

**58.** *Hawks v. Swett*, 4 Hun (N. Y.) 146; *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288, 25 C. C. A. 267, 35 L. R. A. 728, 78 Off. Gaz. 171 [*reversing* 65 Fed. 619]; *Heap v. Hartley*, 42 Ch. D. 461, 58 L. J. Ch. 790, 61 L. T. Rep. N. S. 538, 38 Wkly. Rep. 136; *Renard v. Levinstein*, 2 Hem. & M. 628, 11 L. T. Rep. N. S. 766, 5 New Rep. 301, 13 Wkly. Rep. 382, 71 Eng. Reprint 607.

**59.** *Buss v. Putney*, 38 N. H. 44; *Gates Iron Works v. Fraser*, 153 U. S. 332, 14 S. Ct. 883, 38 L. ed. 734; *Cook v. Sterling Electric Co.*, 150 Fed. 766, 80 C. C. A. 502 [*affirming* 118 Fed. 451]; *Jones v. Berger*, 58 Fed. 1006; *Baldwin v. Sibley*, 2 Fed. Cas. No. 805, 1 Cliff. 150; *Protheroe v. May*, 9 L. J. Exch. 121, 5 M. & W. 675; *Roden v. London Small Arms Co.*, 46 L. J. Q. B. 213, 35 L. T. Rep. N. S. 305, 25 Wkly. Rep. 269.

**60.** A covenant not to sue for future infringements is in substance and effect a license. *Seibert Cylinder Oil-Cup Co. v. Detroit Lubricator Co.*, 34 Fed. 216; *Colgate v. Western Electric Mfg. Co.*, 28 Fed. 146.

**61.** *Heaton-Peninsular Button-Fastener Co.*



use an invention may be given before it is patented,<sup>62</sup> and if without restrictions, and if acted on by applying the invention to machines or mechanisms constructed before the granting of the patent, will protect the licensee in its use afterward.<sup>63</sup> It must conform to the requirements of state laws,<sup>64</sup> and not be in restraint of trade.<sup>65</sup>

(II) *IMPLIED LICENSE*<sup>66</sup> — (A) *In General*. The conduct of the owner of the patent may be such as to create an implied license to make, use, or sell the invention.<sup>67</sup> Mere acquiescence, if founded on a valuable consideration, is sufficient of itself to amount to a license.<sup>68</sup>

(B) *From Sale of Patented Article*. The sale of a patented article by one entitled to sell it carries with it the right to use the particular article anywhere desired, and to sell it to others unless there was an agreement to the contrary when the sale was made. By virtue of the contract of sale and the unconditional delivery the article sold is released from the monopoly.<sup>69</sup> The sale of a patented article without condition or restriction carries with it dominion over the article so sold, and the purchaser may use it in any manner and for any purpose,<sup>70</sup> so long as such use does not violate the vendor's exclusive property in another invention.<sup>71</sup>

v. Eureka Specialty Co., 77 Fed. 288, 25 C. C. A. 267, 35 L. R. A. 728, 78 Off. Gaz. 171.

62. *Burton v. Burton Stock-Car Co.*, 171 Mass. 437, 50 N. E. 1029; *Bezer v. Hall Signal Co.*, 22 N. Y. App. Div. 489, 48 N. Y. Suppl. 203; *Brush Electric Co. v. California Electric Light Co.*, 52 Fed. 945, 3 C. C. A. 368.

63. *Burton v. Burton Stock-Car Co.*, 171 Mass. 437, 50 N. E. 1029.

64. *Sandage v. Studabaker Bros. Mfg. Co.*, 142 Ind. 148, 41 N. E. 380, 51 Am. St. Rep. 165, 34 L. R. A. 363; *Mason v. McLeod*, 57 Kan. 105, 45 Pac. 76, 57 Am. St. Rep. 327, 41 L. R. A. 548. See also *infra*, XII, B.

65. **Exclusive license not illegal.**—An agreement by a patentee to allow an association and its members the exclusive use and sale of inventions patented by him is not illegal as being in restraint of trade. *Good v. Daland*, 121 N. Y. 1, 24 N. E. 15. But a public corporation cannot refuse to give equal service to all merely because operating under a patent. *Commercial Union Tel. Co. v. New England Tel., etc., Co.*, 61 Vt. 241, 17 Atl. 1071, 15 Am. St. Rep. 893, 5 L. R. A. 161.

66. **Implied from relation of employer and employee** see *supra*, IV, C.

67. *Deane v. Hodge*, 35 Minn. 146, 27 N. W. 917, 59 Am. Rep. 321; *O'Rourke Engineering Constr. Co. v. McMullen*, 150 Fed. 338; *Mueller v. Mueller*, 95 Fed. 155, 37 C. C. A. 392; *Anderson v. Eiler*, 50 Fed. 775, 1 C. C. A. 659; *Dodge Mfg. Co. v. Puster*, 42 Fed. 54; *Blanchard v. Sprague*, 3 Fed. Cas. No. 1,516, 1 Cliff. 288; *Gear v. Grosvenor*, 10 Fed. Cas. No. 5,291, 6 Fish. Pat. Cas. 314, Holmes 215, 3 Off. Gaz. 380; *Magoun v. New England Glass Co.*, 16 Fed. Cas. No. 8,960, 3 Ban. & A. 114; *McKeever v. U. S.*, 14 Ct. Cl. 396; *Incandescent Gas Light Co. v. New Incandescent Gas Lighting Co.*, 76 L. T. Rep. N. S. 47; *Kenny's Patent Button-holeing Co. v. Somervell*, 38 L. T. Rep. N. S. 878, 26 Wkly. Rep. 786.

**Evidence held insufficient to show implied license** see *Lawther v. Hamilton*, 124 U. S. 1,

8 S. Ct. 342, 31 L. ed. 325; *Keller v. Stolzenbach*, 20 Fed. 47.

68. *Seibert Cylinder Oil-Cup Co. v. Detroit Lubricator Co.*, 34 Fed. 216; *Blanchard v. Sprague*, 3 Fed. Cas. No. 1,516, 1 Cliff. 288.

69. *Pratt v. Marean*, 25 Ill. App. 516; *Howe v. Wooldredge*, 12 Allen (Mass.) 18; *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.*, 152 U. S. 425, 14 S. Ct. 627, 38 L. ed. 500; *Hobbie v. Jennison*, 149 U. S. 355, 13 S. Ct. 879, 37 L. ed. 766; *Waterman v. MacKenzie*, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923; *Newton v. McGuire*, 97 Fed. 614; *Hanifen v. Lupton*, 95 Fed. 465; *Edison Electric Light Co. v. Goelet*, 65 Fed. 612; *Edison Electric Light Co. v. Bloomington*, 65 Fed. 212; *Edison Electric Light Co. v. Citizens' Electric Light, etc., Co.*, 64 Fed. 491; *Hobbie v. Smith*, 27 Fed. 656; *Alabastine Co. v. Richardson*, 26 Fed. 620; *Roosevelt v. Western Electric Co.*, 20 Fed. 724; *Porter Needle Co. v. National Needle Co.*, 17 Fed. 536; *Detweiler v. Voegel*, 8 Fed. 600, 19 Blatchf. 482; *Adams v. Burks*, 1 Fed. Cas. No. 50, 4 Fish. Pat. Cas. 392, Holmes 40, 1 Off. Gaz. 282 [*affirmed* in 17 Wall. 453, 21 L. ed. 700]; *American Cotton-Tie Co. v. Simmons*, 1 Fed. Cas. No. 293, 3 Ban. & A. 320, 13 Off. Gaz. 967 [*reversed* on other grounds in 106 U. S. 89, 1 S. Ct. 52, 27 L. ed. 791]; *Black v. Hubbard*, 3 Fed. Cas. No. 1,460, 3 Ban. & A. 39, 12 Off. Gaz. 842; *Brooks v. Stolley*, 4 Fed. Cas. No. 1,963, Fish. Pat. Rep. 137, 4 McLean 275; *Farrington v. Gregory*, 8 Fed. Cas. No. 4,688, 4 Fish. Pat. Cas. 221; *Goodyear v. Beverly Rubber Co.*, 10 Fed. Cas. No. 5,557, 1 Cliff. 348; *McKay v. Wooster*, 16 Fed. Cas. No. 8,847, 6 Fish. Pat. Cas. 375, 2 Sawy. 373, 3 Off. Gaz. 441.

**Sale by patentee's agent abroad** see *Betts v. Willmott*, L. R. 6 Ch. 239, 25 L. T. Rep. N. S. 188, 19 Wkly. Rep. 369.

70. *George Frost Co. v. Kora Co.*, 136 Fed. 487 [*affirmed* in 140 Fed. 987, 71 C. C. A. 19]; *Goodyear v. Beverly Rubber Co.*, 10 Fed. Cas. No. 5,557, 1 Cliff. 348.

71. *Roosevelt v. Western Electric Co.*, 20 Fed. 724.



A sale, in order to have this effect, however, must be by one entitled to sell.<sup>72</sup> The purchaser has no right to make another machine or structure like it, nor to buy one from an infringer.<sup>73</sup>

**c. Recording.**<sup>74</sup> The law does not require that a license be recorded in the patent office even as against subsequent purchasers.<sup>75</sup>

**d. Construction and Operation**—(i) *IN GENERAL*. Licenses are to be construed like other contracts,<sup>76</sup> according to the intention of the parties.<sup>77</sup> If the license is in writing, all previous parol agreements are merged therein,<sup>78</sup> and oral evidence is not admissible to explain its provisions,<sup>79</sup> unless it is capable of two interpretations and a doubt exists as to its true meaning.<sup>80</sup> Several licenses constituting one transaction may be construed together.<sup>81</sup>

(ii) *RIGHTS AND INTERESTS CONVEYED*—(A) *In General*. The rights conferred by a license must be taken subject to the conditions therein made by the licensor.<sup>82</sup> The licensee has, however, the right to do those things which are necessary to the enjoyment of his license, such as to make a machine which he has been licensed to use.<sup>83</sup> Conversely a conveyance of the right to make and

72. *Brooks v. Stolley*, 4 Fed. Cas. No. 1,963, Fish. Pat. Rep. 137, 4 McLean 275; *Union Paper-Bag Mach. Co. v. Nixon*, 24 Fed. Cas. No. 14,391, 2 Ban. & A. 244, 1 Flipp. 491, 9 Off. Gaz. 691.

73. *Mitchell v. Hawley*, 16 Wall. (U. S.) 544, 21 L. ed. 322; *Brown v. Puget Sound Reduction Co.*, 110 Fed. 383; *Boston v. Allen*, 91 Fed. 248, 33 C. C. A. 485; *Davis v. Chesapeake, etc., Co.*, 77 Fed. 895; *Vermont Farm Mach. Co. v. Gibson*, 56 Fed. 143, 5 C. C. A. 451; *Union Metallic Cartridge Co. v. U. S. Cartridge Co.*, 24 Fed. Cas. No. 14,369, 2 Ban. & A. 593, 11 Off. Gaz. 1113.

A purchaser's right to use the patent is a mere incident to his ownership of the particular machine or structure sold to him by the patentee, and when it is worn out or destroyed the right to use the invention ceases. *Brown v. Puget Sound Reduction Co.*, 110 Fed. 383.

74. Of assignment see *supra*, XI, A, 4.

75. *Peoria Malting Co. v. Davenport Grain, etc., Co.*, 68 Ill. App. 104; *Stevens v. Head*, 9 Vt. 174, 31 Am. Dec. 617; *Jones v. Berger*, 58 Fed. 1006; *Brooks v. Byam*, 4 Fed. Cas. No. 1,948, 2 Robb Pat. Cas. 161, 2 Story 525; *Chambers v. Smith*, 5 Fed. Cas. No. 2,582, 5 Fish. Pat. Cas. 12, 7 Phila. (Pa.) 575; *Hamilton v. Kingsbury*, 11 Fed. Cas. No. 5,985, 4 Ban. & A. 615, 17 Blatchf. 264, 17 Off. Gaz. 147.

**English practice.**—Record is unnecessary unless royalty fixed. *In re Fletcher*, 62 L. J. Ch. 938, 69 L. T. Rep. N. S. 129, 3 Reports 626.

76. *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288, 25 C. C. A. 267, 35 L. R. A. 728, 78 Off. Gaz. 171.

77. *Laver v. Dennett*, 109 U. S. 90, 3 S. Ct. 73, 27 L. ed. 867; *Wetherill v. Passaic Zinc Co.*, 29 Fed. Cas. No. 17,465, 6 Fish. Pat. Cas. 50, 2 Off. Gaz. 471, 9 Phila. (Pa.) 385.

**Particular licenses construed.**—*Hegelein v. Anthony*, 33 Misc. (N. Y.) 616, 68 N. Y. Suppl. 2; *Leonard v. Crocker Wheeler Co.*, 125 Fed. 375 [reversed on other grounds in 125 Fed. 342, 60 C. C. A. 320]; *Western*

*Union Tel. Co. v. American Bell Tel. Co.*, 105 Fed. 684.

78. *Evory v. Candee*, 8 Fed. Cas. No. 4,583, 4 Ban. & A. 545, 17 Blatchf. 200.

79. *McAlear v. U. S.*, 150 U. S. 424, 14 S. Ct. 160, 37 L. ed. 1130; *Troy Iron, etc., Factory v. Corning*, 24 Fed. Cas. No. 14,195, 1 Blatchf. 467, Fish. Pat. Rep. 290.

80. *Western Union Tel. Co. v. American Bell Tel. Co.*, 105 Fed. 684 [reversed on other grounds in 125 Fed. 342, 60 C. C. A. 220].

81. *Hammond v. Mason, etc., Organ Co.*, 92 U. S. 724, 23 L. ed. 767.

82. *Providence Rubber Co. v. Goodyear*, 9 Wall. (U. S.) 788, 19 L. ed. 566; *Pelzer v. Binghamton*, 95 Fed. 823, 37 C. C. A. 288; *Hobbie v. Smith*, 27 Fed. 656; *Bloomer v. Gilpin*, 3 Fed. Cas. No. 1,558, 4 Fish. Pat. Cas. 50; *Star Salt Caster Co. v. Crossman*, 22 Fed. Cas. No. 13,321, 3 Ban. & A. 281, 4 Cliff. 568; *Wetherill v. Passaic Zinc Co.*, 29 Fed. Cas. No. 17,465, 6 Fish. Pat. Cas. 50, 2 Off. Gaz. 471, 9 Phila. (Pa.) 385. See also *infra*, XI, B, 1, d, (ii), (B).

**English and Canadian practice.**—Licensee abroad cannot use or sell in England *Société Anonyme des Manufactures de Glaces v. Telghman's Patent Sand Blast Co.*, 25 Ch. D. 1, 53 L. J. Ch. 1, 49 L. T. Rep. N. S. 451, 32 Wkly. Rep. 71. Licensee cannot prevent grant of license to others. *Fire Extinguisher Co. v. Northwestern Fire Extinguisher Co.*, 20 Grant Ch. (U. C.) 625.

83. *Edison Electric Light Co. v. Peninsular Light, etc., Co.*, 95 Fed. 669 [affirmed in 101 Fed. 831, 43 C. C. A. 479]; *Illingworth v. Spaulding*, 43 Fed. 827; *Hamilton v. Kingsbury*, 11 Fed. Cas. No. 5,984, 3 Ban. & A. 346, 15 Blatchf. 64, 14 Off. Gaz. 448; *Steam Stonecutter Co. v. Shortsleeves*, 22 Fed. Cas. No. 13,334, 4 Ban. & A. 364, 16 Blatchf. 381; *Woodworth v. Curtis*, 30 Fed. Cas. No. 18,013, 2 Robb Pat. Cas. 603, 2 Woodb. & M. 524; *MacLaughlin v. Lake Erie, etc., R. Co.*, 2 Ont. L. Rep. 190.

**English and Canadian practice.**—License to manufacture gives right to use and sell. *Thomas v. Hunt*, 17 C. B. N. S. 183, 112 E. C. L. 183. Need not use in patented form.



sell a patented article includes the right to use it.<sup>84</sup> So one licensed to make and use may add improvements.<sup>85</sup> But the right to use a composition does not carry the right to use the process.<sup>86</sup>

(B) *Place For Exercise of License*—(1) **EXPRESS LICENSE.** A license to use a patented device in a particular territory,<sup>87</sup> or at a particular establishment,<sup>88</sup> or on a particular railroad,<sup>89</sup> is binding upon the licensee and its use elsewhere is unlawful. But a license to use and sell a machine within a specified territory authorizes the licensee to sell the product of the machine out of the said territory.<sup>90</sup> And a license to use a patented device in a particular shop does not prevent its manufacture elsewhere.<sup>91</sup>

(2) **IMPLIED LICENSE.** It is well settled that the sale of a patented article by one authorized to sell it carries the right to use it anywhere,<sup>92</sup> even in the territory of another assignee or licensee.<sup>93</sup> The right to sell, as distinguished from the right to use, in the territory of another, was formerly denied;<sup>94</sup> but the recent decisions have overruled this doctrine, holding that the sale of patented articles by the patentee or a territorial assignee confers upon the purchasers of such articles the right to carry the same into the territory of another assignee, and there sell them, in the usual course of trade, without the consent or license of the latter assignee.<sup>95</sup>

(C) *Duration of License*<sup>96</sup>—(1) **IN GENERAL.** A license not expressly limited in duration continues until the patent expires or the license is forfeited through some act of the licensee, if not terminated by mutual consent.<sup>97</sup> How-

MacLaughlin v. Lake Erie, etc., R. Co., 3 Ont. L. Rep. 706.

84. *Turnbull v. Weir Plow Co.*, 14 Fed. 108, 9 Biss. 334.

85. *Mitchell v. Hawley*, 16 Wall. (U. S.) 544, 21 L. ed. 322; *MacLaughlin v. Lake Erie, etc., R. Co.*, 3 Ont. L. Rep. 706.

86. *United Nickel Co. v. California Electrical Works*, 25 Fed. 475.

87. *Burke v. Partridge*, 58 N. H. 349; *Chambers v. Smith*, 5 Fed. Cas. No. 2,582, 5 Fish. Pat. Cas. 12, 7 Phila. (Pa.) 575; *Wicke v. Kleinknecht*, 29 Fed. Cas. No. 17,608, 1 Ban. & A. 608, 7 Off. Gaz. 1098; *Woodworth v. Cook*, 30 Fed. Cas. No. 18,011, 2 Blatchf. 151, Fish. Pat. Rep. 423.

88. *Providence Rubber Co. v. Goodyear*, 9 Wall. (U. S.) 788, 19 L. ed. 566.

A license to use an invention to the capacity of a factory confers the right to use the invention in a subsequent addition to the factory, where the total use does not exceed the original capacity. *England v. Thompson*, 8 Fed. Cas. No. 4,487, 3 Cliff. 271.

A lease of premises and machinery by which a patented process is carried on is not a general license, but gives the licensee a right to use such process on the leased premises only. *Wetherill v. Passaic Zinc Co.*, 29 Fed. Cas. No. 17,465, 6 Fish. Pat. Cas. 50, 2 Off. Gaz. 471, 9 Phila. (Pa.) 385.

89. A license to a railroad company extends no further than the road in use or which it was authorized to construct at the date of the license. *Emigh v. Chicago, etc., R. Co.*, 8 Fed. Cas. No. 4,448, 1 Biss. 400, 2 Fish. Pat. Cas. 387, holding that it cannot use the patent on lines afterward built or leased. A license to use a patented brake on any and all cars belonging to the licensed company covers the use of brakes on trucks and running gear belonging to the company, although the

superstructure belongs to another. *Hodge v. Hudson River R. Co.*, 12 Fed. Cas. No. 6,559, 6 Blatchf. 85, 3 Fish. Pat. Cas. 410. But a license to use a patented invention upon the locomotives used by a railroad company on its road or on any road or roads now owned or that may hereafter be owned or operated by said company embraces not only locomotives in use at the date of the license upon roads then owned and operated by the company, but also such other locomotives as it might thereafter use and other roads which it might thereafter operate. *Matthew v. Pennsylvania R. Co.*, 8 Fed. 45.

90. *Simpson v. Wilson*, 4 How. (U. S.) 709, 11 L. ed. 1169.

91. *Wood v. Wells*, 29 Fed. Cas. No. 17,967, 6 Fish. Pat. Cas. 382.

92. *Robbie v. Jennison*, 149 U. S. 355, 13 S. Ct. 879, 37 L. ed. 766; *Adams v. Burks*, 17 Wall. (U. S.) 453, 21 L. ed. 700; *Edison Electric Light Co. v. Goelet*, 65 Fed. 613.

93. *Hobbie v. Jennison*, 149 U. S. 355, 13 S. Ct. 879, 37 L. ed. 766; *Adams v. Burks*, 17 Wall. (U. S.) 453, 21 L. ed. 700.

94. *California Electrical Works v. Finck*, 47 Fed. 583; *Sheldon Axle Co. v. Standard Axle Works*, 37 Fed. 789, 3 L. R. A. 656; *Hatch v. Adams*, 22 Fed. 434.

95. *Keeler v. Standard Folding-Bed Co.*, 157 U. S. 659, 15 S. Ct. 738, 39 L. ed. 848 [reversing 37 Fed. 693, 41 Fed. 51]; *Jackson v. Vaughan*, 73 Fed. 837.

96. *Revocation or other termination* see *infra*, XI, B, 1, g.

97. *St. Paul Plow-Works v. Starling*, 140 U. S. 184, 11 S. Ct. 803, 35 L. ed. 404; *American St. Car Advertising Co. v. Jones*, 122 Fed. 803 [reversed on other grounds in 142 Fed. 974, 74 C. C. A. 236]; *Edison Electric Light Co. v. Peninsular Light, etc., Co.*, 95 Fed. 669; *McKay v. Mace*, 23 Fed. 76;



ever an express stipulation in the contract as to the duration of the license will of course control.<sup>98</sup>

(2) *IN EXTENDED TERM.* The presumption of law in regard to every license under a patent is that the parties deal in regard only to the term existing when the license is given, unless an express provision is inserted looking to a further interest; and unless there be such a stipulation, showing that the parties contemplated an extension, the provisions of the license will be construed as relating to the then existing term only.<sup>99</sup> There is, however, a distinction between the grant of the right to make and vend the patented article, and the grant of the right to use it. Purchasers of the exclusive privilege of making or vending the patented article hold the whole or a portion of the franchise which the patent secures, depending upon the nature of the conveyance, and the interest which the purchaser acquires at the time limited for its continuance by the law which created the franchise, unless it is expressly stipulated to the contrary.<sup>1</sup> But the purchaser of the implement or machine for the purpose of using it in the ordinary pursuits of life stands on different grounds. Where such a sale is absolute, and without any conditions, the rule is well settled that the purchaser may continue to use the implement or machine until it is worn out in spite of any and every extension subsequently obtained by the patentee or his assigns.<sup>2</sup> But a licensee who, having machines in use at the end of an original term of a patent, takes a license for another year under the extended term, waives any rights which he had to use such machines when the first term ended.<sup>3</sup> If before the extension the right to use was limited to a particular district or to a specified number of machines, it continues during the extension subject to the same limitations.<sup>4</sup>

(III) *COVENANTS AND CONDITIONS.* The rights of the licensee may be limited by special covenants and conditions,<sup>5</sup> and a violation of those conditions make

*Hodge v. Hudson River R. Co.*, 12 Fed. Cas. No. 6,559, 6 Blatchf. 85, 3 Fish. Pat. Cas. 410.

98. *Nichols v. Murphy*, 136 Ill. 380, 26 N. E. 509; *Mitchell v. Hawley*, 16 Wall. (U. S.) 544, 21 L. ed. 322; *Sherborne v. Wilcox*, etc., *Sewing-mach. Co.*, 105 Fed. 970.

99. *New York Phonograph Co. v. Edison*, 136 Fed. 600 [affirmed in 144 Fed. 404, 75 C. C. A. 382]; *Hodge v. Hudson River R. Co.*, 12 Fed. Cas. No. 6,559, 6 Blatchf. 85, 3 Fish. Pat. Cas. 410; *Hodge v. Hudson River R. Co.*, 12 Fed. Cas. No. 6,560, 6 Blatchf. 165.

*Construction of particular stipulations.*—A stipulation in a license that it shall continue “during the term for which said letters patent are or may be granted” (*Hodge v. Hudson River R. Co.*, 12 Fed. Cas. No. 6,559, 6 Blatchf. 85, 3 Fish. Pat. Cas. 410), or “for the whole term of the patent which may be granted” (*Wetherill v. Passaic Zinc Co.*, 29 Fed. Cas. No. 17,465, 6 Fish. Pat. Cas. 50, 2 Off. Gaz. 471, 9 Phila. (Pa.) 385), does not authorize the use of the invention during the extended term.

1. *Union Paper-Bag Mach. Co. v. Nixon*, 105 U. S. 766, 26 L. ed. 959; *Mitchell v. Hawley*, 16 Wall. (U. S.) 544, 21 L. ed. 322; *Bloomer v. Millinger*, 1 Wall. (U. S.) 340, 17 L. ed. 581; *Bloomer v. Stolley*, 3 Fed. Cas. No. 1,559, Fish. Pat. Rep. 376, 5 McLean 158; *Wetherill v. Passaic Zinc Co.*, 29 Fed. Cas. No. 17,465, 6 Fish. Pat. Cas. 50, 2 Off. Gaz. 471, 9 Phila. (Pa.) 385.

The right to use a patented process during

the original term of the patent does not authorize the use of it after the patent is extended. *Wetherill v. Passaic Zinc Co.*, 29 Fed. Cas. No. 17,465, 6 Fish. Pat. Cas. 50, 2 Off. Gaz. 471, 9 Phila. (Pa.) 385.

2. *Union Paper-Bag Mach. Co. v. Nixon*, 105 U. S. 766, 26 L. ed. 959; *Mitchell v. Hawley*, 16 Wall. (U. S.) 544, 21 L. ed. 322; *Bloomer v. Millinger*, 1 Wall. (U. S.) 340, 17 L. ed. 581; *Chaffee v. Boston Belting Co.*, 22 How. (U. S.) 217, 16 L. ed. 240; *Bloomer v. McQuewan*, 14 How. (U. S.) 539, 14 L. ed. 532; *Blanchard v. Whitney*, 3 Fed. Cas. No. 1,519, 3 Blatchf. 307; *Farrington v. Gregory*, 8 Fed. Cas. No. 4,688, 4 Fish. Pat. Cas. 221; *Hodge v. Hudson River R. Co.*, 12 Fed. Cas. No. 6,559, 6 Blatchf. 85, 3 Fish. Pat. Cas. 410; *May v. Chaffee*, 16 Fed. Cas. No. 9,332, 2 Dill. 385, 5 Fish. Pat. Cas. 160; *Spaulding v. Page*, 22 Fed. Cas. No. 13,219, 4 Fish. Pat. Cas. 641, 1 Sawy. 702; *Wetherill v. Passaic Zinc Co.*, 29 Fed. Cas. No. 17,465, 6 Fish. Pat. Cas. 50, 2 Off. Gaz. 471, 9 Phila. (Pa.) 385; *Woodworth v. Curtis*, 30 Fed. Cas. No. 18,013, 2 Robb Pat. Cas. 603, 2 Woodb. & M. 524; *Wooster v. Sidenberg*, 30 Fed. Cas. No. 18,039, 2 Ban. & A. 91, 13 Blatchf. 88, 10 Off. Gaz. 244.

3. *Wooster v. Taylor*, 30 Fed. Cas. No. 18,040, 1 Ban. & A. 594, 12 Blatchf. 384, 8 Off. Gaz. 644.

4. *Day v. Union India-Rubber Co.*, 7 Fed. Cas. No. 3,691, 3 Blatchf. 488 [affirmed in 20 How. 216, 15 L. ed. 833].

5. *Whitson v. Columbia Phonograph Co.*, 18 App. Cas. (D. C.) 565; *Garst v. Harris*, 177



him an infringer of the patent.<sup>6</sup> A party selling patented machines may impose any conditions desired upon the use or further sale of those machines, and a purchaser with notice is bound by those conditions.<sup>7</sup> But a purchaser without notice of any private agreements between the patentee and his licensee is not bound thereby.<sup>8</sup>

**e. Rights, Remedies, and Liabilities**<sup>9</sup> — (i) *IN GENERAL*. The rights and liabilities of the parties arise from the license contract and are to be determined from its terms and conditions.<sup>10</sup> Where a licensee violates his express covenants or repudiates the license, the licensor may sue either for breach of the agreement or for infringement.<sup>11</sup> Where the licensee has exclusive right within certain territory the patentee cannot invade that right and the licensee may maintain suit against him for infringement.<sup>12</sup>

(ii) *ENJOINING USE OF INVENTION*. A provisional injunction will be granted against a licensee to restrain his use of a patented machine in violation of restrictions contained in the license.<sup>13</sup> But such an injunction will be refused where it appears that the licensee violated the restrictions under a misapprehension of his rights, and had discontinued the violation.<sup>14</sup> So where a licensee undertakes to use a patent without paying the license-fee, the use will be enjoined whether or not the license becomes voidable at law.<sup>15</sup> The exercise of a license to build a cer-

Mass. 72, 58 N. E. 174; *Burke v. Partridge*, 58 N. H. 349; *Bement v. National Harrow Co.*, 186 U. S. 70, 22 S. Ct. 747, 46 L. ed. 1058; *National Phonograph Co. v. Schlegel*, 128 Fed. 733, 64 C. C. A. 594; *Victor Talking Mach. Co. v. The Fair*, 123 Fed. 424, 61 C. C. A. 58; *Edison Phonograph Co. v. Pike*, 116 Fed. 863; *Cortelyou v. Lowe*, 111 Fed. 1005, 49 C. C. A. 671; *Edison Phonograph Co. v. Kaufmann*, 105 Fed. 960; *Dickerson v. Tinling*, 84 Fed. 192, 28 C. C. A. 139; *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288, 25 C. C. A. 267, 35 L. R. A. 728; *Washburn, etc., Mfg. Co. v. Southern Wire Co.*, 37 Fed. 428; *Brooks v. Stolley*, 4 Fed. Cas. No. 1,962, 3 McLean 523, 2 Robb Pat. Cas. 281; *Dorsey Revolving Harvester Rake Co. v. Bradley Mfg. Co.*, 7 Fed. Cas. No. 4,015, 1 Ban. & A. 330, 12 Blatchf. 202; *Goodyear v. Day*, 10 Fed. Cas. No. 5,567; *Wood v. Wells*, 30 Fed. Cas. No. 17,967, 6 Fish. Pat. Cas. 382; *Woodworth v. Cook*, 30 Fed. Cas. No. 18,011, 2 Blatchf. 151, Fish. Pat. Rep. 423.

An agreement to use only the patented form is not contrary to public policy. *Jones v. Lees*, 1 H. & N. 189, 2 Jur. N. S. 645, 26 L. J. Exch. 9.

6. *Cortelyou v. Johnson*, 138 Fed. 110 [reversed in 145 Fed. 933, 76 C. C. A. 455, and later decision affirmed in 207 U. S. 196, 28 S. Ct. 105, on the ground that there was no sufficient proof of notice of restrictions on sale]; *Victor Talking Mach. Co. v. The Fair*, 123 Fed. 424, 61 C. C. A. 58; *Edison Phonograph Co. v. The Pike*, 116 Fed. 863; *Edison Phonograph Co. v. Kaufmann*, 105 Fed. 960; *Tubular Rivet, etc., Co. v. O'Brien*, 93 Fed. 200; *Chambers v. Smith*, 5 Fed. Cas. No. 2,582, 5 Fish. Pat. Cas. 12, 7 Phila. (Pa.) 575.

7. *Victor Talking Mach. Co. v. The Fair*, 123 Fed. 424, 61 C. C. A. 58; *Edison Phonograph Co. v. Pike*, 116 Fed. 863; *Edison Phonograph Co. v. Kaufmann*, 105 Fed. 960;

*Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288, 25 C. C. A. 267, 35 L. R. A. 728; *Porter Needle Co. v. National Needle Co.*, 17 Fed. 536; *American Cotton-Tie Supply Co. v. Bullard*, 1 Fed. Cas. No. 294, 4 Ban. & A. 520, 17 Blatchf. 160, 9 Reporter 70, 17 Off. Gaz. 389; *Wilson v. Sherman*, 30 Fed. Cas. No. 17,833, 1 Blatchf. 536, 2 Fish. Pat. Rep. 361; *British Mutoscope, etc., Co. v. Homer*, [1901] 1 Ch. 671, 70 L. J. Ch. 279, 84 L. T. Rep. N. S. 26, 49 Wkly. Rep. 277.

Notice of conditions printed and posted upon each machine is binding upon purchasers. *Cortelyou v. Johnson*, 138 Fed. 110 [reversed in 145 Fed. 933, 76 C. C. A. 455 (see same case, 207 U. S. 196, 28 S. Ct. 105)]; *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288, 25 C. C. A. 267, 35 L. R. A. 728.

8. *Washing Mach. Co. v. Earle*, 29 Fed. Cas. No. 17,219, 2 Fish. Pat. Cas. 203, 3 Wall. Jr. 320.

9. Recovery of royalties see *infra*, XI, B, 3. Revocation of license see *infra*, XI, B, 1, g.

10. See *supra*, XI, B, 1, d, (iii).

11. *Cohn v. National Rubber Co.*, 6 Fed. Cas. No. 2,968, 6 Ban. & A. 568, 15 Off. Gaz. 829; *England v. Thompson*, 8 Fed. Cas. No. 4,487, 3 Cliff. 271; *Magic Ruffle Co. v. Elm City Co.*, 16 Fed. Cas. No. 8,949, 2 Ban. & A. 152, 13 Blatchf. 151, 8 Off. Gaz. 773.

12. *Whitson v. Columbia Phonograph Co.*, 18 App. Cas. (D. C.) 565; *Waterman v. McKenzie*, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923; *Wilson v. Rousseau*, 4 How. (U. S.) 646, 11 L. ed. 1141.

13. *Wilson v. Sherman*, 30 Fed. Cas. No. 17,833, 1 Blatchf. 536, Fish. Pat. Rep. 361.

14. *Wilson v. Sherman*, 30 Fed. Cas. No. 17,833, 1 Blatchf. 536, Fish. Pat. Rep. 361.

15. *Day v. Hartshorn*, 7 Fed. Cas. No. 3,683, 3 Fish. Pat. Cas. 32; *Woodworth v. Weed*, 30 Fed. Cas. No. 18,022, 1 Blatchf. 165, Fish. Pat. Rep. 108.



tain number of patented machines will not be restrained until such number of machines has been completed.<sup>16</sup> A bill by a licensee to enjoin the licensor from manufacturing the goods contrary to his agreement cannot be maintained where it appears that the licensee himself has ceased to manufacture any goods under the license.<sup>17</sup>

(iii) *LIABILITY FOR, AND RECOVERY OF, CONSIDERATION FOR LICENSE.*<sup>18</sup> The grant of a license to make, use, or sell a patented article is a sufficient consideration to support a promise to pay the price of such license if the patent is valid, although it may not be a profitable one.<sup>19</sup> Where the compensation for the use of the patent is not fixed by the contract, and where there is no established license-fee, the licensor is entitled to the reasonable value of such use.<sup>20</sup>

f. *Assignments and Sublicenses*—(i) *IN GENERAL.* Generally a license by a patentee is personal to the licensee, and not transferable.<sup>21</sup> In order to give the quality of assignability to a mere license it must contain express words to that effect, must run to the licensee and his assigns, or by other equivalent language indicate the intention to make the privilege transmissible by the licensee.<sup>22</sup> A licensee cannot apportion his license by assignment, unless a manifest intent to confer such a right appears in the contract of license;<sup>23</sup> and such intent cannot be inferred merely from the grant to him and his "assigns."<sup>24</sup> But where such a license runs to the executors and administrators of the licensees as well as to their assigns, it is apportionable and divisible by assignment, and may be transferred in severalty by one of the licensees.<sup>25</sup>

(ii) *ASSENT TO OR RECOGNITION OF ASSIGNMENT BY LICENSOR.* A continuing assignable quality may be given to a licensee to use a patented invention

16. *Aspinwall Mfg. Co. v. Gill*, 32 Fed. 702.

17. *Adams, etc., Mfg. Co. v. Westlake*, 53 Fed. 588.

18. *Recovery of royalties* see *infra*, XI, B, 3.

19. *Elmer v. Pennel*, 40 Me. 430; *Wilson v. Hentges*, 26 Minn. 288, 3 N. W. 338; *Montgomery v. Waterbury*, 2 Misc. (N. Y.) 145, 21 N. Y. Suppl. 631 [*affirmed* in 142 N. Y. 652, 37 N. E. 569]; *Sherman v. Champlain Transp. Co.*, 31 Vt. 162.

*Want of consideration.*—The utter worthlessness of a patent right is a perfect defense to a suit on a note given by a licensee (*Clough v. Patrick*, 37 Vt. 421); and it is sufficient to sustain a plea of want of consideration to show that no patent had ever issued for the article licensed to be made and sold (*Brown v. Wright*, 17 Ark. 9), or that the patent issued was void (*Harlow v. Putnam*, 124 Mass. 553).

20. *Griffin v. White*, 142 N. Y. 539, 37 N. E. 468; *Skinner v. Walter A. Wood Mowing Mach. Co.*, 14 N. Y. St. 317.

*How value determined.*—To determine this value all the elements of value on the case will be considered (*Berdan Firearms Mfg. Co. v. U. S.*, 26 Ct. Cl. 48 [*affirmed* in 156 U. S. 552, 15 S. Ct. 420, 39 L. ed. 530]; *McKeever v. U. S.*, 14 Ct. Cl. 396); and the testimony of experts is also admissible for this purpose (*Deane v. Hodge*, 35 Minn. 146, 27 N. W. 917, 59 Am. Rep. 321).

21. *Hapgood v. Hewitt*, 119 U. S. 226, 7 S. Ct. 193, 30 L. ed. 369; *Oliver v. Rumford Chemical Works*, 109 U. S. 75, 3 S. Ct. 61, 27 L. ed. 862; *Troy Iron, etc., Factory v. Corning*, 14 How. (U. S.) 193, 14 L. ed. 383;

*Bowers v. Lake Superior Contracting, etc., Co.*, 149 Fed. 983, 79 C. C. A. 493; *Walter A. Wood Harvester Co. v. Minneapolis-Esterly Harvester Co.*, 61 Fed. 256; *Waterman v. Shipman*, 55 Fed. 982, 5 C. C. A. 371; *Eclipse Windmill Co. v. Woodmanse Windmill Co.*, 24 Fed. 650; *Curran v. Craig*, 22 Fed. 101; *Gibbs v. Hoefner*, 19 Fed. 323; *Wilson v. Stolley*, 30 Fed. Cas. No. 17,840, 5 McLean 1, Fish. Pat. Rep. 261. But see *Baldwin v. Sibley*, 2 Fed. Cas. No. 805, 1 Cliff. 150; *Brooks v. Stolley*, 4 Fed. Cas. No. 1,963, Fish. Pat. Rep. 137, 4 McLean 275.

*An implied license to make and use does not pass by an administrator's sale of the licensee's place of business, including a few articles covered by the patent.* *Kraatz v. Tieman*, 79 Fed. 322.

22. *Tuttle v. La Dow*, 54 Hun (N. Y.) 149, 7 N. Y. Suppl. 277; *Oliver v. Rumford Chemical Works*, 109 U. S. 75, 3 S. Ct. 61, 27 L. ed. 862; *Troy Iron, etc., Factory v. Corning*, 14 How. (U. S.) 193, 14 L. ed. 383; *Bowers v. Lake Superior Contracting, etc., Co.*, 149 Fed. 983, 79 C. C. A. 493; *Waldo v. American Soda Fountain Co.*, 92 Fed. 623; *Walter A. Wood Harvester Co. v. Minneapolis-Esterly Harvester Co.*, 61 Fed. 256; *Adams v. Howard*, 22 Fed. 656, 23 Blatchf. 27; *Putnam v. Hollender*, 6 Fed. 882, 19 Blatchf. 48.

23. *Consolidated Fruit-Jar Co. v. Whitney*, 6 Fed. Cas. No. 3,132, 1 Ban. & A. 356, 10 Phila. (Pa.) 268.

24. *Brush Electric Co. v. California Electric Light Co.*, 52 Fed. 945, 3 C. C. A. 368; *Brooks v. Byam*, 4 Fed. Cas. No. 1,948, 2 Robb Pat. Cas. 161, 2 Story 525.

25. *Adams v. Howard*, 22 Fed. 656, 23 Blatchf. 27.



originally unassignable, by facts and circumstances and the conduct of the parties during the continuance of the license.<sup>26</sup> Even where a license contains a stipulation that it should be non-transferable, it may be assigned with the assent of the licensor, since such a stipulation is for his sole benefit.<sup>27</sup>

(III) *RIGHTS AND LIABILITIES OF PARTIES.* In the case of an assignment of a license, the assignee is bound to perform the conditions of the license, or the license will become forfeited.<sup>28</sup> But in the absence of any statutory provision the owner of a patented invention is not required to give notice to a voluntary purchaser of a licensee's right in order to enable him to hold such purchaser to the restricted use and enjoyment of the invention stipulated in the license.<sup>29</sup> It is the duty of the purchaser to inform himself of the nature of the licensee's ownership, and the extent of his right.<sup>30</sup>

**g. Revocation, Forfeiture, or Other Termination**<sup>31</sup> — (1) *BY LICENSOR.* Where a license contains no power of revocation it cannot be annulled by the licensor without the consent of the licensee,<sup>32</sup> but he must proceed at law for breach of contract.<sup>33</sup> A breach of covenant does not *per se* work a forfeiture of a patent license,<sup>34</sup> even if the license contains an express stipulation to that effect.<sup>35</sup> It will remain in force so as to defeat a suit against the licensee for infringement until it has been rescinded by decree of a court having jurisdiction.<sup>36</sup> Where the licensor has an adequate remedy at law, equity will not interfere.<sup>37</sup> Where stipulations as to termination are included in the license they must be followed, and

26. *Bowers v. Lake Superior Contracting, etc., Co.*, 149 Fed. 983, 79 C. C. A. 493.

Thus the patentee may affirm an assignment by a licensee by receiving royalties from such assignee or otherwise recognizing and dealing with him as a licensee. *Havana Press Drill Co. v. Ashurst*, 148 Ill. 115, 35 N. E. 873; *Wilde v. Smith*, 8 Daly (N. Y.) 196; *Lane, etc., Co. v. Locke*, 150 U. S. 193, 14 S. Ct. 78, 37 L. ed. 1049; *Holmes Burglar Alarm Tel. Co. v. Domestic Tel., etc., Co.*, 42 Fed. 220; *Bloomer v. Gilpin*, 3 Fed. Cas. No. 1,558, 4 Fish. Pat. Cas. 50.

27. *Scutt v. Robertson*, 127 Ill. 135, 19 N. E. 851.

28. *Moody v. Taber*, 17 Fed. Cas. No. 9,747, 1 Ban. & A. 41, *Holmes* 325, 5 Off. Gaz. 273; *Wilson v. Stolley*, 30 Fed. Cas. No. 17,840, Fish. Pat. Rep. 261, 5 McLean 1.

The grantee from a licensee must pay the license-fees stipulated in the license from the patentee. *Paper Stock Disinfecting Co. v. Boston Disinfecting Co.*, 147 Mass. 318, 17 N. E. 554; *Goodyear v. Congress Rubber Co.*, 10 Fed. Cas. No. 5,565, 3 Blatchf. 449. But he will not be enjoined from acting under the license because of failure of his grantee to pay license-fees accrued before the conveyance, nor is he liable therefor. *Goodyear v. Congress Rubber Co.*, *supra*.

29. *Chambers v. Smith*, 5 Fed. Cas. No. 2,582, 5 Fish. Pat. Cas. 12, 7 Phila. (Pa.) 575.

30. *Chambers v. Smith*, 5 Fed. Cas. No. 2,582, 5 Fish. Pat. Cas. 12, 7 Phila. (Pa.) 575.

31. *Duration of license in general* see *supra*, XI, B, 1, c.

32. *Scutt v. Robertson*, 127 Ill. 135, 19 N. E. 851; *Barclay v. Charles Roome Parmele Co.*, 70 N. J. Eq. 218, 61 Atl. 715; *Bezer v. Hall Signal Co.*, 22 N. Y. App. Div. 489, 48

N. Y. Suppl. 203; *Consolidated Oil Well Packer Co. v. Jarecki Mfg. Co.*, 157 Pa. St. 342, 27 Atl. 543, 545; *Wagner Typewriter Co. v. Watkins*, 84 Fed. 57; *Brush Electric Co. v. California Electric Light Co.*, 52 Fed. 945, 3 C. C. A. 368; *Illingworth v. Spaulding*, 43 Fed. 827; *Goddard v. Wilde*, 17 Fed. 845; *Kelly v. Porter*, 17 Fed. 519, 8 Sawy. 482; *Cook v. Bidwell*, 8 Fed. 452; *Burdell v. Denig*, 4 Fed. Cas. No. 2,142, 2 Fish. Pat. Cas. 588; *Bower v. Hodges*, 13 C. B. 765, 17 Jur. 1057, 22 L. J. C. P. 194, 76 E. C. L. 765; *Tielens v. Hooper*, 5 Exch. 830, 20 L. J. Exch. 78; *Guyot v. Thomson*, 71 L. T. Rep. N. S. 124, 8 Reports 810 [affirmed in [1894] 3 Ch. 388, 64 L. J. Ch. 32, 71 L. T. Rep. N. S. 416, 8 Reports 814 note]; *Ward v. Livesey*, 5 Rep. Pat. Cas. 102; *McLaughlin v. Lake Erie, etc., R. Co.*, 2 Ont. L. Rep. 190.

33. *Chase v. Cox*, 41 Fed. 475.

34. *Maitland v. Central Gas, etc., Co.*, 7 Misc. (N. Y.) 408, 27 N. Y. Suppl. 965 [affirming 7 Misc. 245, 27 N. Y. Suppl. 421]; *New York Phonograph Co. v. Edison*, 136 Fed. 600 [affirmed in 144 Fed. 404, 75 C. C. A. 382]; *Hanifen v. Lupton*, 95 Fed. 465; *Dare v. Boylston*, 6 Fed. 493, 18 Blatchf. 548; *White v. Lee*, 3 Fed. 222; *Woodworth v. Weed*, 30 Fed. Cas. No. 18,022, 1 Blatchf. 165, Fish. Pat. Rep. 108.

35. *Standard Dental Mfg. Co. v. National Tooth Co.*, 95 Fed. 291.

36. *Hanifen v. Lupton*, 95 Fed. 465; *Standard Dental Mfg. Co. v. National Tooth Co.*, 95 Fed. 291.

The exceptions to this rule are where the licensee has assumed such a hostile attitude toward the patent as to amount to a repudiation of the right conveyed by the license. *Wood v. Wells*, 30 Fed. Cas. No. 17,967, 6 Fish. Pat. Cas. 382.

37. *Densmore v. Tanite Co.*, 32 Fed. 544.



when performed end the agreement.<sup>33</sup> An agreement that upon failure of a party to a license to perform his covenant it may be forfeited by a written notice served on him is valid, and may be enforced.<sup>39</sup>

(II) *BY LICENSEE.* In the absence of a stipulation to that effect, a license is not revocable by the licensee, except by mutual consent, or by the fault of the other party.<sup>40</sup> When so stipulated a licensee may terminate the license by giving written notice, and he will no longer be liable for royalty under it;<sup>41</sup> but the notice given must be clear and unequivocal.<sup>42</sup> The surrender of a license by part of the licensees does not avoid the license as to the remainder of the licensees.<sup>43</sup>

(III) *BY DEATH OF LICENSEE.* A mere personal license is immediately terminated by the death of the licensee, and no rights thereunder pass to his personal representatives.<sup>44</sup>

(IV) *BY DISSOLUTION OF PARTNERSHIP OR CORPORATION.* The dissolution of a partnership or corporation exercising a patent license extinguishes the license, in the absence of language importing transferability,<sup>45</sup> except as to a continuing partner.<sup>46</sup>

(V) *REVIVAL OF FORFEITED LICENSE.* A license declared forfeited for breach of conditions cannot be revived by a tender of royalties due.<sup>47</sup>

2. *CONTRACTS.*<sup>48</sup> Contracts in regard to patent rights are interpreted and enforced in the same manner as other legal engagements.<sup>49</sup>

38. Garver v. Bement, 69 Mich. 149, 37 N. W. 63; Warth v. Liebovitz, 83 N. Y. App. Div. 632, 82 N. Y. Suppl. 578 [affirmed in 179 N. Y. 200, 71 N. E. 734]; Pitts v. Jameson, 15 Barb. (N. Y.) 310; Stimpson Computing Scale Co. v. W. F. Stimpson Co., 104 Fed. 893, 44 C. C. A. 241; Union Switch, etc., Co. v. Johnson, 72 Fed. 147, 18 C. C. A. 490; Woodworth v. Weed, 30 Fed. Cas. No. 18,022, 1 Blatchf. 165, Fish. Pat. Rep. 108.

39. Hammacher v. Wilson, 26 Fed. 239. Necessity of notice.—In case of default written notice must be served on the licensee in order to terminate the license, where such license provides in terms for such notice. Hurd v. Gere, 27 N. Y. App. Div. 625, 50 N. Y. Suppl. 235; Rogers v. Riessner, 30 Fed. 525; White v. Lee, 3 Fed. 222.

40. St. Paul Plow-Works v. Starling, 140 U. S. 184, 11 S. Ct. 803, 35 L. ed. 404; Laver v. Dennett, 109 U. S. 90, 3 S. Ct. 73, 27 L. ed. 867; Cherry v. Heming, 2 Exch. 557, 17 L. J. Exch. 305; Lewin v. Brown, 14 Wkly. Rep. 640.

Licensee may abandon license where patent is void see Standard Button Fastening Co. v. Ellis, 159 Mass. 448, 34 N. E. 682; Harlow v. Putnam, 124 Mass. 553; Fornerook Mfg. Co. v. Barnum Wire, etc., Works, 63 Mich. 195, 29 N. W. 537; Macon Knitting Co. v. Leicester Mills Co., 65 N. J. Eq. 138, 55 Atl. 401; Marston v. Swett, 82 N. Y. 526; Edison Gen. Electric Co. v. Thackara Mfg. Co., 167 Pa. St. 530, 31 Atl. 856; Ross v. Fuller, etc., Co., 105 Fed. 510; Mudgett v. Thomas, 55 Fed. 645.

41. Garver v. Bement, 69 Mich. 149, 37 N. W. 63.

42. Skinner v. Walter A. Wood Mowing, etc., Mach. Co., 140 N. Y. 217, 35 N. E. 491, 37 Am. St. Rep. 540; Hurd v. Gere, 27 N. Y. App. Div. 625, 50 N. Y. Suppl. 235.

43. Theberath v. Celluloid Mfg. Co., 3 Fed. 143.

44. Smith v. Preston, 170 Ill. 179, 48 N. E. 688; Oliver v. Rumford Chemical Works, 109 U. S. 75, 3 S. Ct. 61, 27 L. ed. 862.

45. Warth v. Mertens, 71 N. Y. App. Div. 395, 75 N. Y. Suppl. 1092 [affirmed in 173 N. Y. 626, 66 N. E. 1117]; Hapgood v. Hewitt, 119 U. S. 226, 7 S. Ct. 193, 30 L. ed. 369; Carroll v. Goldschmidt, 80 Fed. 520; Elgin Wind Power, etc., Co. v. Nichols, 65 Fed. 215, 12 C. C. A. 578; Haffke v. Clark, 50 Fed. 531, 1 C. C. A. 570; Curran v. Craig, 22 Fed. 101; Hapgood v. Hewitt, 11 Fed. 422, 11 Biss. 184. But see Wilson v. Mechanical Organette Co., 170 N. Y. 542, 63 N. E. 550 [reversing 57 N. Y. App. Div. 158, 68 N. Y. Suppl. 173].

46. Belding v. Turner, 3 Fed. Cas. No. 1,243, 8 Blatchf. 321, 4 Fish. Pat. Cas. 446.

47. Platt v. Fire-Extinguisher Mfg. Co., 59 Fed. 897, 8 C. C. A. 357.

48. Power of attorney to procure or manage patent see PRINCIPAL AND AGENT.

49. Eureka Clothes Wringing Mach. Co. v. Bailey Washing, etc., Mach. Co., 11 Wall. (U. S.) 488, 20 L. ed. 209; Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co., 77 Fed. 288, 25 C. C. A. 267, 35 L. R. A. 728; Morse v. O'Reilly, 17 Fed. Cas. No. 9,858; Star Salt Caster Co. v. Crossman, 22 Fed. Cas. No. 13,321, 3 Ban. & A. 281, 4 Cliff. 568.

Intention of parties controls see Thorn Wire Hedge Co. v. Washburn, etc., Mfg. Co., 159 U. S. 423, 16 S. Ct. 94, 40 L. ed. 205; Wooster v. Trowbridge, 120 Fed. 667, 57 C. C. A. 129 [affirming 115 Fed. 722]; Hartz v. Cleveland Block Co., 95 Fed. 681, 37 C. C. A. 227; Macallen Co. v. Johns-Pratt Co., 80 Fed. 410.

Unambiguous contract not changed by parol evidence see Ralya v. Atkins, 157 Ind. 331, 61 N. E. 726.



**3. ROYALTIES — a. Rights and Liabilities of Parties — (i) WHEN ROYALTIES DUE.** The time during which royalty must be paid depends entirely upon the terms of the contract.<sup>50</sup> No royalties, however, can be required on an agreement to grant a license under a patent if the patent is never granted.<sup>51</sup>

**(ii) AMOUNT OF ROYALTY.** The amount of royalty to which the licensor is entitled is the amount which has been fixed in the license agreement<sup>52</sup> or in the

Not construed to be retroactive see *National Sewing-Mach. Co. v. Wilcox, etc., Sewing-Mach. Co.*, 74 Fed. 557, 20 C. C. A. 654.

Consideration see *Magnolia Anti-Friction Metal Co. v. Singley*, 17 N. Y. Suppl. 251 [affirmed in 137 N. Y. 557, 33 N. E. 337]; *Piaget Novelty Co. v. Headley*, 108 Fed. 870, 48 C. C. A. 116 [affirming 107 Fed. 134].

Contract rather than the patent controls see *Wilder v. Adams*, 16 Gray (Mass.) 478; *Eureka Clothes Wringing Mach. Co. v. Bailey*, Washing, etc., Mach. Co., 11 Wall. (U. S.) 488, 20 L. ed. 209; *Harvey Steel Co. v. U. S.*, 39 Ct. Cl. 297.

Binding on successors see *Pratt v. Wilcox Mfg. Co.*, 64 Fed. 589.

Damages for breach see *Standard Fireproofing Co. v. St. Louis Expanded Metal Fireproofing Co.*, 177 Mo. 559, 76 S. W. 1008.

Agreement not to dispute validity of patent is not against public policy. *Philadelphia Creamery Supply Co. v. Davis, etc., Co.*, 77 Fed. 879; *Pratt v. Wilcox Mfg. Co.*, 64 Fed. 589.

Agreement not to defend against any patents owned by the plaintiff is against public policy and void. *Pope Mfg. Co. v. Gormully*, 144 U. S. 224, 12 S. Ct. 632, 36 L. ed. 414.

Contracts construed see *Eclipse Bicycle Co. v. Farrow*, 16 App. Cas. (D. C.) 468; *Lamson v. Martin*, 159 Mass. 557, 35 N. E. 78; *Mouat v. Bamlet*, 123 Mich. 345, 82 N. W. 74; *Myrick v. Purell*, 99 Minn. 457, 109 N. W. 995; *Mankato Mills Co. v. Willard*, 94 Minn. 160, 102 N. W. 202; *Standard Fireproofing Co. v. St. Louis Expanded Metal Fireproofing Co.*, 177 Mo. 559, 76 S. W. 1008; *Bancroft v. Union Embossing Co.*, 72 N. H. 402, 57 Atl. 97, 64 L. R. A. 298; *Peck v. Collins*, 70 N. Y. 376 [affirmed in 103 U. S. 660, 26 L. ed. 512]; *Corbet v. Manhattan Brass Co.*, 93 N. Y. App. Div. 217, 87 N. Y. Suppl. 577; *Ebert v. Loewenstein*, 42 N. Y. App. Div. 109, 58 N. Y. Suppl. 889 [reversed on other grounds in 167 N. Y. 577, 60 N. E. 1110]; *Miller v. Jones*, 67 Hun (N. Y.) 281, 22 N. Y. Suppl. 86; *Hargraves v. A. B. Pitkin Mach. Co.*, 19 R. I. 426, 34 Atl. 738; *Vaughan v. Porter*, 16 Vt. 266; *Murphey v. Weil*, 92 Wis. 467, 66 N. W. 532; *Thorn Wire Hedge Co. v. Washburn, etc., Mfg. Co.*, 159 U. S. 423, 16 S. Ct. 94, 40 L. ed. 205; *Ball, etc., Fastener Co. v. Patent Button Co.*, 152 Fed. 187; *New York Phonograph Co. v. Edison*, 136 Fed. 600 [affirmed in 144 Fed. 404, 75 C. C. A. 382]; *Kenny v. Knight*, 119 Fed. 475; *Wooster v. Trowbridge*, 115 Fed. 722; *Kerr v. Southwick*, 109 Fed. 482; *Fox Solid Pressed Steel Co. v. Schoen*, 77 Fed. 29; *Denning v. Bray*, 61 Fed. 651, 10 C. C. A. 6; *Goddard v. Wilde*, 17 Fed. 845; *Dibble*

*v. Augur*, 7 Fed. Cas. No. 3,879, 7 Blatchf. 86. See also *Eclipse Bicycle Co. v. Farrow*, 199 U. S. 531, 26 S. Ct. 150, 50 L. ed. 317.

50. *Rhodes v. Ashurst*, 176 Ill. 351, 52 N. E. 118; *Burton v. Burton Stock-Car Co.*, 171 Mass. 437, 50 N. E. 1029; *Hamilton v. Park, etc., Co.*, 112 Mich. 138, 70 N. W. 436; *Nilsson v. De Haven*, 168 N. Y. 656, 61 N. E. 1131; *Fries v. Merck*, 167 N. Y. 445, 60 N. E. 777; *Bezer v. Hall Signal Co.*, 22 N. Y. App. Div. 489, 48 N. Y. Suppl. 203; *People v. Remington*, 59 Hun (N. Y.) 282, 12 N. Y. Suppl. 824, 14 N. Y. Suppl. 98 [affirmed in 126 N. Y. 654, 27 N. E. 853]; *Union Mfg. Co. v. Lounsbury*, 42 Barb. (N. Y.) 125 [affirmed in 41 N. Y. 363]; *Willcox, etc., Sewing-Mach. Co. v. Sherborn*, 109 Fed. 319, 48 C. C. A. 378; *Shepard v. Kinner*, 86 Fed. 638, 30 C. C. A. 315.

Release.—Invalidity of patent releases licensee if he quits using invention. *Standard Button Fastening Co. v. Ellis*, 159 Mass. 448, 34 N. E. 682; *Harlow v. Putnam*, 124 Mass. 553; *Macon Knitting Co. v. Leicester Mills Co.*, 65 N. J. Eq. 138, 55 Atl. 401; *Dutchess Tool Co. v. Kolb*, 44 N. Y. App. Div. 624, 60 N. Y. Suppl. 94; *Edison Gen. Electric Co. v. Thackara Mfg. Co.*, 167 Pa. St. 530, 31 Atl. 856; *Mudgett v. Thomas*, 55 Fed. 645.

Date of payments see *Confectioners' Mach., etc., Co. v. Panoualias*, 134 Fed. 393, 67 C. C. A. 391; *American Paper-Bag Co. v. Van Nortwick*, 52 Fed. 752, 3 C. C. A. 274; *Dare v. Boylston*, 6 Fed. 493, 18 Blatchf. 548; *Brooks v. Stolley*, 4 Fed. Cas. No. 1,962, 3 McLean 523, 2 Robb Pat. Cas. 281.

Due from legal representatives after licensee's death see *Dancel v. Goodyear Shoe-Mach. Co.*, 109 Fed. 333.

51. *Hamilton v. Park, etc., Co.*, 125 Mich. 72, 83 N. W. 1018; *Travis v. Hunter*, 41 Minn. 176, 42 N. W. 1015.

By agreement royalty due before grant of patent see *Burton v. Burton Stock-Car Co.*, 171 Mass. 437, 50 N. E. 1029; *Hamilton v. Park, etc., Co.*, 112 Mich. 138, 70 N. W. 436; *Nilsson v. De Haven*, 168 N. Y. 656, 61 N. E. 1131; *Bezer v. Hall Signal Co.*, 22 N. Y. App. Div. 489, 48 N. Y. Suppl. 203; *Willcox, etc., Sewing-Mach. Co. v. Sherborn*, 109 Fed. 319, 48 C. C. A. 378.

Liable under special agreement although patent not granted see *Ingraham v. Schaum*, 157 Pa. St. 88, 27 Atl. 404; *Beecher v. Stein*, 139 Pa. St. 570, 21 Atl. 79.

In absence of special agreement due upon issue of patent see *D. M. Steward Mfg. Co. v. Steward*, 109 Tenn. 288, 70 S. W. 803.

52. *Keith v. Electrical Engineering Co.*, 136 Cal. 178, 68 Pac. 598; *Linington v. Strong*, 111 Ill. 152; *Simonds Rolling Mach. Co. v. Pope Mfg. Co.*, 180 Mass. 393, 62 N. E.



absence of definite agreement between the parties is determined by what is reasonable.<sup>53</sup>

(iii) *PERSONS ENTITLED TO ROYALTIES.* The owner of a patent who grants a license is entitled to royalty in accordance with the conditions of the contract whether express or implied.<sup>54</sup> Where one of several joint owners issues a license the others cannot recover part of the royalty from the licensee,<sup>55</sup> nor can they recover it from the licensor under an accounting.<sup>56</sup>

(iv) *PERSONS LIABLE FOR ROYALTIES.* The licensee is liable during the continuation of the contract for the use of the invention referred to therein,<sup>57</sup>

467; McGill v. Holmes, 168 N. Y. 647, 61 N. E. 1131.

**Minimum sum fixed** see Hamilton v. Park, etc., Co., 112 Mich. 138, 70 N. W. 436; Genet v. Delaware, etc., Canal Co., 136 N. Y. 593, 32 N. E. 1078, 19 L. R. A. 127; Corbet v. Manhattan Brass Co., 93 N. Y. App. Div. 217, 87 N. Y. Suppl. 577; Ebert v. Loewenstein, 42 N. Y. App. Div. 109, 58 N. Y. Suppl. 889 [affirmed in 167 N. Y. 577, 60 N. E. 1110]; Meyer v. Brenzinger, 22 Misc. (N. Y.) 712, 49 N. Y. Suppl. 1091.

**Particular contracts construed** see Bates Mach. Co. v. Cookson, 202 Ill. 248, 66 N. E. 1093; Goodyear Shoe Mach. Co. v. Selz, 157 Ill. 186, 41 N. E. 625; Warth v. Loewenstein, 121 Ill. App. 71 [affirmed in part in 219 Ill. 222, 76 N. E. 379]; Spureck v. Benner, 89 Ill. App. 79; Cummings v. Standard Harrow Co., 55 Misc. (N. Y.) 601, 105 N. Y. Suppl. 646; Dick v. Bovaird, 8 Pa. Cas. 70, 5 Atl. 30; Bovaird v. Dick, 8 Pa. Cas. 60, 5 Atl. 26; Bowers v. Lake Superior Contracting, etc., Co., 149 Fed. 983, 79 C. C. A. 493; Western Union Tel. Co. v. American Bell Tel. Co., 125 Fed. 342, 60 C. C. A. 220.

**Interest on overdue royalty** see Pressey v. H. B. Smith Mach. Co., 45 N. J. Eq. 872, 19 Atl. 618.

53. Bates Mach. Co. v. Cookson, 202 Ill. 248, 66 N. E. 1093; Standard Fireproofing Co. v. St. Louis Expanded Metal Fireproofing Co., 177 Mo. 559, 76 S. W. 1008; Ross v. Fuller, etc., Co., 105 Fed. 510.

54. Blair v. Lippincott Glass Co., 52 Fed. 226; Consolidated Fruit-Jar Co. v. Whitney, 6 Fed. Cas. No. 3,134, 2 Ban. & A. 375.

**Equitable rights of partner** see Rogers v. Riessner, 30 Fed. 525.

**Contract inuring to benefit of owner** see Mann's Boudoir Car Co. v. Gilbert Car Mfg. Co., 69 Hun (N. Y.) 245, 23 N. Y. Suppl. 697 [affirmed in 141 N. Y. 571, 36 N. E. 345]; Grier v. Baynes, 46 Fed. 523; Troy Iron, etc., Factory v. Corning, 24 Fed. Cas. No. 14,195, 1 Blatchf. 467, Fish. Pat. Rep. 290 [reversed on other grounds in 14 How. 193, 14 L. ed. 383].

**Royalty implied under other patents** see Felix v. Scharnweber, 19 Ill. App. 628 [affirmed in 119 Ill. 445, 10 N. E. 16].

**Conduct of licensor may be such as to estop** see Edison Gen. Electric Co. v. Thackara Mfg. Co., 167 Pa. St. 530, 31 Atl. 856; Angier v. Eaton, 98 Pa. St. 594. Granting licenses to others, however, will not estop him in the absence of agreement. Jarecki v. Hays, 161 Pa. St. 613, 29 Atl. 118; Hard-

wick v. Galbraith, 147 Pa. St. 333, 23 Atl. 451.

55. Paulus v. M. M. Buck Mfg. Co., 129 Fed. 594, 64 C. C. A. 162; Lalance, etc., Mfg. Co. v. National Enameling, etc., Co., 108 Fed. 77; Levy v. Dattlebaum, 63 Fed. 992; Pusey, etc., Co. v. Miller, 61 Fed. 401.

56. Vose v. Singer, 4 Allen (Mass.) 226, 81 Am. Dec. 696; De Witt v. Elmira Nobles Mfg. Co., 5 Hun (N. Y.) 301 [affirmed in 66 N. Y. 459, 23 Am. Rep. 731; Blackledge v. Weir, etc., Mfg. Co., 108 Fed. 71, 47 C. C. A. 212.

57. The licensee is liable for at least the minimum amount specified; it makes no difference whether he uses the invention or not. Linington v. Strong, 90 Ill. 556; Simonds Rolling Mach. Co. v. Pope Mfg. Co., 180 Mass. 393, 62 N. E. 467; Wing v. Ansonia Clock Co., 102 N. Y. 531, 7 N. E. 621; Hackett v. Hackett Hatch Door Mfg. Co., 52 N. Y. Super. Ct. 263.

**Eviction or proper surrender is necessary to terminate liability.** Skinner v. Walter A. Wood Mowing, etc., Mach. Co., 140 N. Y. 217, 35 N. E. 491, 37 Am. St. Rep. 540 [affirming 20 N. Y. Suppl. 251]; Hurd v. Gere, 27 N. Y. App. Div. 625, 50 N. Y. Suppl. 235; Maitland v. Drew, 14 Misc. (N. Y.) 60, 35 N. Y. Suppl. 249; McKay v. Smith, 39 Fed. 556; McKay v. Jackman, 17 Fed. 641.

**Liable after cancellation for past use** see Hamilton v. Park, etc., Co., 112 Mich. 138, 70 N. W. 436.

**Not relieved by invalidity of patent** see Warwick v. Stockton, (N. J. Ch. 1897) 37 Atl. 458; Hurd v. Gere, 27 N. Y. App. Div. 625, 50 N. Y. Suppl. 235; Holmes v. McGill, 108 Fed. 238, 47 C. C. A. 296; National Sewing-Mach. Co. v. Willcox, etc., Sewing-Mach. Co., 74 Fed. 557, 20 C. C. A. 654; Covell v. Bostwick, 39 Fed. 421. See also *supra*, VI, F. 4.

**Infringement by licensor or others** does not *per se* relieve the licensor. Nunes v. Russell, 65 Ill. App. 171; Skidmore v. Fahys Watch-Case Co., 28 N. Y. App. Div. 94, 50 N. Y. Suppl. 1016; Birdsall v. Perego, 3 Fed. Cas. No. 1,435, 5 Blatchf. 251.

**Transfer of license or business** does not end liability. Porter v. Standard Measuring Mach. Co., 142 Mass. 197, 7 N. E. 925; Rodgers v. Tarrant, 43 Mich. 113, 4 N. W. 507; Wilson v. Mechanical Organette Co., 170 N. Y. 542, 63 N. E. 550; Marsh v. Dodge, 4 Hun (N. Y.) 278 [affirmed in 66 N. Y. 533]; Sherman v. Champlain Transp. Co., 31 Vt. 162.



whether it is fully protected by patent or not.<sup>58</sup> He cannot allege invalidity or termination of contract so long as he acts under it.<sup>59</sup> Where a contractor is employed to do certain work and in doing it infringes a patent the contractor and not the employer is liable.<sup>60</sup>

(v) *LIEN*. An agreement to pay royalties is a personal contract and creates no lien on the manufactured articles.<sup>61</sup>

b. Remedies. Royalties may be collected by an action at law,<sup>62</sup> and an action

Where the device infringes another patent the licensee may stop use and refuse to pay further royalty. *Standard Button Fastening Co. v. Ellis*, 159 Mass. 448, 34 N. E. 682; *Harlow v. Putnam*, 124 Mass. 553; *Macon Knitting Co. v. Leicester Mills Co.*, 65 N. J. Eq. 138, 55 Atl. 401; *Edison Gen. Electric Co. v. Thackara Mfg. Co.*, 167 Pa. St. 530, 31 Atl. 856; *Mudgett v. Thomas*, 55 Fed. 645; *McKay v. Smith*, 39 Fed. 556; *McKay v. Jackman*, 17 Fed. 641.

58. *Keith v. Electrical Engineering Co.*, 136 Cal. 178, 68 Pac. 598; *Eclipse Bicycle Co. v. Farrow*, 23 App. Cas. (D. C.) 411 [*reversed* on other grounds in 199 U. S. 581, 26 S. Ct. 150, 50 L. ed. 317]; *Palmer's Appeal*, 96 Pa. St. 106; *U. S. v. Harvey Steel Co.*, 196 U. S. 310, 25 S. Ct. 240, 49 L. ed. 492; *Corbin v. Taussig*, 137 Fed. 151; *Leslie v. Standard Sewing-Mach. Co.*, 98 Fed. 827, 39 C. C. A. 314; *Sproull v. Pratt, etc., Co.*, 97 Fed. 807.

Liability includes unpatented as well as patented articles see *McGill v. Holmes*, 48 N. Y. App. Div. 628, 64 N. Y. Suppl. 787 [*affirmed* in 168 N. Y. 647, 61 N. E. 1131].

Agreement controls and not the scope of the patent. *Kroegher v. McConway, etc., Co.*, 149 Pa. St. 444, 23 Atl. 341; *Kirkpatrick v. Pope Mfg. Co.*, 64 Fed. 369.

Substitution of another device does not avoid liability. *Eclipse Bicycle Co. v. Farrow*, 16 App. Cas. (D. C.) 468, 23 App. Cas. (D. C.) 411 [*reversed* on other grounds in 199 U. S. 581, 26 S. Ct. 150, 50 L. ed. 317]; *Denise v. Swett*, 68 Hun (N. Y.) 188, 22 N. Y. Suppl. 950 [*reversed* on other grounds in 142 N. Y. 602, 37 N. E. 627].

Not liable for use of things outside of patent and of agreement see *Fornbrook Mfg. Co. v. Barnum Wire, etc., Works*, 63 Mich. 195, 29 N. W. 537; *Dutchess Tool Co. v. Kolb*, 44 N. Y. App. Div. 624, 60 N. Y. Suppl. 94; *Hyatt v. Mark*, 55 N. Y. Super. Ct. 507, 2 N. Y. Suppl. 727 [*affirmed* in 124 N. Y. 93, 26 N. E. 285]; *Moore v. National Water-Tube Boiler Co.*, 84 Fed. 346; *Standard Sewing-Mach. Co. v. Leslie*, 78 Fed. 325, 24 C. C. A. 107; *Covell v. Bostwick*, 39 Fed. 421.

Use of one of several patents mentioned see *Kline v. M. Garland Co.*, 135 Mich. 313, 97 N. W. 768; *Pope Mfg. Co. v. Owsley*, 27 Fed. 100.

Not liable for different invention see *Eclipse Bicycle Co. v. Farrow*, 199 U. S. 581, 26 S. Ct. 150, 50 L. ed. 317. Royalty only on machines under patent. *Goucher v. Clayton*, 11 Jur. N. S. 462, 13 L. T. Rep. N. S. 111. Liable under contract whether or not followed strictly. *Smith v. Goldie*, 9 Can. Sup. Ct. 46; *Yates v. Great Western R. Co.*, 24

*Grant Ch. (U. C.) 495*; *Smith v. Powell*, 7 U. C. C. P. 332.

59. *Bowers' California Dredging Co. v. San Francisco Bridge Co.*, 132 Cal. 342, 64 Pac. 475; *Illinois Watch Case Co. v. Ecaubert*, 177 Ill. 587, 52 N. E. 861; *Clark v. Amoskeag Mfg. Co.*, 62 N. H. 612; *Warwick v. Stockton*, (N. J. Ch. 1897) 37 Atl. 458; *Hyatt v. Ingalls*, 124 N. Y. 93, 26 N. E. 285 [*affirming* 55 N. Y. Super. Ct. 507, 2 N. Y. Suppl. 727]; *Dutchess Tool Co. v. Kolb*, 44 N. Y. App. Div. 624, 60 N. Y. Suppl. 94; *Skidmore v. Fahys Watch-Case Co.*, 28 N. Y. App. Div. 94, 50 N. Y. Suppl. 1016; *Denise v. Swett*, 68 Hun (N. Y.) 188, 22 N. Y. Suppl. 950 [*reversed* on other grounds in 142 N. Y. 602, 37 N. E. 627]; *Gaylord v. Case*, 5 Ohio Dec. (Reprint) 413, 5 Am. L. Rec. 494; *Consolidated Oil Well Packer Co. v. Jarecki Mfg. Co.*, 157 Pa. St. 342, 27 Atl. 543, 545; *U. S. v. Harvey Steel Co.*, 196 U. S. 310, 25 S. Ct. 240, 49 L. ed. 492; *American St. Car Advertising Co. v. Jones*, 122 Fed. 803 [*reversed* on other grounds in 142 Fed. 974, 74 C. C. A. 236]; *Holmes v. McGill*, 108 Fed. 238, 47 C. C. A. 296; *Leslie v. Standard Sewing-Mach. Co.*, 98 Fed. 827, 39 C. C. A. 314; *Sproull v. Pratt, etc., Co.*, 97 Fed. 807; *Moore v. National Water-Tube Boiler Co.*, 84 Fed. 346; *Bonsack Mach. Co. v. Hess*, 68 Fed. 119, 15 C. C. A. 303; *Harvey Steel Co. v. U. S.*, 38 Ct. Cl. 662.

60. *May v. Juneau County*, 30 Fed. 241; *Bryce v. Dorr*, 4 Fed. Cas. No. 2,070, 3 McLean 582, 2 Robb Pat. Cas. 302; *Stow v. Chicago*, 23 Fed. Cas. No. 13,512, 3 Ban. & A. 83, 8 Biss. 47 [*affirmed* in 104 U. S. 547, 26 L. ed. 816].

Release of contractor releases employer. *Bigelow v. Louisville*, 25 Fed. Cas. No. 1,400, 3 Fish. Pat. Cas. 602.

Where employer is licensee contractor is released. *Union Switch, etc., Co. v. Johnson R. Signal Co.*, 52 Fed. 867 [*reversed* on other grounds in 55 Fed. 487, 5 C. C. A. 204].

Both liable where both have knowledge see *Palmer v. Landphere*, 118 Fed. 52.

61. *People v. Remington*, 126 N. Y. 654, 27 N. E. 853 [*affirming* 59 Hun 282, 12 N. Y. Suppl. 824, 14 N. Y. Suppl. 98].

62. *Preston v. Smith*, 156 Ill. 359, 40 N. E. 949; *American Merchants' Mfg. Co. v. Kantrowitz*, 77 Ill. App. 155; *American Mach., etc., Co. v. Stewart*, 115 La. 188, 38 So. 960; *Stewart Mfg. Co. v. Iron Clad Mfg. Co.*, 67 N. J. L. 577, 52 Atl. 391; *Scheurle v. Husbands*, 65 N. J. L. 40, 46 Atl. 759; *Hyatt v. Ingalls*, 124 N. Y. 93, 26 N. E. 285; *Guggenheim v. Kirchofer*, 66 Fed. 755, 14 C. C. A. 72; *Washburn, etc., Mfg. Co. v. Cincinnati Barbed-Wire Fence Co.*, 42 Fed. 675; *Wash-*



for an accounting may be joined with a demand for equitable relief by forfeiture of the license.<sup>63</sup> State courts have jurisdiction of an action to recover royalties under an agreement where there is no question as to the validity of the patent.<sup>64</sup>

**C. Enforcement of Assignments, Contracts, and Agreements.** A court of equity will enforce the rights of parties under a contract or agreement relating to patent rights by making appropriate orders in the same manner as under other agreements.<sup>65</sup> It is held that the ordinary rules of practice and procedure

burn, etc., *Mfg. Co. v. Freeman Wire Co.*, 41 Fed. 410; *Moxon v. Bright*, L. R. 4 Ch. 292, 20 L. T. Rep. N. S. 961; *Kernot v. Potter*, 3 De G. F. & J. 447, 64 Eng. Ch. 350, 45 Eng. Reprint 951.

Facts entitling plaintiff to royalty must be shown. *Meyer v. Saul*, 82 Md. 459, 33 Atl. 539; *Stewart Mfg. Co. v. Iron Clad Mfg. Co.*, 67 N. J. L. 577, 52 Atl. 391; *Russell v. U. S.*, 35 Ct. Cl. 154.

May sue for breach or for infringement see *Kilburn v. Holmes*, 121 Fed. 750, 58 C. C. A. 116; *Starling v. St. Paul Plow-Works*, 32 Fed. 290; *Cohn v. National Rubber Co.*, 6 Fed. Cas. No. 2,968, 3 Ban. & A. 568, 15 Off. Gaz. 829; *England v. Thompson*, 8 Fed. Cas. No. 4,487, 3 Cliff. 271; *Magic Ruffle Co. v. Elm City Co.*, 16 Fed. Cas. No. 8,949, 2 Ban. & A. 152, 13 Blatchf. 151, 8 Off. Gaz. 773; *Woodworth v. Weed*, 30 Fed. Cas. No. 18,022, 1 Blatchf. 165, Fish. Pat. Rep. 108. But see *Consolidated Middlings Purifier Co. v. Wolf*, 28 Fed. 814.

Invalidity of patent is no defense. *Rhodes v. Ashurst*, 176 Ill. 351, 52 N. E. 118; *Jones v. Burnham*, 67 Me. 93, 24 Am. Rep. 10; *Hall Mfg. Co. v. American R. Supply Co.*, 48 Mich. 331, 12 N. W. 205; *Clark v. Amoskeag Mfg. Co.*, 62 N. H. 612; *Warwick v. Stockton*, (N. J. Ch. 1897) 37 Atl. 458; *Hyatt v. Ingalls*, 49 N. Y. Super. Ct. 375; *Baylis v. Bullock Electric Mfg. Co.*, 32 Misc. (N. Y.) 218, 66 N. Y. Suppl. 253 [reversed on other grounds in 59 N. Y. App. Div. 576, 69 N. Y. Suppl. 693]; *McGill v. Holmes*, 64 N. Y. Suppl. 787; *Brusie v. Peck*, 16 N. Y. Suppl. 648; *Edison Gen. Electric Co. v. Thackara Mfg. Co.*, 167 Pa. St. 530, 31 Atl. 856; *Ingraham v. Schaum*, 157 Pa. St. 88, 27 Atl. 404; *Patterson's Appeal*, 99 Pa. St. 521; *Marsh v. Harris Mfg. Co.*, 63 Wis. 276, 22 N. W. 516; *Eureka Clothes Wringing Mach. Co. v. Bailey Washing, etc., Mach. Co.*, 11 Wall. (U. S.) 488, 20 L. ed. 209; *Moore v. National Water-Tube Boiler Co.*, 84 Fed. 346; *Godell v. Wells, etc., Co.*, 70 Fed. 319.

Burden of proof see *Bennett v. Iron Clad Mfg. Co.*, 121 N. Y. App. Div. 133, 105 N. Y. Suppl. 593.

Weight and sufficiency of evidence see *Bennett v. Iron Clad Mfg. Co.*, 121 N. Y. App. Div. 133, 105 N. Y. Suppl. 593.

Question for jury see *Gaylord v. Case*, 5 Ohio Dec. (Reprint) 413, 5 Am. L. Rec. 494.

Right of appeal where infringement or validity involved see *St. Paul Plow-Works v. Starling*, 127 U. S. 376, 8 S. Ct. 1327, 32 L. ed. 251.

Review on appeal see *Hyatt v. Ingalls*, 124 N. Y. 93, 26 N. E. 285 [affirming 55 N. Y. Super. Ct. 507, 2 N. Y. Suppl. 727]; *U. S. v.*

*Berdan Firearms Mfg. Co.*, 156 U. S. 552, 15 S. Ct. 420, 39 L. ed. 530.

Procedure before referee see *Hyatt v. Mark*, 55 N. Y. Super. Ct. 507, 2 N. Y. Suppl. 727 [affirmed in 124 N. Y. 93, 26 N. E. 285].

63. *Eclipse Bicycle Co. v. Farrow*, 16 App. Cas. (D. C.) 468; *Hyatt v. Ingalls*, 124 N. Y. 93, 26 N. E. 285 [affirming 55 N. Y. Super. Ct. 507, 2 N. Y. Suppl. 727]; *Adams v. Meyerose*, 7 Fed. 208, 2 McCrary 360; *Woodworth v. Weed*, 30 Fed. Cas. No. 18,022, 1 Blatchf. 165, Fish. Pat. Rep. 108; *Ashworth v. Roberts*, 45 Ch. D. 623, 60 L. J. Ch. 27, 63 L. T. Rep. N. S. 160, 39 Wkly. Rep. 170; *Haddan v. Smith*, 11 Jur. 959, 17 L. J. Ch. 43, 16 Sim. 42, 39 Eng. Ch. 42, 60 Eng. Reprint 788. And see *Eclipse Bicycle Co. v. Farrow*, 23 App. Cas. (D. C.) 411 [reversed in part in 199 U. S. 581, 26 S. Ct. 150, 50 L. ed. 317].

Discovery, injunction, and account see *Ball Glove Fastening Co. v. Ball, etc., Fastener Co.*, 36 Fed. 309; *McKay v. Smith*, 29 Fed. 295 [affirmed in 164 U. S. 701, 17 S. Ct. 1001, 41 L. ed. 1180].

Equity interferes only where remedy at law inadequate see *Washburn, etc., Mfg. Co. v. Cincinnati Barbed-Wire Fence Co.*, 42 Fed. 675; *Washburn, etc., Mfg. Co. v. Freeman*, 41 Fed. 410.

64. *Peck v. Bacon*, 18 Conn. 377; *Bull v. Pratt*, 1 Conn. 342; *Rhodes v. Ashurst*, 176 Ill. 351, 52 N. E. 118; *Havana Press Drill Co. v. Ashurst*, 148 Ill. 115, 35 N. E. 873; *Illinois Watch Case Co. v. Ecaubert*, 75 Ill. App. 418; *Hunt v. Hoover*, 24 Iowa 231; *Binney v. Annan*, 107 Mass. 94, 9 Am. Rep. 10; *Continental Store Service Co. v. Clark*, 100 N. Y. 365, 3 N. E. 335; *Snow v. Judson*, 38 Barb. (N. Y.) 210; *Darst v. Brockway*, 11 Ohio 462; *Standard Combustion Co. v. Farr*, 9 Ohio Dec. (Reprint) 509, 14 Cine. L. Bul. 201; *Hubbard v. Allen*, 123 Pa. St. 198, 16 Atl. 772; *Wade v. Lawder*, 165 U. S. 624, 17 S. Ct. 425, 41 L. ed. 851; *Marsh v. Nichols*, 140 U. S. 344, 11 S. Ct. 798, 35 L. ed. 413; *Walter A. Wood Mowing, etc., Mach. Co. v. Skinner*, 139 U. S. 293, 11 S. Ct. 528, 35 L. ed. 193; *Felix v. Scharnweber*, 125 U. S. 54, 8 S. Ct. 759, 31 L. ed. 687; *Dale Tile Mfg. Co. v. Hyatt*, 125 U. S. 46, 8 S. Ct. 756, 31 L. ed. 683; *Albright v. Teas*, 106 U. S. 613, 1 S. Ct. 550, 27 L. ed. 295; *Wilson v. Sandford*, 10 How. (U. S.) 99, 13 L. ed. 344; *Blanchard v. Sprague*, 3 Fed. Cas. No. 1,516, 1 Cliff. 288; *Goodyear v. Day*, 10 Fed. Cas. No. 5,568, 1 Blatchf. 565, Fish. Pat. Rep. 385.

65. Specific performance see *Manvel v. Holdredge*, 45 N. Y. 151; *Maugham v. Parkes Sewing Mach. Co.*, 69 N. Y. App. Div. 609, 74 N. Y. Suppl. 689; *Leicester, etc., Mills Co.*



apply.<sup>66</sup> State courts have jurisdiction where there is no question of infringement or validity of the patents.<sup>67</sup>

## XII. REGULATION OF DEALINGS IN PATENT RIGHTS AND PATENTED ARTICLES.

**A. By Congress — 1. FAILURE TO MARK PATENTED ARTICLES.** Patentees are required to give notice that their articles are patented by placing a notice to that effect upon the articles or upon the package containing them.<sup>68</sup> In the absence

*v. Macon Knitting Co.*, 116 Fed. 196, 53 C. C. A. 621; *Foster v. Goldschmidt*, 21 Fed. 70; *Wood v. Wells*, 30 Fed. Cas. No. 17,967, 6 Fish. Pat. Cas. 382.

When specific performance refused see *Kennedy v. Hazelton*, 128 U. S. 667, 9 S. Ct. 202, 32 L. ed. 576.

Suit to annul see *Backus Portable Steam Heater Co. v. Simonds*, 2 App. Cas. (D. C.) 290; *American Street Car Advertising Co. v. Jones*, 122 Fed. 803 [reversed on other grounds in 142 Fed. 974, 74 C. C. A. 236]; *Patton v. Glatz*, 56 Fed. 367.

Injunction granted see *Ball, etc., Fastener Co. v. Patent Button Co.*, 136 Fed. 272; *Waterman v. Shipman*, 55 Fed. 982, 5 C. C. A. 371; *Goddard v. Wilde*, 17 Fed. 845; *Day v. Hartshorn*, 7 Fed. Cas. No. 3,683, 3 Fish. Pat. Cas. 32; *Singer Sewing-Mach. Co. v. Union Button-Hole, etc., Co.*, 22 Fed. Cas. No. 12,904, 6 Fish. Pat. Cas. 480, *Holmes* 253, 4 Off. Gaz. 553; *Wilson v. Sherman*, 30 Fed. Cas. No. 17,833, 1 Blatchf. 536, Fish. Pat. Rep. 361.

Injunction refused see *Henderson v. Dougherty*, 95 N. Y. App. Div. 346, 88 N. Y. Suppl. 665; *Brunner v. Kaempfer*, 2 N. Y. App. Div. 177, 37 N. Y. Suppl. 700; *Young Reversible Lock-Nut Co. v. Young Lock-Nut Co.*, 66 Fed. 563; *Adams, etc., Mfg. Co. v. Westlake*, 53 Fed. 588; *Pope Mfg. Co. v. Johnson*, 40 Fed. 584; *Aspinwall Mfg. Co. v. Gill*, 32 Fed. 702; *Washburn, etc., Mfg. Co. v. Cincinnati Barbed-Wire Fence Co.*, 22 Fed. 712; *Baker Mfg. Co. v. Washburn, etc., Mfg. Co.*, 18 Fed. 172, 5 McCrary 504; *Crowell v. Parmenter*, 6 Fed. Cas. No. 3,446, 3 Ban. & A. 480, 18 Off. Gaz. 360; *Florence Sewing-Mach. Co. v. Singer Mfg. Co.*, 9 Fed. Cas. No. 4,884, 8 Blatchf. 113, 4 Fish. Pat. Cas. 329; *Smith v. Cummings*, 22 Fed. Cas. No. 13,034, 1 Fish. Pat. Cas. 152; *Wilson v. Sherman*, 30 Fed. Cas. No. 17,833, 1 Blatchf. 536, Fish. Pat. Rep. 361. Where there is an adequate remedy at law equity will not interfere. *Crandall v. Plano Mfg. Co.*, 24 Fed. 738; *Perkins v. Hendryx*, 23 Fed. 418; *Baker Mfg. Co. v. Washburn, etc., Mfg. Co.*, *supra*.

66. Parties see *Backus Portable Steam Heater Co. v. Simonds*, 2 App. Cas. (D. C.) 290; *Rogers v. Riessner*, 30 Fed. 525; *Florence Sewing-Mach. Co. v. Singer Mfg. Co.*, 9 Fed. Cas. No. 4,884, 8 Blatchf. 113, 4 Fish. Pat. Cas. 329.

Pleading see *Ralya v. Atkins*, 157 Ind. 331, 61 N. E. 726; *Torrent v. Rodgers*, 39 Mich. 85; *Dalzell v. Fahy's Watch Case Co.*, 138 N. Y. 285, 33 N. E. 1071; *Marsh v. Dodge*, 5 Lans. (N. Y.) 541; *Smith v. Standard Laundry Mach. Co.*, 11 Daly (N. Y.) 154; *Wilcox, etc., Sewing Mach. Co. v. Himes*, 21 N. Y. Suppl. 160; *Dancel v. United Shoe Mach. Co.*,

120 Fed. 839; *White v. Lee*, 4 Fed. 916; *Theberath v. Celluloid Mfg. Co.*, 3 Fed. 143.

Evidence see *Brusie v. Peck*, 135 N. Y. 622, 32 N. E. 76; *Marsh v. Dodge*, 5 Lans. (N. Y.) 541; *Hubbard v. Allen*, 123 Pa. St. 198, 16 Atl. 772; *St. Paul Plow-Works v. Starling*, 140 U. S. 184, 11 S. Ct. 803, 35 L. ed. 404; *Rogers v. Riessner*, 34 Fed. 270.

67. *Rhodes v. Ashurst*, 176 Ill. 351, 52 N. E. 118; *Illinois Watch Case Co. v. Ecaubert*, 75 Ill. App. 418 [affirmed in 177 Ill. 587, 52 N. E. 861]; *Standard Combustion Co. v. Farr*, 9 Ohio Dec. (Reprint) 509, 14 Cinc. L. Bul. 201. See also *supra*, XI, B, 1, e.

68. U. S. Rev. St. (1878) § 4900 [U. S. Comp. St. (1901) p. 3388].

Sufficiency of notice see *Dunlap v. Schofield*, 152 U. S. 244, 14 S. Ct. 576, 38 L. ed. 426; *Sessions v. Romadka*, 145 U. S. 29, 12 S. Ct. 799, 36 L. ed. 609; *Inman Mfg. Co. v. Beach*, 71 Fed. 420, 18 C. C. A. 165.

Marking is legal notice to all. *Hogg v. Gimbel*, 94 Fed. 518.

The article and not merely the package must be marked where possible. *Smith v. Walton*, 51 Fed. 17; *Sessions v. Romadka*, 21 Fed. 124.

Particular part of article for notice is immaterial.—*Dade v. Boorum, etc., Co.*, 121 Fed. 135.

Patented processes are not within the requirement. *U. S. Mitis Co. v. Midvale Steel Co.*, 135 Fed. 103; *U. S. Mitis Co. v. Carnegie Steel Co.*, 89 Fed. 206 [affirmed in 90 Fed. 829, 33 C. C. A. 387].

Where patentee has not made and sold articles under his patent the requirement does not apply. *Ewart Mfg. Co. v. Baldwin Cycle-Chain Co.*, 91 Fed. 262; *Campbell v. New York*, 81 Fed. 182.

Date.—Notice must include date. *Traver v. Brown*, 62 Fed. 933 [reversed on other grounds in 70 Fed. 810, 17 C. C. A. 424]; *Hawley v. Bagley*, 11 Fed. Cas. No. 6,248.

Excuse for not marking is immaterial. *Putnam v. Sudhoff*, 20 Fed. Cas. No. 11,483, 1 Ban. & A. 198.

Burden of proof.—The burden is on defendant to show absence of mark. *Providence Rubber Co. v. Goodyear*, 9 Wall. (U. S.) 788, 19 L. ed. 566; *U. S. Printing Co. v. American Playing-Card Co.*, 70 Fed. 50; *Schofield v. Dunlop*, 42 Fed. 323; *Goodyear v. Allyn*, 10 Fed. Cas. No. 5,555, 6 Blatchf. 33, 3 Fish. Pat. Cas. 374. *Contra*, *Matthews, etc., Mfg. Co. v. National Brass, etc., Works*, 71 Fed. 518; *National Co. v. Belcher*, 68 Fed. 665 [modified in 71 Fed. 876, 18 C. C. A. 375].

Complainant must allege marking see *Sprague v. Bramhall-Deane Co.*, 133 Fed. 738.



of such notice on the article no damages can be collected except where the infringer continues after actual notice.<sup>69</sup>

**2. MARKING UNPATENTED ARTICLE.** Parties are prohibited by statute from marking articles for which they have not obtained a patent with any mark indicating that they are patented,<sup>70</sup> and are prohibited from marking articles patented by another with any mark in imitation of the name or marks of the real patentee.<sup>71</sup>

**3. PENALTIES — a. In General.** For such wrongful marking of articles the guilty party is liable to a penalty of not less than one hundred dollars with costs for every offense, one half of such penalty going to the party who shall sue for the same and the other to the United States.<sup>72</sup>

**Canada.**—Must mark subject to penalty of one hundred dollars. St. 38 Vict. c. 14, § 3.

**69. Must prove actual notice.**—*Dunlap v. Schofield*, 152 U. S. 244, 14 S. Ct. 576, 38 L. ed. 426; *Pairpoint Mfg. Co. v. Eldridge Co.*, 71 Fed. 307.

**Sufficiency of actual notice** see U. S. Mitis Co. v. Midvale Steel Co., 135 Fed. 103; *Jennings v. Rogers Silver Plate Co.*, 96 Fed. 340; *Thompson v. N. T. Bushnell Co.*, 96 Fed. 238, 37 C. C. A. 456; *Ryan v. Newark Spring Mattress Co.*, 96 Fed. 160; *New York Pharmaceutical Assoc. v. Tilden*, 14 Fed. 740, 21 Blatchf. 190.

**Recovery limited to infringement after notice** see *Allen v. Deacon*, 21 Fed. 122; *Putnam v. Sudhoff*, 20 Fed. Cas. No. 11,483, 1 Ban. & A. 198.

**When some articles marked and some not marked only nominal damages are recoverable.** *B. B. Hill Mfg. Co. v. Stewart*, 116 Fed. 927.

**Right to injunction.**—Absence of notice affects damages only and not right to injunction. *McDowell v. Kurtz*, 77 Fed. 206, 23 C. C. A. 119; *Horn v. Bergner*, 68 Fed. 428 [*affirmed* in 72 Fed. 687]; *Anderson v. Monroe*, 55 Fed. 398 [*reversed* on other grounds in 58 Fed. 398, 7 C. C. A. 272]; *Goodyear v. Allyn*, 10 Fed. Cas. No. 5,555, 6 Blatchf. 33, 3 Fish. Pat. Cas. 374.

**70. U. S. Rev. St. (1878) § 4901** [U. S. Comp. St. (1901) p. 3388].

**Intent to deceive is necessary in order to create offense.** *Bowman v. Read*, 2 Wall. (U. S.) 591, 17 L. ed. 812; *A. B. Dick Co. v. Fuerth*, 57 Fed. 834; *Hotchkiss v. Samuel Cupples Wooden-Ware Co.*, 53 Fed. 1018; *Lawrence v. Holmes*, 45 Fed. 357; *Tompkins v. Butterfield*, 25 Fed. 556; *Nichols v. Newell*, 18 Fed. Cas. No. 10,245, 1 Fish. Pat. Cas. 647; *Stephens v. Caldwell*, 22 Fed. Cas. No. 13,367; *Walker v. Hawxhurst*, 29 Fed. Cas. No. 17,071, 5 Blatchf. 494.

**Marking after application but before payment may or may not constitute offense according to intent.** *Lauferty v. Wheeler*, 11 Daly (N. Y.) 194; *Nichols v. Newell*, 18 Fed. Cas. No. 10,245, 1 Fish. Pat. Cas. 647; *Stephens v. Caldwell*, 22 Fed. Cas. No. 13,367.

**Expiration of patent on device does not create offense.** *Wilson v. Singer Mfg. Co.*, 30 Fed. Cas. No. 17,836, 4 Ban. & A. 637, 9 Biss. 173, 16 Off. Gaz. 1091, 9 N. Y. Wkly. Dig. 338 [*affirmed* in 12 Fed. 57, 11 Biss. 298].

**Actual sale of article is not necessary.** *Nichols v. Newell*, 18 Fed. Cas. No. 10,245, 1 Fish. Pat. Cas. 647.

**Whether the things marked are of such a nature as to be capable of being patented bears simply upon intent to deceive.** *Winne v. Snow*, 19 Fed. 507; *Oliphant v. Salem Flouring Mills Co.*, 18 Fed. Cas. No. 10,486, 3 Ban. & A. 256, 5 Sawy. 128; *U. S. v. Morris*, 26 Fed. Cas. No. 15,814, 2 Bond 23, 3 Fish. Pat. Cas. 72.

**Marking "Patent Applied For" is permissible.** *A. B. Dick Co. v. Fuerth*, 57 Fed. 834; *Schwebel v. Bothe*, 40 Fed. 478.

**71. U. S. Rev. St. (1878) § 4901** [U. S. Comp. St. (1901) p. 3388].

**Article must be covered by the patent** see *Russell v. Newark Mach. Co.*, 55 Fed. 297; *French v. Foley*, 11 Fed. 801.

**Injunction.**—Patentee may obtain injunction. *Stimpson Computing Scale Co. v. W. F. Stimpson Co.*, 104 Fed. 893, 44 C. C. A. 241; *Washburn, etc., Mfg. Co. v. Haish*, 29 Fed. Cas. No. 17,217, 4 Ban. & A. 571, 9 Biss. 141, 18 Off. Gaz. 465.

**Invalidity of the patent is no defense for marking without patentee's consent.** *Myers v. Baker*, 3 H. & N. 802, 28 L. J. Exch. 90, 7 Wkly. Rep. 66.

**72. U. S. Rev. St. (1878) § 4901** [U. S. Comp. St. (1901) p. 3388].

**Canada.**—Penalty two hundred dollars or imprisonment for six months or both. St. 35 Vict. c. 26, § 50.

**Offense committed** see *Nichols v. Newell*, 18 Fed. Cas. No. 10,245, 1 Fish. Pat. Cas. 647; *Oliphant v. Salem Flouring Co.*, 18 Fed. Cas. No. 10,486, 3 Ban. & A. 256, 5 Sawy. 128.

**Offense not committed** see *Russell v. Newark Mach. Co.*, 55 Fed. 297; *Wilson v. Singer Mfg. Co.*, 12 Fed. 57, 11 Biss. 298.

**The amount of the penalty is one hundred dollars and no more.** *Stimpson v. Pond*, 23 Fed. Cas. No. 13,455, 2 Curt. 502. *Compare Nichols v. Newell*, 18 Fed. Cas. No. 10,245, 1 Fish. Pat. Cas. 647.

**Single offense may include marking of a number of articles at the same time.** *Hoyt v. Computing Scale Co.*, 96 Fed. 250; *Hotchkiss v. Samuel Cupples Wooden-Ware Co.*, 53 Fed. 1018.

**Where the patentee has failed to mark his own articles "patented" it is held that the patentee cannot recover the penalty.** *Smith v. Walton*, 56 Fed. 499; *Smith v. Walton*, 51 Fed. 17.



**b. Infringement of Design Patents.** One who knowingly infringes a design patent is liable in the amount of at least two hundred and fifty dollars and if his profits are greater he is liable for the excess.<sup>73</sup> The owner of the patent may recover the amount at law or in equity.<sup>74</sup>

**B. By States.** The owner of a patent himself cannot make and sell his patented articles in violation of the laws of the state prescribed for the general welfare.<sup>75</sup> The right conferred by statute to make, use, and vend his invention throughout the United States and the territories thereof is not granted or secured without reference to the general powers which the several states of the Union unquestionably possess over their purely domestic affairs, whether of internal commerce or police.<sup>76</sup> The manufacture and sale of patented articles is subject to state legislation enacted in pursuance of the police power inherent in the state,<sup>77</sup> to the taxing power of the states,<sup>78</sup> if there is no discrimination in such taxation as between the patented article and the sale of other similar articles in the state,<sup>79</sup> and a license-fee can be required for selling in the state patented articles.<sup>80</sup> With respect to the power of states to regulate the transfer or sale of patent rights themselves, there is a very considerable conflict of authority. In a large number

The informer, although without interest, brings suit in his own name and not in the name of the United States. *Winne v. Snow*, 19 Fed. 507; *U. S. v. Morris*, 26 Fed. Cas. No. 15,814, 2 Bond 23, 3 Fish. Pat. Cas. 72.

**Where suit brought.**—Suits must be brought in the district where offense committed. *Winne v. Snow*, 19 Fed. 507; *Pentlarge v. Kirby*, 19 Fed. 501.

**Allegations.**—Essential facts must be alleged, but not necessarily the day stamping was done. *Fish v. Manning*, 31 Fed. 340.

**Intent** is a question for the jury. *Walker v. Hawxhurst*, 29 Fed. Cas. No. 17,071, 5 Blatchf. 494.

**Statute strictly construed** see *Pentlarge v. Kirby*, 19 Fed. 501.

**Proofs strictly construed** see *Hawloetz v. Kass*, 25 Fed. 765 [*affirmed* in 136 U. S. 638, 10 S. Ct. 1068, 34 L. ed. 549]; *Hawley v. Bagley*, 11 Fed. Cas. No. 6,248.

73. Act Feb. 4, 1887, 24 U. S. St. at L. 387 [U. S. Comp. St. (1901) p. 3398]; *Frank v. Geiger*, 121 Fed. 126.

**Infringement must be wilful after notice.**—See *Fuller v. Field*, 82 Fed. 813, 27 C. C. A. 165; *Monroe v. Anderson*, 58 Fed. 398, 7 C. C. A. 272.

**Infringement of several claims in one patent constitutes only one offense.** *Gimbel v. Hogg*, 97 Fed. 791, 38 C. C. A. 419.

**Sufficiency of notice.**—Marking patented articles is not such notice as will make infringer's act one after notice. *Gimbel v. Hogg*, 97 Fed. 791, 38 C. C. A. 419.

74. See *infra*, XIII, C, 12, a, (III).

75. *Livingston v. Van Ingen*, 9 Johns. (N. Y.) 507; *Jordan v. Dayton*, 4 Ohio 294; *Bement v. National Harrow Co.*, 186 U. S. 70, 22 S. Ct. 747, 46 L. ed. 1058; *Webber v. Virginia*, 103 U. S. 344, 26 L. ed. 565; *Patterson v. Kentucky*, 97 U. S. 501, 24 L. ed. 1115; *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288, 25 C. C. A. 267, 35 L. R. A. 728, 78 Off. Gaz. 171; *In re Brosnahan*, 18 Fed. 62, 4 McCrary 1.

**Sale of patent rights and patented articles distinguished.**—There is a manifest distinction

between the right of property in the patent, which carries with it the power on the part of the patentee to assign it, and the right to sell the property resulting from the invention or patent. When the fruits of the invention or the article made by reason of the application of the principle discovered is attempted to be sold or used within the jurisdiction of a state, it is subject to its laws, like other property. *Patterson v. Com.*, 11 Bush (Ky.) 311, 21 Am. Rep. 220 [*affirmed* in 97 U. S. 501, 24 L. ed. 1115].

76. *Patterson v. Kentucky*, 97 U. S. 501, 24 L. ed. 1115.

77. *In re Opinion of Justices*, 193 Mass. 605, 81 N. E. 142; *Webber v. Virginia*, 103 U. S. 344, 347, 26 L. ed. 565 (in which it was said: "Congress never intended that the patent laws should displace the police powers of the States, meaning by that term those powers by which the health, good order, peace, and general welfare of the community are promoted. Whatever rights are secured to inventors must be enjoyed in subordination to this general authority of the State over all property within its limits"); *Patterson v. Kentucky*, 97 U. S. 501, 24 L. ed. 1115; *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288, 25 C. C. A. 267, 35 L. R. A. 728, 78 Off. Gaz. 171.

78. *Palmer v. State*, 39 Ohio St. 236, 48 Am. Rep. 429; *State v. Bell Tel. Co.*, 36 Ohio St. 296, 38 Am. Rep. 583; *Webber v. Virginia*, 103 U. S. 344, 26 L. ed. 565; *In re Sheffield*, 64 Fed. 833.

79. *Palmer v. State*, 39 Ohio St. 236, 48 Am. Rep. 429. To the same effect see *In re Sheffield*, 64 Fed. 833.

A law imposing a fee only in case the articles are made outside of the state is invalid as subjecting them to a discriminating regulation or burden. *Webber v. Virginia*, 103 U. S. 344, 26 L. ed. 565.

80. *People v. Russell*, 49 Mich. 617, 14 N. W. 568, 43 Am. Rep. 478, 25 Off. Gaz. 504; *Webber v. Virginia*, 103 U. S. 344, 26 L. ed. 565. *Contra*, *State v. Butler*, 3 Lea (Tenn.), 222.



of cases, both state and federal, the right has been upheld,<sup>81</sup> while in others, both state and federal, the constitutionality of such regulations has been denied,<sup>82</sup> and it has been held that a license-tax cannot be imposed upon the right to vend patent rights.<sup>83</sup> In a very recent decision of the United States supreme court, however, it was held that a "state has the power, certainly until congress legislates upon the subject, with regard to the provision which shall accompany the sale or assignment of rights arising under a patent, to make reasonable regulations concerning the subject, calculated to protect its citizens from fraud," and a state law providing that before barter or sale of patent rights an authenticated copy of the letters patent and the authority of the vendor to sell the right patented shall be filed in the office of the county within which the rights were sold was sustained as a reasonable regulation.<sup>84</sup> And in another recent decision of that court the validity of a state statute making void a note given for a patent, if the note fails to show on its face for what it was given, was upheld.<sup>85</sup>

81. *Arkansas*.—*Tilson v. Gatling*, 60 Ark. 114, 29 S. W. 35.

*Indiana*.—*Sandage v. Studabaker Bros. Mfg. Co.*, 142 Ind. 148, 41 N. E. 380, 51 Am. St. Rep. 165, 34 L. R. A. 363; *Mayfield v. Sears*, 133 Ind. 86, 32 N. E. 816; *Hankey v. Downey*, 116 Ind. 118, 18 N. E. 271, 1 L. R. A. 447; *New v. Walker*, 108 Ind. 365, 9 N. E. 386, 58 Am. Rep. 40; *Brechbill v. Randall*, 102 Ind. 528, 1 N. E. 362, 52 Am. Rep. 695 [*overruling Grover, etc., Sewing Mach. Co. v. Butler*, 53 Ind. 454, 21 Am. Rep. 200]. *Contra*, *Helm v. Huntington First Nat. Bank*, 43 Ind. 167, 13 Am. Rep. 395.

*Kansas*.—*Nyhart v. Kubach*, 76 Kan. 154, 90 Pac. 796; *Allen v. Riley*, 71 Kan. 378, 80 Pac. 952, 114 Am. St. Rep. 481 [*affirmed* in 203 U. S. 347, 27 S. Ct. 95, 51 L. ed. 216]; *Mason v. McLeod*, 57 Kan. 105, 45 Pac. 76, 57 Am. St. Rep. 327, 41 L. R. A. 548.

*Ohio*.—*Tod v. Wick*, 36 Ohio St. 370.

*Pennsylvania*.—*Graham's Estate*, 14 Phila. 280.

*United States*.—*Reeves v. Corning*, 51 Fed. 774. And see cases cited *infra*, this note.

**Instances.**—A state may require that notes given for patent rights be marked to indicate the fact. *Pinney v. Concordia First Nat. Bank*, 68 Kan. 223, 75 Pac. 119; *Mason v. McLeod*, 57 Kan. 105, 45 Pac. 76, 57 Am. St. Rep. 327, 41 L. R. A. 548; *Rumbley v. Hall*, 107 Ky. 349, 54 S. W. 4, 21 Ky. L. Rep. 1071; *Nunn v. Citizens' Bank*, 107 Ky. 262, 53 S. W. 665, 21 Ky. L. Rep. 961; *Bohon v. Brown*, 101 Ky. 354, 41 S. W. 273, 19 Ky. L. Rep. 540, 72 Am. St. Rep. 420, 38 L. R. A. 503; *Herdie v. Roessler*, 39 Hun (N. Y.) 198 [*affirmed* in 109 N. Y. 127, 16 N. E. 198]; *Shires v. Com.*, 120 Pa. St. 368, 14 Atl. 251; *Haskell v. Jones*, 86 Pa. St. 173; *State v. Cook*, 107 Tenn. 409, 64 S. W. 720, 62 L. R. A. 174. So the state may require the filing of a copy of the patent and an affidavit as to its genuineness. *New v. Walker*, 108 Ind. 365, 9 N. E. 386, 58 Am. Rep. 40; *Brechbill v. Randall*, 102 Ind. 528, 1 N. E. 362, 52 Am. Rep. 695.

**What constitutes sale of patent right.**—A contract by which the owner of a patent right conveys to another the exclusive right to sell the patented article within certain

prescribed territory for a term of years is a sale of such an interest in a patent right as brings the transaction within Gen. St. (1901) §§ 4356-4358, relating to the registration and sale of patent rights, and prescribing a penalty for the violation thereof. *Nyhart v. Kubach*, 76 Kan. 154, 90 Pac. 796. A territorial lease and appointment of agency giving the party of the second part six sample machines and the agency for the sale of the same for a term of years, the company agreeing to furnish all machines ordered by the agent at a certain fixed price, is a contract for the sale of a patent right within Gen. St. (1901) §§ 4356-4358. *Nyhart v. Kubach*, *supra*.

82. *Illinois*.—*Hollida v. Hunt*, 70 Ill. 109, 22 Am. Rep. 63.

*Michigan*.—*People v. Russell*, 49 Mich. 617, 14 N. W. 568, 43 Am. Rep. 478, 25 Off. Gaz. 504; *Cransen v. Smith*, 37 Mich. 309, 26 Am. Rep. 514.

*Minnesota*.—*Crittenden v. White*, 23 Minn. 24, 23 Am. Rep. 676.

*Nebraska*.—*Wilch v. Phelps*, 14 Nebr. 134, 15 N. W. 361.

*Wisconsin*.—*State v. Lockwood*, 43 Wis. 403.

*United States*.—*Rubber Tire Wheel Co. v. Milwaukee Rubber Works Co.*, 154 Fed. 358, 83 C. C. A. 336; *Ozan Lumber Co. v. Union County Nat. Bank*, 145 Fed. 344, 76 C. C. A. 218; *U. S. Consol. Seeded Raisin Co. v. Griffin, etc., Co.*, 126 Fed. 364, 61 C. C. A. 334; *Columbia Wire Co. v. Freeman Wire Co.*, 71 Fed. 302; *Castle v. Hutchinson*, 25 Fed. 394; *Ex p. Robinson*, 20 Fed. Cas. No. 11,932, 2 Biss. 309, 4 Fish. Pat. Cas. 186; *Woollen v. Banker*, 30 Fed. Cas. No. 18,030, 2 Flipp. 33, 5 Reporter 259, 17 Alb. L. J. (N. Y.) 72.

83. *Com. v. Petty*, 96 Ky. 452, 29 S. W. 291, 16 Ky. L. Rep. 488, 29 L. R. A. 786; *People v. Russell*, 49 Mich. 617, 14 N. W. 568, 43 Am. Rep. 478, 25 Off. Gaz. 504; *In re Sheffield*, 64 Fed. 833.

84. *Allen v. Riley*, 203 U. S. 347, 27 S. Ct. 95, 51 L. ed. 216 [*affirming* 71 Kan. 378, 80 Pac. 952, 114 Am. St. Rep. 481].

85. *Woods v. Carl*, 203 U. S. 358, 27 S. Ct. 99, 51 L. ed. 219 [*affirming* 75 Ark. 328, 87 S. W. 621].



XIII. INFRINGEMENT.<sup>86</sup>

**A. What Constitutes — 1. IN GENERAL.** The infringement of a patent is the unauthorized making, using, or selling of the invention during the life of the patent.<sup>87</sup> The use of what was old prior to the patentee's invention will not infringe.<sup>88</sup> The patent must be a valid one, otherwise there is no basis for a suit for infringement.<sup>89</sup>

**86. Enjoining libel or slander on patent** see INJUNCTIONS, 22 Cyc. 901.

**Use by the government** see *supra*, I, B, 4. **87. See cases cited *infra*, this note.**

**Authorization by owner.**—There is no infringement where the manufacture, use, or sale was authorized by the owner of the patent. *Holmes v. Kirkpatrick*, 133 Fed. 232, 66 C. C. A. 286; *Hanifen v. Lupton*, 101 Fed. 462, 41 C. C. A. 462; *American Graphophone Co. v. Talking-Mach. Co.*, 98 Fed. 729, 39 C. C. A. 245; *Pelzer v. Binghamton*, 95 Fed. 823, 37 C. C. A. 288; *Sprague Electric R., etc., Co. v. Nassau Electric R. Co.*, 95 Fed. 821, 37 C. C. A. 286; *Blakey v. National Mfg. Co.*, 95 Fed. 136, 37 C. C. A. 27; *Dibble v. Augur*, 7 Fed. Cas. No. 3879, 7 Blatchf. 86; *Jordan v. Dobson*, 13 Fed. Cas. No. 7,519, 2 Abb. 398, 4 Fish. Pat. Cas. 232, 7 Phila. (Pa.) 533.

**The giving away of infringing articles as premiums with other goods sold is in effect a sale, and constitutes infringement.** *Benbow-Brammer Mfg. Co. v. Heffron-Tanner Co.*, 144 Fed. 429.

**Equitable owner of the patent is not an unauthorized user.** *Clum v. Brewer*, 5 Fed. Cas. No. 2,909, 2 Curt. 506.

**Licensee may infringe by violating conditions.** *Hobbie v. Smith*, 27 Fed. 656.

**Refusal of patentee to furnish device does not authorize infringement.** *Masseth v. Reiber*, 59 Fed. 614.

**Importation.**—Importation of the invention is infringement. *Boesch v. Graff*, 133 U. S. 697, 10 S. Ct. 378, 33 L. ed. 787 [*reversing* 33 Fed. 279, 13 Savy. 17]; *Dickerson v. Tinning*, 84 Fed. 192, 28 C. C. A. 139; *Dickerson v. Matheson*, 57 Fed. 524, 6 C. C. A. 466; *Featherstone v. Ormonde Cycle Co.*, 53 Fed. 110; *Neilson v. Betts*, L. R. 5 H. L. 1, 40 L. J. Ch. 317, 19 Wkly. Rep. 1121; *Von Heyden v. Neustadt*, 14 Ch. D. 230, 50 L. J. Ch. 126, 42 L. T. Rep. N. S. 300, 28 Wkly. Rep. 496; *Emslie v. Boursier*, L. R. 9 Eq. 217, 39 L. J. Ch. 328, 18 Wkly. Rep. 665. Where patentee or his agent sells articles abroad they may be imported without infringement. *Holiday v. Mattheson*, 24 Fed. 185, 23 Blatchf. 239.

**One who purchases abroad from the patentee and imports is not an infringer.** *Betts v. Willmott*, L. R. 6 Ch. 239, 25 L. T. Rep. N. S. 188, 19 Wkly. Rep. 369; *Saccharin Corp. v. Reitmeyer*, [1900] 2 Ch. 659, 69 L. J. Ch. 761, 83 L. T. Rep. N. S. 397, 49 Wkly. Rep. 199.

**Shipping parts to foreign country for use there in making the invention is no infringement.** *Bullock Electric, etc., Co. v. Westing-*

*house Electric, etc., Co.*, 129 Fed. 105, 63 C. C. A. 607.

**Use on foreign vessel in port is not infringement.** *Brown v. Duchesne*, 19 How. (U. S.) 183, 15 L. ed. 595.

**Use on United States vessel at sea is infringement.** *Gardiner v. Howe*, 9 Fed. Cas. No. 5,219, 2 Cliff. 462.

**Use of armor on United States war vessel is not infringement.** *Heaton v. Quintard*, 11 Fed. Cas. No. 6,311, 7 Blatchf. 73.

**Use pending application is not infringement.** *Brill v. St. Louis Car Co.*, 80 Fed. 909.

**Selling article made on patented machine is not infringement.** *Simpson v. Wilson*, 4 How. (U. S.) 709, 11 L. ed. 1169.

**A mere agreement to buy infringing articles is no infringement.** *Keplinger v. De Young*, 10 Wheat. (U. S.) 358, 6 L. ed. 341.

**Use after expiration of patent is not infringement.** *Sawyer Spindle Co. v. Carpenter*, 133 Fed. 238 [*affirmed* in 143 Fed. 976, 75 C. C. A. 162].

**Selling after expiration of patent is not infringement.** *British Insulated Wire Co. v. Dublin United Tramways Co.*, [1900] 1 Ir. 287.

**In Canada the purchaser and user of articles made in derogation of the patent is an infringer.** *Toronto Auer Light Co. v. Colling*, 31 Ont. 18.

**88. Pope Mfg. Co. v. Gormully, etc., Mfg. Co.**, 144 U. S. 238, 12 S. Ct. 641, 36 L. ed. 419; *Jones v. Morehead*, 1 Wall. (U. S.) 155, 17 L. ed. 662; *McCormick v. Talcott*, 20 How. (U. S.) 402, 15 L. ed. 930; *Wilson v. Townley Shingle Co.*, 125 Fed. 491, 60 C. C. A. 327; *Marsh v. Quick-Meal Stove Co.*, 51 Fed. 203; *Challenge Corn-Planter Co. v. Gearhardt*, 46 Fed. 768; *Lee v. Upson, etc., Co.*, 42 Fed. 530; *Webster v. Ovens*, 39 Fed. 388; *Simon v. Neumann*, 20 Fed. 196; *Consolidated Safety-Valve Co. v. Kunkle*, 14 Fed. 732; *Adams, etc., Mfg. Co. v. St. Louis Wire-Goods Co.*, 1 Fed. Cas. No. 72, 3 Ban. & A. 77, 12 Off. Gaz. 940; *Byam v. Eddy*, 4 Fed. Cas. No. 2,263, 2 Blatchf. 521, 24 Vt. 666; *Rich v. Lippincott*, 20 Fed. Cas. No. 11,758, 2 Fish. Pat. Cas. 1, 1 Pittsb. (Pa.) 31; *Smith v. Clark*, 22 Fed. Cas. No. 13,027, *Brunn. Col. Cas.* 345; *Smith v. Higgins*, 22 Fed. Cas. No. 13,058.

**89. Johnston v. Woodbury**, 109 Fed. 567, 48 C. C. A. 550; *Swain v. Holyoke Mach. Co.*, 109 Fed. 154, 48 C. C. A. 265; *American Ordnance Co. v. Driggs-Seabury Gun, etc., Co.*, 109 Fed. 83, 48 C. C. A. 241; *Hoskins v. Matthes*, 108 Fed. 404, 47 C. C. A. 434; *Goss Printing-Press Co. v. Scott*, 108 Fed. 253, 47 C. C. A. 302; *Thomson-Houston Electric Co.*



**2. MAKING, USING, OR SELLING.** Infringement may consist either in making, using, or selling the invention, or in all three.<sup>90</sup>

**3. ARTICLE MADE BEFORE PATENT.** Any person who purchases of the inventor, or with his knowledge and consent, constructs an article embodying the invention prior to his application for patent has the right to use and sell the particular article after a patent is granted.<sup>91</sup>

**4. EXPERIMENTAL USE.**<sup>92</sup> The making of the patented invention for amusement or scientific investigation with no intent of using it practically is not an actionable infringement; but it is otherwise where the thing made is sold or put into actual use.<sup>93</sup>

*v. Nassau Electric R. Co.*, 107 Fed. 277, 46 C. C. A. 263; *Pelzer v. Dale Co.*, 106 Fed. 989, 46 C. C. A. 83; *Dodge Mfg. Co. v. Collins*, 106 Fed. 935, 46 C. C. A. 53; *Solvay Process Co. v. Michigan Alkali Co.*, 90 Fed. 818, 33 C. C. A. 285; *Chuse v. Ide*, 89 Fed. 491, 32 C. C. A. 260; *Antisdel v. Chicago Hotel Cabinet Co.*, 89 Fed. 308, 32 C. C. A. 216; *Kelly v. Clow*, 89 Fed. 297, 32 C. C. A. 205; *Talbot v. Fear*, 89 Fed. 197, 32 C. C. A. 186; *Clishy v. Reese*, 88 Fed. 645, 32 C. C. A. 80; *Eastman Co. v. Getz*, 84 Fed. 458, 28 C. C. A. 459; *Soehner v. Favorite Stove, etc., Co.*, 84 Fed. 182, 28 C. C. A. 317; *Dunbar v. Eastern Elevating Co.*, 81 Fed. 201, 26 C. C. A. 330; *Crossley v. Duggan*, 79 Fed. 992, 25 C. C. A. 681; *Matheson v. Campbell*, 78 Fed. 910, 24 C. C. A. 384.

90. *Birdsell v. Shaliol*, 112 U. S. 485, 5 S. Ct. 244, 28 L. ed. 768; *Tuttle v. Matthews*, 28 Fed. 98; *Carter v. Baker*, 5 Fed. Cas. No. 2,472, 4 Fish. Pat. Cas. 404, 1 Sawy. 512; *Haselden v. Ogden*, 11 Fed. Cas. No. 6,190, 3 Fish. Pat. Cas. 378.

**Making without use or sale is infringement.** *Carter Crume Co. v. American Sales Book Co.*, 124 Fed. 903; *Page Woven Wire Fence Co. v. Land*, 49 Fed. 936; *Ketchum Harvester Co. v. Johnson Harvester Co.*, 8 Fed. 586, 19 Blatchf. 367; *Bloomer v. Gilpin*, 3 Fed. Cas. No. 1,558, 4 Fish. Pat. Cas. 50; *Jenkins v. Greenwald*, 13 Fed. Cas. No. 7,270, 1 Bond 126, 2 Fish. Pat. Cas. 37; *Whitemore v. Cutter*, 29 Fed. Cas. No. 17,600, 1 Gall. 429, 1 Robb Pat. Cas. 28.

**Use for personal benefit or convenience is infringement without sale.** *Beedle v. Bennett*, 122 U. S. 71, 7 S. Ct. 1090, 30 L. ed. 1074; *United Nickel Co. v. Central Pac. R. Co.*, 36 Fed. 186; *Andrews v. Cross*, 8 Fed. 269, 19 Blatchf. 294.

A single sale is an infringement. *Hutter v. De Q. Bottle Stopper Co.*, 128 Fed. 283, 62 C. C. A. 652.

**Sale to agent of patentee is infringement.** *Chicago Pneumatic Tool Co. v. Philadelphia Pneumatic Tool Co.*, 118 Fed. 852.

**Sale by sheriff on execution is not an actionable infringement.** *Sawin v. Guild*, 21 Fed. Cas. No. 12,391, 1 Gall. 485, 1 Robb Pat. Cas. 47.

**Any use is infringement.** *Betts v. Neilson*, 3 De G. J. & S. 82, 11 Jur. N. S. 679, 34 L. J. Ch. 537, 12 L. T. Rep. N. S. 719, 6 Wkly. Rep. 221, 13 Wkly. Rep. 1028, 68 Eng. Ch. 63, 46 Eng. Reprint 569.

**Making and offering for sale is infringe-**

ment even without actual sale. *Oxley v. Holden*, 8 C. B. N. S. 666, 30 L. J. C. P. 68, 2 L. T. Rep. N. S. 464, 8 Wkly. Rep. 626, 98 E. C. L. 666.

**Making for sale abroad is infringement.** *British Motor Syndicate v. Taylor*, [1901] 1 Ch. 122, 70 L. J. Ch. 21, 83 L. T. Rep. N. S. 419, 49 Wkly. Rep. 183; *Goucher v. Clayton*, 11 Jur. N. S. 462, 13 L. T. Rep. N. S. 111.

91. U. S. Rev. St. (1878) § 4899 [U. S. Comp. St. (1901) p. 3387]; *Dable Grain Shovel Co. v. Flint*, 137 U. S. 41, 11 S. Ct. 8, 34 L. ed. 618; *Wade v. Metcalfe*, 129 U. S. 202, 9 S. Ct. 271, 32 L. ed. 661 [affirming 10 Fed. 130]; *Kendall v. Winsor*, 21 How. (U. S.) 322, 16 L. ed. 165; *McClurg v. Kingsland*, 1 How. (U. S.) 202, 11 L. ed. 102; *Campbell v. New York*, 35 Fed. 504, 1 L. R. A. 48; *Duffy v. Reynolds*, 24 Fed. 855.

**That the right must be derived directly or indirectly from the inventor** see *Pierson v. Eagle Screw Co.*, 19 Fed. Cas. No. 11,156, 2 Robb Pat. Cas. 268, 3 Story 402.

**An article made or bought without the inventor's consent cannot be used.** *Kendall v. Winsor*, 21 How. (U. S.) 322, 16 L. ed. 165; *Evans v. Weiss*, 8 Fed. Cas. No. 4,572, 1 Robb Pat. Cas. 10, 2 Wash. 342; *Hovey v. Stevens*, 12 Fed. Cas. No. 6,745, 2 Robb Pat. Cas. 479, 1 Woodb. & M. 290.

**Transfer of license.**—The implied license is not transferable. *Thomson v. Citizens' Nat. Bank*, 53 Fed. 250, 3 C. C. A. 518.

**Articles properly obtained before patent may be used after extension.** *Paper Bag Mach. Cases*, 105 U. S. 766, 26 L. ed. 959; *Simpson v. Wilson*, 4 How. (U. S.) 709, 11 L. ed. 1169; *Wilson v. Rousseau*, 4 How. (U. S.) 646, 11 L. ed. 1141.

**Canada.**—Pat. Act, Rev. St. Can. c. 61, § 61, does not authorize one who has, with the full consent of the patentee, manufactured and sold a patented article for less than a year before the issue of the patent, to continue the manufacture after the issue thereof, but merely permits him to use and sell the articles manufactured by him prior thereto. *Fowell v. Chown*, 25 Ont. 71. And see *Victor Sporting Goods Co. v. Harold A. Wilson Co.*, 24 Can. L. T. Occ. Notes 211, 7 Ont. L. Rep. 570, 2 Ont. Wkly. Rep. 465, 3 Ont. Wkly. Rep. 496.

92. **Experiments and incomplete inventions as showing prior knowledge or use** see *supra*, III, C, 4, c, e.

93. *Cimiotti Unhairing Co. v. Derbeklow*,



5. KNOWLEDGE OR INTENT OF INFRINGER.<sup>94</sup> A party is no less an infringer because he did not intend to infringe or because he did not know of the patent.<sup>95</sup> His lack of knowledge or intent can have no effect save possibly on the amount of damages.<sup>96</sup>

6. IDENTITY OF INFRINGING DEVICE<sup>97</sup>—a. In General. It is not necessary that every feature of the invention disclosed in the patent be used in order to constitute infringement, but it is sufficient that the essential features as set forth in the claim are taken. Substantial identity is all that is required. If the essence of the invention is taken, variations in detail will not avoid infringement.<sup>98</sup> Mere

87 Fed. 997; Clerk v. Tannage Patent Co., 84 Fed. 643, 28 C. C. A. 501; Bonsack Mach. Co. v. Underwood, 73 Fed. 206; Albright v. Celluloid Harness Trimming Co., 1 Fed. Cas. No. 147, 2 Ban. & A. 629, 12 Off. Gaz. 227; Poppenhusen v. Falke, 19 Fed. Cas. No. 11,279, 4 Blatchf. 493, 2 Fish. Pat. Cas. 181; Poppenhusen v. New York Gutta Percha Comb Co., 19 Fed. Cas. No. 11,283, 2 Fish. Pat. Cas. 62. But see United Tel. Co. v. Sharples, 29 Ch. D. 164, 54 L. J. Ch. 633, 52 L. T. Rep. N. S. 384, 33 Wkly. Rep. 444, holding that use for experiment and instruction is infringement.

94. Knowledge of one whose infringement is contributory see *infra*, XIII, B.

95. A. B. Dick Co. v. Henry, 149 Fed. 424; Pardy v. J. D. Hooker Co., 148 Fed. 631, 78 C. C. A. 403; Thompson v. N. T. Bushnell Co., 96 Fed. 238, 37 C. C. A. 456 [*reversing* 88 Fed. 81]; National Cash-Register Co. v. Leland, 94 Fed. 502, 37 C. C. A. 372; MacKnight v. McNiece, 64 Fed. 115; Grosvenor v. Dashiell, 62 Fed. 584; Smith v. Stewart, 55 Fed. 481 [*affirmed* in 58 Fed. 580, 7 C. C. A. 380]; Winchester Repeating Arms Co. v. American Buckle, etc., Co., 54 Fed. 703; Pirkil v. Smith, 42 Fed. 410; Timken v. Olin, 41 Fed. 169; Bate Refrigerating Co. v. Gillett, 31 Fed. 809; Matthews v. Skates, 16 Fed. Cas. No. 9,291, 1 Fish. Pat. Cas. 602; Parker v. Hulme, 18 Fed. Cas. No. 10,740, 1 Fish. Pat. Cas. 44; Wright v. Hitchcock, L. R. 5 Exch. 37, 39 L. J. Exch. 97; Stead v. Anderson, 4 C. B. 806, 11 Jur. 877, 16 L. J. C. P. 250, 56 E. C. L. 806; Heath v. Unwin, 11 Jur. 420, 16 L. J. Ch. 283, 15 Sim. 552, 60 Eng. Reprint 733; Curtis v. Platt, 11 L. T. Rep. N. S. 245.

Warning infringers.—It is not incumbent upon patentees to warn infringers. Proctor v. Bennis, 36 Ch. D. 740, 57 L. J. Ch. 11, 57 L. T. Rep. N. S. 662, 36 Wkly. Rep. 456.

An erroneous decision holding patent void does not relieve other infringers from liability. Tilghman v. Proctor, 125 U. S. 136, 8 S. Ct. 894, 31 L. ed. 664.

96. Hogg v. Emerson, 11 How. (U. S.) 587, 13 L. ed. 824; Regina Music-Box Co. v. Paillard, 85 Fed. 644; Burdett v. Estey, 3 Fed. 566, 19 Blatchf. 1. And see *infra*, XIII, C, 12, a, (11), (12).

97. Change of form as involving invention see *supra*, III, E, 9.

98. Hobbs v. Beach, 180 U. S. 383, 21 S. Ct. 409, 45 L. ed. 586 [*affirming* 92 Fed. 146, 34 C. C. A. 248]; Driven Well Cases, 122 U. S. 40, 7 S. Ct. 1073, 30 L. ed. 1064; Shelby

Steel Tube Co. v. Delaware Seamless Tube Co., 151 Fed. 64; Edison Gen. Electric Co. v. Crouse-Hinds Electric Co., 146 Fed. 539 [*reversed* on other grounds in 152 Fed. 437, 81 C. C. A. 579]; Hillard v. Fisher Book Typewriter Co., 159 Fed. 439; Wagner Typewriter Co. v. Wyckoff, 151 Fed. 585, 81 C. C. A. 129; Smyth Mfg. Co. v. Sheridan, 144 Fed. 423; International Time Recording Co. v. Dey, 142 Fed. 736, 74 C. C. A. 68; Jewell Filter Co. v. Jackson, 140 Fed. 340, 72 C. C. A. 304; Cazier v. Mackie-Lovejoy Mfg. Co., 138 Fed. 654, 71 C. C. A. 104; Solmsen v. Bredin, 136 Fed. 187, 69 C. C. A. 203 [*affirming* 132 Fed. 161]; Hutter v. De Q. Bottle Stopper Co., 128 Fed. 283, 62 C. C. A. 652; Van Epps v. International Paper Co., 124 Fed. 542; H. C. White Co. v. Walbridge, 118 Fed. 166; Cimiotti Unhairing Co. v. American Unhairing Mach. Co., 115 Fed. 498, 53 C. C. A. 230; Morrison v. Sonn, 111 Fed. 172; Campbell Printing-Press, etc., Co. v. Duplex Printing-Press Co., 86 Fed. 315; Morgan v. Maul, 84 Fed. 336; Dunbar v. Eastern Elevating Co., 75 Fed. 567; Consolidated Car Heating Co. v. Martin Anti-Fire Car Heater Co., 71 Fed. 697; Shaver v. Skinner Mfg. Co., 30 Fed. 68; May v. Fond du Lac County, 27 Fed. 691; Globe Nail Co. v. U. S. Horse Nail Co., 19 Fed. 819; Coupe v. Weatherhead, 16 Fed. 673; Ward v. Grand Detour Plow Co., 14 Fed. 696; Crompton v. Knowles, 7 Fed. 204; Holly v. Vergennes Mach. Co., 4 Fed. 74, 18 Blatchf. 327; American Mfg. Co. v. Lane, 1 Fed. Cas. No. 304, 3 Ban. & A. 268, 14 Blatchf. 438, 15 Off. Gaz. 421; Blanchard v. Eldridge, 3 Fed. Cas. No. 1,509; Blanchard v. Reeves, 3 Fed. Cas. No. 1,515, 1 Fish. Pat. Cas. 103; Blandy v. Griffith, 3 Fed. Cas. No. 1,529, 3 Fish. Pat. Cas. 609; Burr v. Prentiss, 4 Fed. Cas. No. 2,194; Byam v. Eddy, 4 Fed. Cas. No. 2,263, 2 Blatchf. 521, 24 Vt. 666; Carter v. Baker, 5 Fed. Cas. No. 2,472, 4 Fish. Pat. Cas. 404, 1 Sawy. 512; Coleman v. Liesor, 6 Fed. Cas. No. 2,984; Collender v. Came, 6 Fed. Cas. No. 2,999, 2 Ban. & A. 412, 4 Cliff. 393, 10 Off. Gaz. 467; Conover v. Roach, 6 Fed. Cas. No. 3,125, 4 Fish. Pat. Cas. 12; Converse v. Cannon, 6 Fed. Cas. No. 3,144, 2 Woods 7, 9 Off. Gaz. 105; Crompton v. Belknap Mills, 6 Fed. Cas. No. 3,406, 3 Fish. Pat. Cas. 536; Davis v. Palmer, 7 Fed. Cas. No. 3,645, 2 Brock. 298, 1 Robb Pat. Cas. 518; Fuller v. Yentzer, 9 Fed. Cas. No. 5,151, 1 Ban. & A. 520, 6 Biss. 203; Goodyear v. Day, 10 Fed. Cas. No. 5,566; Henderson v. Cleveland Co-operative Stove Co., 11 Fed. Cas. No. 6,351, 2 Ban. & A.



differences in form are immaterial,<sup>99</sup> unless the invention claimed resides in the form. Where this is the case substantial identity of form is necessary.<sup>1</sup> To constitute infringement the principle of operation must be the same,<sup>2</sup> and there must be substantial identity of means and not merely of function or result.<sup>3</sup>

604, 12 Off. Gaz. 4; *Howes v. McNeal*, 12 Fed. Cas. No. 6,789, 3 Ban. & A. 376, 15 Blatchf. 103, 15 Off. Gaz. 608; *Lorillard v. McDowell*, 15 Fed. Cas. No. 8,510, 2 Ban. & A. 531, 11 Off. Gaz. 640, 13 Phila. (Pa.) 461; *McComb v. Brodie*, 15 Fed. Cas. No. 8,708, 5 Fish. Pat. Cas. 384, 1 Woods 153, 2 Off. Gaz. 117; *McCormick v. Seymour*, 15 Fed. Cas. No. 8,726, 2 Blatchf. 240; *Odiorne v. Winkley*, 18 Fed. Cas. No. 10,432, 2 Gall. 51, 1 Robb Pat. Cas. 52; *Page v. Ferry*, 18 Fed. Cas. No. 10,662, 1 Fish. Pat. Cas. 298; *Parker v. Haworth*, 18 Fed. Cas. No. 10,738, 4 McLean 370, 2 Robb Pat. Cas. 725; *Parker v. Stiles*, 18 Fed. Cas. No. 10,749, Fish. Pat. Rep. 319, 5 McLean 44; *Pitts v. Edmonds*, 19 Fed. Cas. No. 11,191, 1 Biss. 168, 2 Fish. Pat. Cas. 52; *Root v. Ball*, 20 Fed. Cas. No. 12,035, 2 Robb Pat. Cas. 513, 4 McLean 177; *Sickels v. Borden*, 22 Fed. Cas. No. 12,832, 3 Blatchf. 535; *Smith v. Downing*, 22 Fed. Cas. No. 13,036, 1 Fish. Pat. Cas. 64; *Storrs v. Howe*, 23 Fed. Cas. No. 13,495, 2 Ban. & A. 420, 4 Cliff. 388, 10 Off. Gaz. 421; *Thorn v. Worthing Skating Rink Co.*, 6 Ch. D. 415 note; *Consolidated Car Heating Co. v. Came*, 18 Quebec Super. Ct. 44.

Theory is immaterial if there is substantial identity of things. *Foss v. Herbert*, 9 Fed. Cas. No. 4,957, 1 Biss. 121, 2 Fish. Pat. Cas. 31.

99. *Busch v. Jones*, 16 App. Cas. (D. C.) 23; *O'Reilly v. Morse*, 15 How. (U. S.) 62, 14 L. ed. 601; *Shelby Steel Tube Co. v. Delaware Seamless Tube Co.*, 151 Fed. 64; *Ferry-Hallock Co. v. Hallock*, 142 Fed. 172; *Nathan v. Howard*, 143 Fed. 889, 75 C. C. A. 97 [affirmed in 160 Fed. 928]; *Rood v. Evans*, 92 Fed. 371; *National Folding-Box, etc., Co. v. Elsas*, 86 Fed. 917, 30 C. C. A. 487; *Taylor v. Sawyer Spindle Co.*, 75 Fed. 301, 22 C. C. A. 203 [affirming 69 Fed. 837]; *Kilmer Mfg. Co. v. Griswold*, 62 Fed. 119 [reversed on other grounds in 67 Fed. 1017, 15 C. C. A. 161]; *Jones v. Holman*, 58 Fed. 973 [reversed on other grounds in 61 Fed. 105, 9 C. C. A. 385]; *National Folding-Box, etc., Co. v. American Paper Pail, etc., Co.*, 55 Fed. 488; *American Paper Pail, etc., Co. v. National Folding Box, etc., Co.*, 51 Fed. 229, 2 C. C. A. 165; *Chicopee Folding-Box Co. v. Nugent*, 41 Fed. 139; *Sewing-Mach. Co. v. Frame*, 24 Fed. 596; *Grier v. Castle*, 17 Fed. 523; *Collignon v. Hayes*, 8 Fed. 912; *Blanchard v. Puttman*, 3 Fed. Cas. No. 1,514, 2 Bond 84, 3 Fish. Pat. Cas. 186; *Cahoon v. Ring*, 4 Fed. Cas. No. 2,292, 1 Cliff. 592, 1 Fish. Pat. Cas. 397; *Carter v. Baker*, 5 Fed. Cas. No. 2,472, 4 Fish. Pat. Cas. 404, 1 Sawy. 512; *Case v. Brown*, 5 Fed. Cas. No. 2,488, 1 Biss. 382, 2 Fish. Pat. Cas. 268 [affirmed in 2 Wall. 320, 17 L. ed. 817]; *Foss v. Herbert*, 9 Fed. Cas. No. 4,957, 1 Biss. 121, 2 Fish. Pat. Cas. 31; *Graham v. Mason*, 10 Fed. Cas. No. 5,671, 4 Cliff. 88, 5 Fish. Pat. Cas. 1; *Howe*

*v. Williams*, 12 Fed. Cas. No. 6,778, 2 Cliff. 245, 2 Fish. Pat. Cas. 395; *Judson v. Cope*, 14 Fed. Cas. No. 7,565, 1 Bond 327, 1 Fish. Pat. Cas. 615; *Latta v. Shawk*, 14 Fed. Cas. No. 8,116, 1 Bond 259, 1 Fish. Pat. Cas. 465; *Potter v. Wilson*, 19 Fed. Cas. No. 11,342, 2 Fish. Pat. Cas. 102; *Sargent v. Larned*, 21 Fed. Cas. No. 12,364, 2 Curt. 340; *Sickels v. Borden*, 22 Fed. Cas. No. 12,832, 3 Blatchf. 535; *Teese v. Phelps*, 23 Fed. Cas. No. 13,819, McAllister 48; *Union Sugar Refinery v. Matthiessen*, 24 Fed. Cas. No. 14,399, 3 Cliff. 639, 2 Fish. Pat. Cas. 600; *Van Hook v. Pendleton*, 28 Fed. Cas. No. 16,851, 1 Blatchf. 187, Fish. Pat. Rep. 120.

Making in two parts instead of one will not avoid infringement. *Hammond Buckle Co. v. Hathaway*, 48 Fed. 834; *Hayes v. Bickelhaupt*, 21 Fed. 567; *Mabie v. Haskell*, 15 Fed. Cas. No. 8,653, 2 Cliff. 507. See *Western Tube Co. v. Rinear*, 156 Fed. 49 [affirmed in 159 Fed. 431].

Difference in size will not avoid infringement. *Rogers v. Sargent*, 20 Fed. Cas. No. 12,020, 7 Blatchf. 507.

1. *Lehigh Valley R. Co. v. Mellon*, 104 U. S. 112, 26 L. ed. 639; *Werner v. King*, 96 U. S. 218, 24 L. ed. 613; *Shelby Steel Tube Co. v. Delaware Seamless Tube Co.*, 151 Fed. 64 [affirmed in 160 Fed. 928]; *Polisdorfer v. St. Louis Wooden-Ware Works*, 37 Fed. 57; *Toepfer v. Goetz*, 31 Fed. 913; *Newark Mach. Co. v. Hargett*, 28 Fed. 567; *Scott v. Evans*, 11 Fed. 726.

2. *Peerless Rubber Mfg. Co. v. White*, 118 Fed. 827, 55 C. C. A. 502; *Goodyear Shoe Mach. Co. v. Spaulding*, 110 Fed. 393, 49 C. C. A. 88; *Brett v. Quintard*, 10 Fed. 741, 20 Blatchf. 320; *White v. Noyes*, 2 Fed. 782; *May v. Johnson County*, 16 Fed. Cas. No. 9,334; *Wintermute v. Redington*, 30 Fed. Cas. No. 17,896, 1 Fish. Pat. Cas. 239.

3. *Boyd Power-Brake Co. v. Westinghouse*, 170 U. S. 537, 18 S. Ct. 707, 42 L. ed. 1136 [reversing 70 Fed. 816, 17 C. C. A. 430]; *Masseth v. Larkin*, 119 Fed. 171, 56 C. C. A. 167 [affirming 111 Fed. 409]; *Pittsburg Meter Co. v. Pittsburg Supply Co.*, 109 Fed. 644, 48 C. C. A. 580; *Taber Bas-Relief Photograph Co. v. Marceau*, 87 Fed. 871; *Dickinson v. A. Plamondon Mfg. Co.*, 76 Fed. 455; *American Pin Co. v. Oakville Co.*, 1 Fed. Cas. No. 313, 3 Blatchf. 190; *Burden v. Corning*, 4 Fed. Cas. No. 2,143, 2 Fish. Pat. Cas. 477; *Burr v. Duryee*, 4 Fed. Cas. No. 2,190, 2 Fish. Pat. Cas. 275 [affirmed in 1 Wall. 531, 17 L. ed. 650, 660, 661]; *Lee v. Blandy*, 15 Fed. Cas. No. 8,182, 1 Bond 361, 2 Fish. Pat. Cas. 89; *Morris v. Barrett*, 17 Fed. Cas. No. 9,827, 1 Bond 254, 1 Fish. Pat. Cas. 461; *Reckendorfer v. Faber*, 20 Fed. Cas. No. 11,625, 1 Ban. & A. 229, 12 Blatchf. 68, 5 Off. Gaz. 697 [affirmed in 92 U. S. 347, 23 L. ed. 719]; *Singer v. Walmsley*, 22 Fed. Cas. No. 12,900, 1 Fish. Pat. Cas. 558.



**b. Limitation of Claims.** Each claim of the patent is separately considered in determining infringement,<sup>4</sup> and while a claim describing the invention in broad terms may be infringed by devices differing in many respects from that of the patent,<sup>5</sup> a claim including a distinct limitation to a particular feature is not infringed unless that feature is used.<sup>6</sup>

**c. Diversity of Use.** The use of an invention for an analogous purpose is infringement,<sup>7</sup> but use for a non-analogous purpose where invention is necessary to procure its adaptability is not infringement.<sup>8</sup>

**d. Combination.** A claim to a combination of old elements, materials, or parts is not infringed unless every element, material, or part mentioned in the claim, or its equivalent, is used in the same relation;<sup>9</sup> and in the application of this rule it is immaterial that one or more of the elements specified in the claim are not of

Identity of means, operation, and result is necessary. *American Can Co. v. Hickmott Asparagus Canning Co.*, 137 Fed. 86.

4. *Mast v. Dempster Mill Mfg. Co.*, 82 Fed. 327, 27 C. C. A. 191; *Holloway v. Dow*, 54 Fed. 511; *Foss v. Herbert*, 9 Fed. Cas. No. 4,957, 1 Biss. 121, 2 Fish. Pat. Cas. 31; *Union Sugar Refinery v. Matthiesson*, 24 Fed. Cas. No. 14,399, 3 Cliff. 639, 2 Fish. Pat. Cas. 600.

5. *General Electric Co. v. Brooklyn Heights R. Co.*, 117 Fed. 613; *Tuscarawas Mfg. Co. v. Cole*, 109 Fed. 161; *Thomson-Houston Electric Co. v. Lorain Steel Co.*, 103 Fed. 641 [*affirmed* in 107 Fed. 711, 46 C. C. A. 593]; *Hatch Storage Battery Co. v. Electric Storage Battery Co.*, 100 Fed. 975; *Parsons v. Seelye*, 100 Fed. 455, 40 C. C. A. 486 [*reversing* 92 Fed. 1005]; *American Paper Barrel Co. v. Laraway*, 28 Fed. 141; *Fricke v. Hum*, 22 Fed. 302; *Gibson v. Betts*, 10 Fed. Cas. No. 5,390, 1 Blatchf. 163, Fish. Pat. Rep. 91.

6. *Lane v. Levi*, 21 App. Cas. (D. C.) 168; *Hubbell v. U. S.*, 179 U. S. 77, 21 S. Ct. 24, 45 L. ed. 95; *Ball, etc., Fastener Co. v. Kraetzer*, 150 U. S. 111, 14 S. Ct. 48, 37 L. ed. 1019; *McClain v. Ortmayer*, 141 U. S. 419, 12 S. Ct. 76, 35 L. ed. 800; *Anderson Foundry, etc., Works v. Potts*, 108 Fed. 379, 47 C. C. A. 409; *Consolidated Store-Service Co. v. Siegel-Cooper Co.*, 107 Fed. 716, 46 C. C. A. 599; *Lepper v. Randall*, 105 Fed. 975; *Ross-Moyer Mfg. Co. v. Randall*, 104 Fed. 355, 43 C. C. A. 578; *Union Steam-Pump Co. v. Battle Creek Steam-Pump Co.*, 104 Fed. 337, 43 C. C. A. 560; *Starrett v. J. Stevens Arms, etc., Co.*, 96 Fed. 244; *A. J. Phillips Co. v. Owosso Mfg. Co.*, 83 Fed. 176; *Foos Mfg. Co. v. Springfield Engine, etc., Co.*, 49 Fed. 641, 1 C. C. A. 410 [*affirming* 44 Fed. 595]; *Heine Safety Boiler Co. v. Anheuser-Busch Brewing Assoc.*, 43 Fed. 786 [*affirmed* in 154 U. S. 504, 14 S. Ct. 1146, 38 L. ed. 1083]; *Newark Mach. Co. v. Hargett*, 28 Fed. 567; *Osceola Mfg. Co. v. Pie*, 28 Fed. 83; *Celluloid Mfg. Co. v. Pratt*, 21 Fed. 313; *McKay v. Stowe*, 17 Fed. 516; *Cornell v. Littlejohn*, 6 Fed. Cas. No. 3,238, 2 Ban. & A. 324, 9 Off. Gaz. 837, 922; *Keystone Bridge Co. v. Phoenix Iron Co.*, 14 Fed. Cas. No. 7,751, 5 Fish. Pat. Cas. 468, 1 Off. Gaz. 471, 9 Phila. (Pa.) 374.

Claim to an article including limitations as to the process of making it is not infringed by another process. *Expanded Metal*

*Co. v. St. Louis Bd. of Education*, 103 Fed. 287.

7. *Sanitary Fireproofing, etc., Co. v. Sprick-erhoff*, 139 Fed. 801, 71 C. C. A. 565; *West-inghouse Electric, etc., Co. v. Roberts*, 125 Fed. 6; *Williams Patent Crusher, etc., Co. v. St. Louis Pulverizer Co.*, 104 Fed. 795; *Red Jacket Mfg. Co. v. Davis*, 82 Fed. 432, 27 C. C. A. 204; *Long v. Pope Mfg. Co.*, 75 Fed. 835, 21 C. C. A. 533; *Thompson v. Gilder-sleeve*, 34 Fed. 43; *Cincinnati Ice-Mach. Co. v. Foss Schneider Brewing Co.*, 31 Fed. 469; *Zinn v. Weiss*, 7 Fed. 914; *American Wood-Paper Co. v. Fibre Disintegrating Co.*, 1 Fed. Cas. No. 320, 6 Blatchf. 27, 3 Fish. Pat. Cas. 362 [*affirmed* in 23 Wall. 566, 23 L. ed. 311]; *Mabie v. Haskell*, 15 Fed. Cas. No. 8,653, 2 Cliff. 507; *Pike v. Potter*, 19 Fed. Cas. No. 11,162, 3 Fish. Pat. Cas. 55; *Young v. Lipp-man*, 30 Fed. Cas. No. 18,160, 9 Blatchf. 277, 5 Fish. Pat. Cas. 230, 2 Off. Gaz. 249, 342; *Cannington v. Nuttall*, L. R. 5 H. L. 205, 40 L. J. Ch. 739.

8. *Cary Mfg. Co. v. Standard Metal Strap Co.*, 120 Fed. 945, 57 C. C. A. 235; *Johnson v. McCurdy*, 108 Fed. 671, 47 C. C. A. 577; *Thomson Meter Co. v. National Meter Co.*, 106 Fed. 519; *Palmer v. De Yongh*, 90 Fed. 281; *MacColl v. Knowles Loom Works*, 87 Fed. 727; *Heap v. Tremont, etc., Mills*, 82 Fed. 449, 27 C. C. A. 316; *Boston, etc., Elec-tric St. R. Co. v. Bemis Car Box Co.*, 80 Fed. 287, 25 C. C. A. 420; *Long v. Pope Mfg. Co.*, 75 Fed. 835, 21 C. C. A. 533; *Hoe v. Knap*, 27 Fed. 204; *Osmer v. J. B. Sickles Saddlery Co.*, 23 Fed. 724; *Judd v. Babcock*, 8 Fed. 605; *Brown v. Rubber Step Mfg. Co.*, 4 Fed. Cas. No. 2,023, 3 Ban. & A. 232, 13 Off. Gaz. 369; *Stuart v. Shantz*, 23 Fed. Cas. No. 13,556, 6 Fish. Pat. Cas. 35, 2 Off. Gaz. 524, 9 Phila. (Pa.) 376; *Tatham v. Le Roy*, 23 Fed. Cas. No. 13,762; *Higgs v. Goodwin, E. B. & E.* 529, 5 Jur. N. S. 97, 27 L. J. Q. B. 421, 96 E. C. L. 529.

9. *Fenton Metallic Mfg. Co. v. Office Spe-cialty Mfg. Co.*, 12 App. Cas. (D. C.) 201; *Knapp v. Morss*, 150 U. S. 221, 14 S. Ct. 81, 37 L. ed. 1059; *Garratt v. Seibert*, 131 U. S. appendix cxv, 21 L. ed. 956; *Electric R. Signal Co. v. Hall R. Signal Co.*, 114 U. S. 87, 5 S. Ct. 1069, 29 L. ed. 96; *Rowell v. Lindsay*, 113 U. S. 97, 5 S. Ct. 507, 28 L. ed. 906 [*affirming* 6 Fed. 290, 10 Biss. 217]; *Mc-Murray v. Mallory*, 111 U. S. 97, 4 S. Ct. 375, 28 L. ed. 365 [*affirming* 5 Fed. 593, 4



the essence of the invention. Every element claimed must be regarded as

Hughes 265]; Fuller v. Yentzer, 94 U. S. 288, 24 L. ed. 103; Rees v. Gould, 15 Wall. (U. S.) 187, 21 L. ed. 39; Mowry v. Whitney, 14 Wall. (U. S.) 620, 20 L. ed. 860; Stimpson v. Baltimore, etc., R. Co., 10 How. (U. S.) 329, 13 L. ed. 441; Consolidated Engine Stop Co. v. Landers, 160 Fed. 79; H. F. Brainmer Mfg. Co. v. Witte Hardware Co., 159 Fed. 726; Ajax Forge Co. v. Morden Frog, etc., Works, 156 Fed. 591]; American Chocolate Mach. Co. v. Helmsstetter, 142 Fed. 978, 74 C. C. A. 240; O. H. Jewell Filter Co. v. Jackson, 140 Fed. 340, 72 C. C. A. 304; American Can Co. v. Hickmott Asparagus Canning Co., 137 Fed. 86; Levy v. Harris, 130 Fed. 711, 65 C. C. A. 113; American Fur Refining Co. v. Cimiotti Unhairing Mach. Co., 123 Fed. 869, 59 C. C. A. 357 [affirmed in 198 U. S. 399, 25 S. Ct. 697, 49 L. ed. 1100]; Cimiotti Unhairing Co. v. Derbohlav, 115 Fed. 510, 53 C. C. A. 164; Pittsburg Meter Co. v. Pittsburg Supply Co., 109 Fed. 644, 48 C. C. A. 580; Wellman v. Midland Steel Co., 106 Fed. 221; Starrett v. J. Stevens Arms, etc., Co., 100 Fed. 93, 40 C. C. A. 289; Norton v. Wheaton, 97 Fed. 636; Thompson v. Second Ave. Traction Co., 89 Fed. 321; Campbell Printing-Press, etc., Co. v. Duplex Printing-Press Co., 86 Fed. 315; Kansas City Hay-Press Co. v. Devol, 81 Fed. 726, 26 C. C. A. 578; Carter Mach. Co. v. Hanes, 78 Fed. 346, 24 C. C. A. 128; Muller v. Lodge, etc., Mach. Tool Co., 77 Fed. 621, 23 C. C. A. 357; Adams Electric R. Co. v. Lindell R. Co., 77 Fed. 432, 23 C. C. A. 223 [affirming 63 Fed. 986]; P. H. Murphy Mfg. Co. v. Excelsior Car-Roof Co., 76 Fed. 965, 22 C. C. A. 658; Engle Sanitary, etc., Co. v. Elwood, 73 Fed. 484; Brown v. Stilwell, etc., Mfg. Co., 57 Fed. 731, 741, 6 C. C. A. 528; Ashton Valve Co. v. Coale Muffler, etc., Co., 50 Fed. 100 [affirmed in 52 Fed. 314, 3 C. C. A. 98]; Ross v. Montana Union R. Co., 45 Fed. 424; Innis v. Oil City Boiler Works, 41 Fed. 788; Tatum v. Gregory, 41 Fed. 142; Ott v. Barth, 32 Fed. 89; Thoens v. Israel, 31 Fed. 556; Blades v. Rand, 27 Fed. 93 [affirmed in 136 U. S. 631, 10 S. Ct. 1065, 34 L. ed. 553]; Saladee v. Racine Wagon, etc., Co., 20 Fed. 686; Gould v. Spicers, 20 Fed. 317; Howe v. Neemes, 18 Fed. 40; Matteson v. Caine, 17 Fed. 525, 8 Sawy. 498; Rowell v. Lindsay, 6 Fed. 290, 10 Biss. 217 [affirmed in 113 U. S. 97, 5 S. Ct. 507, 28 L. ed. 906]; Pourrot v. Hawes, 3 Fed. 456; Barrett v. Hall, 2 Fed. Cas. No. 1,047, 1 Mason 447, 1 Robb Pat. Cas. 207; Bell v. Daniels, 3 Fed. Cas. No. 1,247, 1 Bond 212, 1 Fish. Pat. Cas. 372; Brooks v. Bicknell, 3 Fed. Cas. No. 1,946, Fish. Pat. Rep. 72, 4 McLean 70; Burr v. Duryee, 4 Fed. Cas. No. 2,190, 2 Fish. Pat. Cas. 275 [affirmed in 1 Wall. 531, 17 L. ed. 650, 660, 661]; Crompton v. Belknap Mills, 6 Fed. Cas. No. 3,406, 3 Fish. Pat. Cas. 536; Howe v. Abbott, 12 Fed. Cas. No. 6,766, 2 Robb Pat. Cas. 99, 2 Story 190; Huggins v. Hubby, 12 Fed. Cas. No. 6,839; McCormick v. Manny, 15 Fed. Cas. No. 8,724, 6 McLean 539 [affirmed in 20 How. 402, 15 L. ed. 930]; Nicholson Pavement Co.

v. Hatch, 18 Fed. Cas. No. 10,251, 3 Fish. Pat. Cas. 432, 4 Sawy. 692; Pitts v. Wemple, 19 Fed. Cas. No. 11,195, 6 McLean 558; Rich v. Close, 20 Fed. Cas. No. 11,757, 8 Blatchf. 41, 4 Fish. Pat. Cas. 279; Rollhaus v. McPherson, 20 Fed. Cas. No. 12,026; Smith v. Higgins, 22 Fed. Cas. No. 13,058; Berdan Fire-Arms Mfg. Co. v. U. S., 25 Ct. Cl. 355 [affirmed in 156 U. S. 552, 15 S. Ct. 420, 39 L. ed. 530]; Pacific Submarine, etc., Proof Wall Co. v. U. S., 19 Ct. Cl. 234; Dudgeon v. Thomson, 3 App. Cas. 34; Clark v. Adie, 2 App. Cas. 315, 46 L. J. Ch. 585, 36 L. T. Rep. N. S. 923; Curtis v. Platt, L. R. 1 H. L. 337, 35 L. J. Ch. 852; Parkes v. Stevens, L. R. 8 Eq. 358, 38 L. J. Ch. 627, 17 Wkly. Rep. 846 [affirmed in L. R. 5 Ch. 36, 22 L. T. Rep. N. S. 635, 18 Wkly. Rep. 233]; Saxby v. Clunes, 43 L. J. Exch. 228; White v. Fenn, 15 L. T. Rep. N. S. 505, 15 Wkly. Rep. 348.

Similarity of result not sufficient to constitute infringement. Westinghouse v. Boyden Power-Brake Co., 170 U. S. 537, 18 S. Ct. 707, 42 L. ed. 1136; Miller v. Eagle Mfg. Co., 151 U. S. 186, 14 S. Ct. 310, 38 L. ed. 121; Gage v. Herring, 107 U. S. 640, 2 S. Ct. 819, 27 L. ed. 601; Jenkins v. Mahoney, 135 Fed. 550 [reversed on other grounds in 138 Fed. 404, 70 C. C. A. 662]; Norton v. Wheaton, 97 Fed. 636.

For cases holding that there was no infringement see Ball, etc., Fastener Co. v. Kraetzer, 150 U. S. 111, 14 S. Ct. 48, 37 L. ed. 1019; Gordon v. Warder, 150 U. S. 47, 14 S. Ct. 32, 37 L. ed. 992; Roemer v. Peddie, 132 U. S. 313, 10 S. Ct. 98, 33 L. ed. 382; Sharp v. Riessner, 119 U. S. 631, 7 S. Ct. 417, 30 L. ed. 507; Bridge v. Excelsior Mfg. Co., 105 U. S. 618, 26 L. ed. 1191; Kursheedt Mfg. Co. v. Adler, 107 Fed. 488, 46 C. C. A. 422 [affirming 103 Fed. 948]; Consolidated Store-Service Co. v. Seybold, 105 Fed. 978, 45 C. C. A. 152; Jones Special Mach. Co. v. Pentucket Variable Stitch Sewing-Mach. Co., 104 Fed. 556, 44 C. C. A. 33; Consolidated Store-Service Co. v. Siegel-Cooper Co., 103 Fed. 489; Whitaker Cement Co. v. Huntington Dry Pulverizer Co., 95 Fed. 471, 37 C. C. A. 151; Risdon Iron, etc., Works v. Trent, 92 Fed. 375 [modified in 102 Fed. 635, 42 C. C. A. 529]; Kansas City Hay-Press Co. v. Devol, 81 Fed. 726, 26 C. C. A. 578; Babcock v. Clarkson, 58 Fed. 581; Gates Iron Works v. Fraser, 55 Fed. 409, 5 C. C. A. 154; Douglas v. Abraham, 50 Fed. 420; Stauffer v. Spangler, 50 Fed. 84; Foos Mfg. Co. v. Springfield Engine, etc., Co., 49 Fed. 641, 1 C. C. A. 410; Challenge Corn-Planter Co. v. Gearhardt, 46 Fed. 768; Joliet Mfg. Co. v. Keystone Mfg. Co., 39 Fed. 798; Royer v. Schultz Belting Co., 28 Fed. 850; Buckingham v. Porter, 26 Fed. 759, 10 Sawy. 289; Crompton v. Knowles, 7 Fed. 199; Birdsell v. Hagerstown Agricultural Implement Mfg Co., 3 Fed. Cas. No. 1,436, 2 Ban. & A. 519, 1 Hughes 59, 11 Off. Gaz. 420; Merriam v. Drake, 17 Fed. Cas. No. 9,461, 9 Blatchf. 336, 5 Fish. Pat. Cas. 259; Wheeler v. Simpson,



material, although it is not so in fact.<sup>10</sup> A patentee will not be heard to deny the materiality of any element included in his claim.<sup>11</sup> When parts are substituted they must be equivalents to constitute infringement,<sup>12</sup> and they must be combined in the same way.<sup>13</sup> While, as already shown, a patent for a combination is not infringed if any one of the elements is omitted, a mere change of form or location, or sequence of the elements, which does not change the essence of the combination, will not avoid infringement.<sup>14</sup> So where some of the parts of the combination are new, and those parts are taken and used in the same manner, but with different things from the rest of the combination patented, and a part of the patented invention is taken although the whole is not, it is an infringement to that extent.<sup>15</sup>

**e. Process.** A claim to an art or process is not infringed except by the use of all of the steps or their equivalents and in the order stated.<sup>16</sup> And it is well

29 Fed. Cas. No. 17,500, 1 Ban. & A. 420, 6 Off. Gaz. 435; *Carter v. Hamilton*, 23 Can. Sup. Ct. 172; *Sylvester v. Masson*, 12 Ont. App. 335.

10. *Wright v. Yuengling*, 155 U. S. 47, 15 S. Ct. 1, 39 L. ed. 64; *Union Water Meter Co. v. Desper*, 101 U. S. 332, 25 L. ed. 1024; *Levy v. Harris*, 124 Fed. 69 [affirmed in 135 Fed. 1023]; *Pittsburg Meter Co. v. Pittsburg Supply Co.*, 109 Fed. 644, 48 C. C. A. 580; *Kinzel v. Luttrell Brick Co.*, 67 Fed. 926, 15 C. C. A. 82; *Rowell v. Lindsay*, 6 Fed. 290, 10 Biss. 217 [affirmed in 113 U. S. 97, 5 S. Ct. 507, 28 L. ed. 906].

11. *Eames v. Godfrey*, 1 Wall. (U. S.) 78, 17 L. ed. 547; *Adam v. Folger*, 120 Fed. 260, 56 C. C. A. 540.

12. *Robins Conveying Belt Co. v. American Road Mach. Co.*, 145 Fed. 923, 76 C. C. A. 461; *Singer Mfg. Co. v. Cramer*, 109 Fed. 652, 48 C. C. A. 588; *Brammer v. Schroeder*, 106 Fed. 918, 46 C. C. A. 41; *National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co.*, 106 Fed. 693, 45 C. C. A. 544; *Noonan v. Chester Park Athletic Club Co.*, 99 Fed. 90, 39 C. C. A. 426; *Burdett v. Estey*, 4 Fed. Cas. No. 2,146, 4 Ban. & A. 141, 16 Blatchf. 105; *Crompton v. Belknap Mills*, 6 Fed. Cas. No. 3,406, 3 Fish. Pat. Cas. 536; *Densmore v. Schofield*, 7 Fed. Cas. No. 3,809, 4 Fish. Pat. Cas. 148.

13. *Crompton v. Belknap Mills*, 6 Fed. Cas. No. 3,406, 3 Fish. Pat. Cas. 536, 30 Fed. Cas. No. 18,285; *Tatham v. Le Roy*, 23 Fed. Cas. No. 13,760, 2 Blatchf. 474.

14. *Adam v. Folger*, 120 Fed. 260, 56 C. C. A. 540; *Dowagiac Mfg. Co. v. Superior Drill Co.*, 115 Fed. 886, 53 C. C. A. 36; *Ide v. Trorlicht, etc., Carpet Co.*, 115 Fed. 137, 53 C. C. A. 341; *National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co.*, 106 Fed. 693, 45 C. C. A. 544; *Thompson v. Second Ave. Traction Co.*, 93 Fed. 824, 35 C. C. A. 620; *Taylor v. Sawyer Spindle Co.*, 75 Fed. 301, 22 C. C. A. 203.

15. *Thompson v. American Bank-Note Co.*, 35 Fed. 203; *Adair v. Thayer*, 4 Fed. 441, 17 Blatchf. 468; *Sharp v. Tift*, 2 Fed. 697, 18 Blatchf. 132; *Latta v. Shawk*, 14 Fed. Cas. No. 8,116, 1 Bond 259, 1 Fish. Pat. Cas. 465; *Lee v. Blandy*, 15 Fed. Cas. No. 8,182, 1 Bond 361, 2 Fish. Pat. Cas. 89; *Rose v. Sibley Mach. Co.*, 20 Fed. Cas. No. 12,051;

*Union Sugar Refinery v. Matthiesson*, 24 Fed. Cas. No. 14,399, 3 Cliff. 639, 2 Fish. Pat. Cas. 600; *Lister v. Leather*, 8 E. & B. 1004, 4 Jur. N. S. 947, 27 L. J. Q. B. 295, 92 E. C. L. 1004; *Newton v. Grand Junction R. Co.*, 5 Exch. 331 note, 20 L. J. Exch. 427 note, 6 Eng. L. & Eq. 557; *Sellers v. Dickinson*, 5 Exch. 312, 20 L. J. Exch. 417, 6 Eng. L. & Eq. 544.

16. *U. S. Glass Co. v. Atlas Glass Co.*, 90 Fed. 724, 33 C. C. A. 254; *Kennedy v. Solar Refining Co.*, 69 Fed. 715; *Brush Electric Co. v. Electrical Accumulator Co.*, 47 Fed. 48 [modified in 52 Fed. 130, 2 C. C. A. 682]; *Hatch v. Towne*, 35 Fed. 139; *Royer v. Chicago Mfg. Co.*, 20 Fed. 853; *Arnold v. Phelps*, 20 Fed. 315; *Heller v. Bauer*, 19 Fed. 96; *Cotter v. New Haven Copper Co.*, 13 Fed. 234; *Hammerschlag v. Garrett*, 10 Fed. 479; *Hudson v. Draper*, 12 Fed. Cas. No. 6,834, 4 Cliff. 178, 4 Fish. Pat. Cas. 256; *Unwin v. Heath*, 16 C. B. 713, 81 E. C. L. 713, 5 H. L. Cas. 505, 10 Eng. Reprint 997, 25 L. J. C. P. 8; *Patent Bottle Envelope Co. v. Seymour*, 5 C. B. N. S. 164, 5 Jur. N. S. 174, 28 L. J. C. P. 22, 94 E. C. L. 164.

Identity of result is not sufficient. *Schwartz v. Housman*, 88 Fed. 519; *Merrill v. Yeomans*, 17 Fed. Cas. No. 9,472, 1 Ban. & A. 47, Holmes 331, 5 Off. Gaz. 268 [affirmed in 94 U. S. 568, 24 L. ed. 235].

But similarity of result may indicate identity of process. *Hemolin Co. v. Harway Dye-wood, etc., Mfg. Co.*, 131 Fed. 483 [affirmed in 138 Fed. 54, 70 C. C. A. 480].

**Sufficiency of substantial identity.**—Absolute identity is not necessary, but only substantial identity. *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 22 S. Ct. 698, 46 L. ed. 968 [reversing 96 Fed. 850]; *Burdon Wire, etc., Co. v. Williams*, 128 Fed. 927; *Electric Smelting, etc., Co. v. Pittsburg Reduction Co.*, 125 Fed. 926, 60 C. C. A. 636; *U. S. Mitis Co. v. Carnegie Steel Co.*, 89 Fed. 343 [reversed on other grounds in 90 Fed. 829, 33 C. C. A. 387]; *New York Filter Mfg. Co. v. Elmira Waterworks Co.*, 82 Fed. 459, 83 Fed. 1013; *New York Filter Mfg. Co. v. Niagara Falls Waterworks Co.*, 80 Fed. 924, 26 C. C. A. 252, 77 Fed. 900; *American Bell Tel. Co. v. Southern Tel. Co.*, 34 Fed. 795; *Celluloid Mfg. Co. v. American Zylonite Co.*, 31 Fed. 904; *Cary*



settled that the purchaser and user of an article made by the process is not an infringer.<sup>17</sup>

**f. Composition.**<sup>18</sup> A claim to an article or substance composed of a particular ingredient or combination of ingredients is infringed by an article having the same characteristics and composed of the same or equivalent ingredients.<sup>19</sup> The

*v. Wolff*, 24 Fed. 139, 23 Blatchf. 92; *Gottfried v. Bartholomae*, 10 Fed. Cas. No. 5,632, 3 Ban. & A. 308, 8 Biss. 219, 6 Reporter 390, 13 Off. Gaz. 1128; *Gottfried v. Phillip Best Brewing Co.*, 10 Fed. Cas. No. 5,633, 5 Ban. & A. 4, 17 Off. Gaz. 675; *Jones v. Merrill*, 13 Fed. Cas. No. 7,481, 8 Off. Gaz. 401; *Roberts v. Roter*, 20 Fed. Cas. No. 11,912, 5 Fish. Pat. Cas. 295; *United Nickel Co. v. Keith*, 24 Fed. Cas. No. 14,408, 1 Ban. & A. 44, Holmes 328, 5 Off. Gaz. 272; *Whitney v. Mowry*, 29 Fed. Cas. No. 17,592, 2 Bond 45, 3 Fish. Pat. Cas. 157.

Additions which do not essentially vary the process do not avoid infringement. *Ford Morocco Co. v. Tannage Patent Co.*, 84 Fed. 644, 28 C. C. A. 503; *Clerk v. Tannage Patent Co.*, 84 Fed. 643, 28 C. C. A. 501; *Lalance, etc., Mfg. Co. v. Habermann Mfg. Co.*, 53 Fed. 375; *Maryland Hominy, etc., Co. v. Dorr*, 46 Fed. 773.

Substitution of equivalent materials is infringement. *Johnson v. Willimantic Linen Co.*, 33 Conn. 436; *United Nickel Co. v. Central Pac. R. Co.*, 36 Fed. 186; *Poppenhusen v. Falke*, 19 Fed. Cas. No. 11,280, 5 Blatchf. 46, 2 Fish. Pat. Cas. 213.

Process held not infringed see *California Artificial Stone Paving Co. v. Schalicke*, 119 U. S. 401, 7 S. Ct. 391, 30 L. ed. 471; *Burns v. Meyer*, 100 U. S. 671, 25 L. ed. 738; *Wolff v. De Nemours*, 122 Fed. 944 [affirmed in 134 Fed. 862, 67 C. C. A. 488]; *Bradford v. Belknap Motor Co.*, 105 Fed. 63 [affirmed in 115 Fed. 711, 53 C. C. A. 293]; *Cambria Iron Co. v. Carnegie Steel Co.*, 96 Fed. 850, 37 C. C. A. 593; *U. S. Repair, etc., Co. v. Standard Paving Co.*, 95 Fed. 137, 37 C. C. A. 28; *Michaelis v. Larkin*, 91 Fed. 778; *U. S. Glass Co. v. Atlas Glass Co.*, 90 Fed. 724, 33 C. C. A. 254; *Cary Mfg. Co. v. De Haven*, 88 Fed. 698; *Tabor Bas-Relief Photograph Co. v. Marceau*, 87 Fed. 871; *Chicago Sugar-Refining Co. v. Charles Pope Glucose Co.*, 84 Fed. 977, 28 C. C. A. 594; *Philadelphia Creamery Supply Co. v. Davis, etc., Bldg., etc., Co.*, 84 Fed. 881, 28 C. C. A. 555; *Electric Smelting, etc., Co. v. Carborundum Co.*, 83 Fed. 492; *Jackson v. Birmingham Brass Co.*, 79 Fed. 801, 25 C. C. A. 196; *Cowles Electric Smelting, etc., Co. v. Lowrey*, 79 Fed. 331, 24 C. C. A. 616; *Clement Mfg. Co. v. Upson, etc., Co.*, 50 Fed. 538; *Smith v. Pittsburgh Gas Co.*, 42 Fed. 145; *Wickwire v. Wire Fabric Co.*, 41 Fed. 36; *Consolidated Bunting Apparatus Co. v. H. Clausen, etc., Brewing Co.*, 39 Fed. 277; *Gloucester Isinglass, etc., Co. v. Le Page*, 30 Fed. 370; *Globe Nail Co. v. Superior Nail Co.*, 27 Fed. 450 [affirmed in 138 U. S. 636, 10 S. Ct. 1068, 34 L. ed. 552]; *Celluloid Mfg. Co. v. Comstock*, 23 Fed. 38; *Boneless Fish Co. v. Roberts*, 12 Fed. 627; *Doubleday v. Bracheo*, 7 Fed. Cas. No.

4,018; *Merrill v. Yeomans*, 17 Fed. Cas. No. 9,472, 1 Ban. & A. 47, Holmes 331, 5 Off. Gaz. 268.

Process held infringed see *Chisholm v. Johnson*, 106 Fed. 191; *Alvin Mfg. Co. v. Scharling*, 100 Fed. 87; *German-American Filter Co. v. Erdrich*, 98 Fed. 300; *Streator Cathedral Glass Co. v. Wire-Glass Co.*, 97 Fed. 950, 33 C. C. A. 573; *Westinghouse Electric, etc., Co. v. Beacon Lamp Co.*, 95 Fed. 462; *Badische Anilin, etc., Fabrik v. Kalle*, 94 Fed. 163; *Simonds Rolling-Mach. Co. v. Hathorn Mfg. Co.*, 90 Fed. 201; *Celluloid Co. v. Arlington Mfg. Co.*, 85 Fed. 449; *Ford Morocco Co. v. Tannage Patent Co.*, 84 Fed. 644, 28 C. C. A. 503; *Adams v. Tannage Patent Co.*, 81 Fed. 178, 26 C. C. A. 326; *Matheson v. Campbell*, 77 Fed. 280.

17. *Brown v. District of Columbia*, 3 Mackey (D. C.) 502; *National Phonograph Co. v. Lambert Co.*, 125 Fed. 388 [affirmed in 142 Fed. 164, 73 C. C. A. 382]; *Welsbach Light Co. v. Union Incandescent Light Co.*, 101 Fed. 131, 41 C. C. A. 255; *Ferris v. Batcheller*, 70 Fed. 714; *Durand v. Green*, 60 Fed. 392 [affirmed in 61 Fed. 819, 10 C. C. A. 97]; *Anonymous*, 1 Fed. Cas. No. 477.

Sale of article is not an infringement of the machine which makes it. *Boyd v. McAlpin*, 3 Fed. Cas. No. 1,748, 3 McLean, 427, 2 Robb Pat. Cas. 277; *Goodyear v. New Jersey Cent. R. Co.*, 10 Fed. Cas. No. 5,563, 1 Fish. Pat. Cas. 626, 2 Wall. Jr. 356.

In England the importation of articles made abroad according to the patented process is infringement. *Saccharin Corp. v. Anglo-Continental Chemical Works*, [1901] 1 Ch. 414, 70 L. J. Ch. 194, 48 Wkly. Rep. 444; *Elmslie v. Boursier*, L. R. 9 Eq. 217, 39 L. J. Ch. 328, 18 Wkly. Rep. 665; *Von Heyden v. Neustadt*, 14 Ch. D. 230, 50 L. J. Ch. 126, 42 L. T. Rep. N. S. 300, 28 Wkly. Rep. 496.

In Canada use or sale of article is infringement. *Toronto Auer Light Co. v. Colling*, 31 Ont. 18.

18. Substitution of materials as involving invention see *supra*, III, E, 15.

19. *Dickerson v. Maurer*, 108 Fed. 233; *Propfe v. Coddington*, 108 Fed. 86, 47 C. C. A. 218 [affirming 105 Fed. 951]; *Badische Anilin, etc., Fabrik v. Kalle*, 104 Fed. 802, 44 C. C. A. 201; *Stelwagon Co. v. Childs*, 101 Fed. 989, 42 C. C. A. 127; *King v. Anderson*, 90 Fed. 500; *Wickelman v. A. B. Dick Co.*, 88 Fed. 264, 31 C. C. A. 530 [affirming 80 Fed. 519]; *American Graphophone Co. v. Leeds*, 87 Fed. 873; *Welsbach Light Co. v. Sunlight Incandescent Gas Lamp Co.*, 87 Fed. 221; *Holliday v. Schulze-Berge*, 78 Fed. 493; *Pasteur Chamberland Filter Co. v. Funk*, 52 Fed. 146; *Tibbe, etc., Mfg. Co. v. Lamparter*, 51 Fed. 763; *Vulcanite Co. v. American Co.*, 34 Fed. 320; *Roosevelt v. Law Tel. Co.*, 33



addition of other ingredients to those claimed does not avoid infringement if the essential character of the compound remains the same.<sup>20</sup> But an addition changing the character of the compound is no infringement.<sup>21</sup> There is no infringement if an ingredient claimed is omitted,<sup>22</sup> although in the specifications the use of such ingredient is stated to be for a particular case only.<sup>23</sup>

g. Substitution of Equivalents<sup>24</sup>—(i) *IN GENERAL*. Infringement is not

Fed. 505; *Hobbie v. Smith*, 27 Fed. 656; *Kimball v. Hess*, 15 Fed. 393; *Atlantic Giant-Powder Co. v. Goodyear*, 2 Fed. Cas. No. 623, 3 Ban. & A. 161, 13 Off. Gaz. 45; *Atlantic Giant-Powder Co. v. Parker*, 2 Fed. Cas. No. 625, 4 Ban. & A. 292, 16 Blatchf. 281, 16 Off. Gaz. 495; *Atlantic Giant-Powder Co. v. Rand*, 2 Fed. Cas. No. 626, 4 Ban. & A. 263, 16 Blatchf. 250, 16 Off. Gaz. 87; *Bryan v. Stevens*, 4 Fed. Cas. No. 2,066a; *Collender v. Came*, 6 Fed. Cas. No. 2,999, 2 Ban. & A. 412, 4 Cliff. 393, 10 Off. Gaz. 467; *Goodyear Dental Vulcanite Co. v. Gardiner*, 10 Fed. Cas. No. 5,591, 3 Cliff. 408, 4 Fish. Pat. Cas. 224; *Goodyear Dental Vulcanite Co. v. Preterre*, 10 Fed. Cas. No. 5,596, 3 Ban. & A. 471, 15 Blatchf. 274, 14 Off. Gaz. 346; *Hoffman v. Aronson*, 12 Fed. Cas. No. 6,576, 8 Blatchf. 324, 4 Fish. Pat. Cas. 456; *Rumford Chemical Works v. Hecker*, 20 Fed. Cas. No. 12,133, 2 Ban. & A. 351, 10 Off. Gaz. 289; *Tarr v. Folsom*, 23 Fed. Cas. No. 13,756, 1 Ban. & A. 24, Holmes 312, 50 Off. Gaz. 92; *Taylor v. Archer*, 23 Fed. Cas. No. 13,778, 8 Blatchf. 315, 4 Fish. Pat. Cas. 449; *United Nickel Co. v. Keith*, 24 Fed. Cas. No. 14,408, 1 Ban. & A. 44, Holmes 328, 5 Off. Gaz. 272; *United Nickel Co. v. Manhattan Brass Co.*, 24 Fed. Cas. No. 14,410, 4 Ban. & A. 173, 16 Blatchf. 68; *Woodward v. Morrison*, 30 Fed. Cas. No. 18,008, 5 Fish. Pat. Cas. 357, Holmes 124, 2 Off. Gaz. 120.

Equivalent ingredients are those known in the art as possessing the desired properties. *Goodyear Dental Vulcanite Co. v. Davis*, 102 U. S. 222, 26 L. ed. 149; *United Nickel Co. v. Pendleton*, 15 Fed. 739, 21 Blatchf. 226; *Babcock v. Judd*, 1 Fed. 408; *Atlantic Giant-Powder Co. v. Mowbray*, 2 Fed. Cas. No. 624, 2 Ban. & A. 442, 12 Off. Gaz. No. 14, p. iii; *Matthews v. Skates*, 16 Fed. Cas. No. 9,291, 1 Fish. Pat. Cas. 602; *Woodward v. Morrison*, 30 Fed. Cas. No. 18,008, 5 Fish. Pat. Cas. 357, Holmes 124, 2 Off. Gaz. 120. An ingredient may be equivalent, although subsequently discovered, if it performs no new function in the compound. *Read Holliday v. Schulze-Berge*, 78 Fed. 493.

Where the articles or compounds are the same, there is infringement, although they are made by different processes. *Maurer v. Dickerson*, 113 Fed. 870, 51 C. C. A. 494; *Badische Anilin, etc., Fabrik v. Cochrane*, 2 Fed. Cas. No. 719, 4 Ban. & A. 215, 16 Blatchf. 155; *Badische Anilin, etc., Fabrik v. Cummins*, 2 Fed. Cas. No. 720, 4 Ban. & A. 489; *Badische Anilin, etc., Fabrik v. Hamilton Mfg. Co.*, 2 Fed. Cas. No. 721, 3 Ban. & A. 235, 13 Off. Gaz. 273; *Badische Anilin, etc., Fabrik v. Higgin*, 2 Fed. Cas. No. 722, 3 Ban. & A. 462, 15 Blatchf. 290, 14 Off. Gaz. 414. The Baur patent, No. 451,847, for an

artificial musk, in view of the disclaimer filed, limiting it to the product of the process of patent No. 416,710 to the same patentee, is not infringed by a product not shown to have been made by such process. *Societe Fabriques, etc. v. Lueders*, 142 Fed. 753, 74 C. C. A. 15 [affirming 135 Fed. 102].

Not equivalent ingredients.—*Hurlbut v. Schillinger*, 130 U. S. 456, 9 S. Ct. 584, 32 L. ed. 1011; *New York Asbestos Mfg. Co. v. Ambler Asbestos Air-Cell Covering Co.*, 103 Fed. 316; *S. Rauh v. Guinzburg*, 101 Fed. 1007, 42 C. C. A. 139; *New Jersey Wire-Cloth Co. v. Merritt*, 101 Fed. 460, 41 C. C. A. 460; *Tower v. Eagle Pencil Co.*, 94 Fed. 361, 36 C. C. A. 294; *Matheson v. Campbell*, 78 Fed. 910, 24 C. C. A. 384; *Johns Mfg. Co. v. Robertson*, 77 Fed. 985, 23 C. C. A. 601; *Seabury v. Johnson*, 76 Fed. 456; *Atlantic Dynamite Co. v. Climax Powder Mfg. Co.*, 72 Fed. 925; *Blumenthal v. Burrell*, 53 Fed. 105, 3 C. C. A. 462 [affirming 43 Fed. 667]; *Edison Electric Light Co. v. U. S. Electric Lighting Co.*, 47 Fed. 454 [affirmed in 52 Fed. 300, 3 C. C. A. 83]; *Hood v. Boston Car Spring Co.*, 37 Fed. 792; *Western, etc., Mfg. Co. v. Rosenstock*, 30 Fed. 67; *Union Tubing Co. v. Patterson*, 23 Fed. 79; *Tucker v. Sargent*, 9 Fed. 299, 19 Blatchf. 538; *Ashcroft v. Hollings*, 2 Fed. Cas. No. 579, 11 Off. Gaz. 879; *Baldwin v. Schultz*, 2 Fed. Cas. No. 804, 9 Blatchf. 494, 5 Fish. Pat. Cas. 75, 2 Off. Gaz. 315, 319; *Clarke v. Johnson*, 5 Fed. Cas. No. 2,855, 4 Ban. & A. 403, 16 Blatchf. 495, 17 Off. Gaz. 1401; *Goodyear Dental Vulcanite Co. v. Flagg*, 10 Fed. Cas. No. 5,590, 9 Off. Gaz. 153; *Tarr v. Folsom*, 23 Fed. Cas. No. 13,756, 1 Ban. & A. 24, Holmes 312, 5 Off. Gaz. 92; *Union Paper Collar Co. v. White*, 24 Fed. Cas. No. 14,396, 2 Ban. & A. 60, 7 Off. Gaz. 698, 877, 11 Phila. (Pa.) 479, 1 Wkly. Notes Cas. (Pa.) 362; *West v. Silver Wire, etc., Mfg. Co.*, 29 Fed. Cas. No. 17,425, 5 Blatchf. 477, 3 Fish. Pat. Cas. 306; *Wonson v. Gilman*, 30 Fed. Cas. No. 17,933, 2 Ban. & A. 590, 11 Off. Gaz. 1011.

20. *Eastman v. Hinkel*, 8 Fed. Cas. No. 4,256, 5 Ban. & A. 1; *Thompson v. Jewett*, 23 Fed. Cas. No. 13,961; *United Nickel Co. v. Manhattan Brass Co.*, 24 Fed. Cas. No. 14,410, 4 Ban. & A. 173, 16 Blatchf. 68; *Wonson v. Peterson*, 30 Fed. Cas. No. 17,934, 3 Ban. & A. 249, 13 Off. Gaz. 548.

21. *Dougherty v. Doyle*, 63 Fed. 475, 11 C. C. A. 298 [affirming 59 Fed. 470].

22. *Otley v. Watkins*, 36 Fed. 323; *Byam v. Eddy*, 4 Fed. Cas. No. 2,263, 2 Blatchf. 521, 24 Vt. 666.

23. *Otley v. Watkins*, 36 Fed. 323.

24. Substitution of materials or equivalents as involving invention see *supra*, III, E, 14, 15.



evaded by substituting equivalent elements for those set forth in the patented claim.<sup>25</sup> Patentees of an invention consisting merely of a combination of old ingredients are entitled to equivalents, by which is meant that the patent in respect to each of the respective ingredients comprising the invention covers every other ingredient which, in the same arrangement of the parts, will perform the same function, if it was well known as a proper substitute for the one described in the specification at the date of the patent.<sup>26</sup>

(II) *WHAT ARE EQUIVALENTS.* Similarity or differences are to be determined not by the names but by what the elements will do.<sup>27</sup> Where there is iden-

25. *Union Water Meter Co. v. Desper*, 101 U. S. 332, 25 L. ed. 1024; *Ives v. Hamilton*, 92 U. S. 426, 23 L. ed. 494; *O'Reilly v. Morse*, 15 How. (U. S.) 62, 14 L. ed. 601; *Westinghouse Electric, etc., Co. v. Condit Electrical Mfg. Co.*, 159 Fed. 154; *Dey Time Register Co. v. Syracuse Time Recorder Co.*, 152 Fed. 440; *Benbow-Brammer Mfg. Co. v. Simpson Mfg. Co.*, 132 Fed. 614; *Kinloch Tel. Co. v. Western Electric Co.*, 113 Fed. 652, 51 C. C. A. 369; *Lepper v. Randall*, 113 Fed. 627, 51 C. C. A. 337; *Fruit-Cleaning Co. v. Fresno Home-Packing Co.*, 94 Fed. 845; *Bundy Mfg. Co. v. Detroit Time-Register Co.*, 94 Fed. 524, 36 C. C. A. 375; *Thompson v. Second Ave. Traction Co.*, 93 Fed. 824, 35 C. C. A. 620; *Hart, etc., Mfg. Co. v. Anchor Electric Co.*, 92 Fed. 657, 34 C. C. A. 606; *Huntington Dry-Pulverizer Co. v. Whittaker Cement Co.*, 89 Fed. 323; *Salomon v. Garvin Mach. Co.*, 84 Fed. 195; *Boston, etc., Electric St. R. Co. v. Bemis Car-Box Co.*, 80 Fed. 287, 25 C. C. A. 420; *Tripp Giant Leveler Co. v. Bresnahan*, 70 Fed. 982 [*affirmed* in 72 Fed. 920]; *McCormick Harvesting Mach. Co. v. Aultman*, 69 Fed. 371, 16 C. C. A. 259; *Oval Wood Dish Co. v. Sandy Creek, New York, Wood Mfg. Co.*, 60 Fed. 285; *Standard Folding Bed Co. v. Osgood*, 58 Fed. 583, 7 C. C. A. 382; *Cutcheon v. Herrick*, 52 Fed. 147 [*modified* in 60 Fed. 80]; *Hoe v. Cranston*, 42 Fed. 837; *Cohansey Glass Mfg. Co. v. Wharton*, 28 Fed. 189; *Putnam v. Hutchinson*, 12 Fed. 131, 11 Biss. 240; *Dederick v. Cassell*, 9 Fed. 306; *Singer Mfg. Co. v. Henry Stewart Co.*, 8 Fed. 920; *Barrett v. Hall*, 2 Fed. Cas. No. 1,047, 1 Mason 447, 1 Robb Pat. Cas. 207; *Foster v. Moore*, 9 Fed. Cas. No. 4,978, 1 Curt. 279; *May v. Johnson County*, 16 Fed. Cas. No. 9,334; *Rice v. Heald*, 20 Fed. Cas. No. 11,752; *Sloat v. Spring*, 22 Fed. Cas. No. 12,948a; *Consolidated Car Heating Co. v. Came*, [1903] A. C. 509, 72 L. J. P. C. 110, 89 L. T. Rep. N. S. 224; *Palmer v. Wagstaff*, 2 C. L. R. 1052, 9 Exch. 494, 23 L. J. Exch. 217; *Ellington v. Clark*, 58 L. T. Rep. N. S. 818; *Woodward v. Clement*, 10 Ont. 348; *Patrice v. Sylvester*, 23 Grant Ch. (U. C.) 573.

Combining parts of two patented structures which results in changing one type of machine into the other is an infringement. *National Cash Register Co. v. Grobet*, 153 Fed. 905, 82 C. C. A. 651.

26. *Imhaeuser v. Buerk*, 101 U. S. 647, 25 L. ed. 945.

27. *Columbia Wire Co. v. Kokomo Steel, etc., Co.*, 139 Fed. 578; *Stetson v. Herreshoff*

*Mfg. Co.*, 113 Fed. 952; *Western Electric Co. v. Home Tel. Co.*, 85 Fed. 649; *In re Boughton*, 3 Fed. Cas. No. 1,696, *McArthur Pat. Cas.* 278; *Smith v. Downing*, 22 Fed. Cas. No. 13,036, 1 Fish. Pat. Cas. 64.

Substantial and not technical identity is the test. *Sayre v. Scott*, 55 Fed. 971, 5 C. C. A. 366; *Brush Electric Co. v. Western Electric Light, etc., Co.*, 43 Fed. 533; *Delong v. Bickford*, 13 Fed. 32; *Whipple v. Middlesex Co.*, 29 Fed. Cas. No. 17,520, 4 Fish. Pat. Cas. 41.

Equivalents illustrated.—*Lidgerwood Mfg. Co. v. Lambert Hoisting Engine Co.*, 150 Fed. 364; *Robins Conveying Belt Co. v. American Road Mach. Co.*, 145 Fed. 923, 76 C. C. A. 461 [*affirming* 142 Fed. 221]; *Bredin v. Solomon*, 132 Fed. 161 [*affirmed* in 136 Fed. 187, 69 C. C. A. 203]; *Lepper v. Randall*, 113 Fed. 627, 51 C. C. A. 337; *Crown Cork, etc., Co. v. Aluminum Stopper Co.*, 108 Fed. 845, 48 C. C. A. 72 [*reversing* 100 Fed. 849]; *Dowagiac Mfg. Co. v. Smith*, 108 Fed. 67; *Kampfe v. Reichard*, 105 Fed. 624; *Owatonna Mfg. Co. v. Fargo*, 94 Fed. 519; *Beach v. Hobbs*, 92 Fed. 146, 34 C. C. A. 248 [*modifying* 82 Fed. 916]; *Heap v. Greene*, 91 Fed. 792, 34 C. C. A. 86 [*reversing* 75 Fed. 405]; *Huntington Dry-Pulverizer Co. v. Whittaker Cement Co.*, 89 Fed. 323; *Heap v. Tremont, etc., Mills*, 82 Fed. 449, 27 C. C. A. 316; *C. T. Ham Mfg. Co. v. R. E. Dietz Co.*, 69 Fed. 841, 13 C. C. A. 687 [*affirming* 58 Fed. 367, 13 C. C. A. 687]; *H. Tibbe, etc., Mfg. Co. v. Missouri Cob-Pipe Co.*, 62 Fed. 158; *Ballard v. McCluskey*, 58 Fed. 880; *Winchester Repeating Arms Co. v. American Buckle, etc., Co.*, 54 Fed. 703; *Riker v. Crocker-Wheeler Motor Co.*, 54 Fed. 519; *Consolidated Piedmont Cable Co. v. Pacific Cable R. Co.*, 53 Fed. 385, 3 C. C. A. 570; *Pacific Cable R. Co. v. Butte City St. R. Co.*, 52 Fed. 863 [*affirmed* in 60 Fed. 90, 8 C. C. A. 484]; *Municipal Signal Co. v. Gamewell Fire-Alarm Tel. Co.*, 52 Fed. 459; *Norton v. Jensen*, 49 Fed. 859, 1 C. C. A. 452; *Creamery Package Mfg. Co. v. Elgin Co-operative Butter Tub Co.*, 43 Fed. 892; *Harmon v. Struthers*, 43 Fed. 437; *Rapid Service Store R. Co. v. Taylor*, 43 Fed. 249; *Reed v. Smith*, 40 Fed. 882; *Simonds Counter Mach. Co. v. Knox*, 39 Fed. 702; *Root v. Third Ave. R. Co.*, 39 Fed. 281; *Coleman Hardware Co. v. Kellogg*, 39 Fed. 39; *Pullman's Palace-Car Co. v. Wagner Palace-Car Co.*, 38 Fed. 416; *Sawyer Spindle Co. v. Buttrick*, 37 Fed. 794; *Bradley, etc., Mfg. Co. v. Charles Parker Co.*, 35 Fed. 748; *Casey v. Butterfield*, 35 Fed. 77; *Morss v. Ufford*,



tity of operation there is equivalency.<sup>28</sup> Mere differences of form are immaterial

34 Fed. 37; Thaxter v. Boston Electric Co., 32 Fed. 833; Royer v. Coupe, 29 Fed. 358; Pennsylvania Diamond-Drill Co. v. Simpson, 29 Fed. 288; Hoyt v. Slocum, 26 Fed. 329; Norton Door-Check, etc., Co. v. Elliott Pneumatic Door-Check Co., 26 Fed. 320; Adams, etc., Mfg. Co. v. Excelsior Oil-Stove Mfg. Co., 26 Fed. 270; Parker v. Montpelier Carriage Co., 23 Fed. 886; Hartford Woven-Wire Mattress Co. v. Peerless Wire Mattress Co., 23 Fed. 587, 23 Blatchf. 227; Parker v. Stow, 23 Fed. 252; Maxheimer v. Meyer, 9 Fed. 460, 20 Blatchf. 17; Brainard v. Pulsifer, 7 Fed. 349; Aiken v. Dolan, 1 Fed. Cas. No. 110, 3 Fish. Pat. Cas. 197; American Whip Co. v. Lombard, 1 Fed. Cas. No. 319, 3 Ban. & A. 598, 4 Cliff. 495, 14 Off. Gaz. 900; Blake v. Robertson, 3 Fed. Cas. No. 1,500, 11 Blatchf. 237, 6 Fish. Pat. Cas. 509; Buchanan v. Howland, 4 Fed. Cas. No. 2,074, 5 Blatchf. 151, 2 Fish. Pat. Cas. 341; Cook v. Howard, 6 Fed. Cas. No. 3,160, 4 Fish. Pat. Cas. 269; Crehore v. Norton, 6 Fed. Cas. No. 3,381; Doughty v. West, 7 Fed. Cas. No. 4,028, 6 Blatchf. 429, 3 Fish. Pat. Cas. 580; Gibson v. Harris, 10 Fed. Cas. No. 5,396, 1 Blatchf. 167, Fish. Pat. Rep. 115; Gibson v. Van Dresar, 10 Fed. Cas. No. 5,402, 1 Blatchf. 532, Fish. Pat. Rep. 369; Harwood v. Mill River Woolen Mfg. Co., 11 Fed. Cas. No. 6,187, 3 Fish. Pat. Cas. 526; Johnsen v. Fassman, 13 Fed. Cas. No. 7,365, 5 Fish. Pat. Cas. 471, 1 Woods 138, 2 Off. Gaz. 94; Knox v. Loweree, 14 Fed. Cas. No. 7,910, 1 Ban. & A. 589, 6 Off. Gaz. 802; Maynadier v. Tenney, 16 Fed. Cas. No. 9,350, 2 Ban. & A. 615; Megraw v. Carroll, 16 Fed. Cas. No. 9,393b, 5 Ban. & A. 324; Myers v. Frame, 17 Fed. Cas. No. 9,991, 8 Blatchf. 446, 4 Fish. Pat. Cas. 493 [reversed on other grounds in 94 U. S. 187, 24 L. ed. 34]; Parker v. Remhoff, 18 Fed. Cas. No. 10,747, 3 Ban. & A. 550, 17 Blatchf. 206, 14 Off. Gaz. 601; Tilghman v. Morse, 23 Fed. Cas. No. 14,044, 9 Blatchf. 421, 5 Fish. Pat. Cas. 323, 1 Off. Gaz. 574; Waterbury Brass Co. v. Miller, 29 Fed. Cas. No. 17,254, 9 Blatchf. 77, 5 Fish. Pat. Cas. 48; Waterbury Brass Co. v. New York, etc., Brass Co., 29 Fed. Cas. No. 17,256, 3 Fish. Pat. Cas. 43; Weston v. Nash, 29 Fed. Cas. No. 17,454, 2 Ban. & A. 40, Holmes 488, 7 Off. Gaz. 1096; Woolcocks v. Many, 30 Fed. Cas. No. 18,024, 9 Blatchf. 139, 5 Fish. Pat. Cas. 72; Berdan Fire-Arms Mfg. Co. v. U. S., 25 Ct. Cl. 355.

Not equivalents.—Cimiotti Unhairing Co. v. American Fur Refining Co., 198 U. S. 399, 25 S. Ct. 697, 49 L. ed. 1100 [affirming 123 Fed. 869, 59 C. C. A. 357]; Black Diamond Coal-Min. Co. v. Excelsior Coal Co., 156 U. S. 611, 15 S. Ct. 482, 39 L. ed. 553; Gates Iron Works v. Fraser, 153 U. S. 332, 14 S. Ct. 883, 38 L. ed. 734; Ball, etc., Fastener Co. v. Kraetzer, 150 U. S. 111, 14 S. Ct. 48, 37 L. ed. 1019; Weatherhead v. Coupe, 147 U. S. 322, 13 S. Ct. 312, 37 L. ed. 188; Joyce v. Chillicothe Foundry, etc., Co., 127 U. S. 557, 8 S. Ct. 1311, 32 L. ed. 171; Forncrook v. Root, 127 U. S. 176, 8 S. Ct. 1247, 32 L. ed.

97; Matthews v. Iron-Clad Mfg. Co., 124 U. S. 347, 8 S. Ct. 639, 31 L. ed. 477; Electric R. Signal Co. v. Hall R. Signal Co., 114 U. S. 87, 5 S. Ct. 1069, 29 L. ed. 96; Blake v. San Francisco, 113 U. S. 679, 5 S. Ct. 692, 28 L. ed. 1070; L. E. Waterman Co. v. McCutcheon, 127 Fed. 1020, 61 C. C. A. 653; Evans v. Newark Rivet Works, 121 Fed. 133 [affirmed in 126 Fed. 492, 61 C. C. A. 474]; L. E. Waterman Co. v. Forsyth, 121 Fed. 107 [affirmed in 128 Fed. 926, 63 C. C. A. 648]; Wellman v. Midland Steel Co., 106 Fed. 221; Lepper v. Randall, 105 Fed. 975; McCully v. Kny-Scheerer Co., 103 Fed. 648; Dodge v. Ohio Valley Pulley Works, 101 Fed. 581; Rauh v. Guinzburg, 95 Fed. 151; Johnson Electric Service Co. v. Powers Regulator Co., 85 Fed. 863, 29 C. C. A. 459; Norton v. Jensen, 81 Fed. 494; Engle Sanitary, etc., Co. v. Elwood, 73 Fed. 484; Wells v. Curtis, 66 Fed. 318, 13 C. C. A. 494; Whitcomb Envelope Co. v. Logan, etc., Envelope Co., 63 Fed. 982; Ball, etc., Fastener Co. v. Ball Glove Fastening Co., 58 Fed. 818, 7 C. C. A. 498; Detwiler v. Bosler, 58 Fed. 249, 55 Fed. 660; Morss v. Domestic Sewing-Mach. Co., 55 Fed. 79, 5 C. C. A. 47; Holloway v. Dow, 54 Fed. 511; Dudley E. Jones Co. v. Munger Improved Cotton Mach. Mfg. Co., 49 Fed. 61, 1 C. C. A. 158; Hitchcock v. Wanzer Lamp Co., 45 Fed. 362; Sackett v. Smith, 42 Fed. 846; Brush Electric Co. v. Julien Electric Co., 41 Fed. 679; Ligowsky Clay-Pigeon Co. v. Peoria Target Co., 35 Fed. 758; Eastern Paper-Bag Co. v. Standard Paper-Bag Co., 29 Fed. 787; McFarland v. Deere, etc., Mfg. Co., 22 Fed. 781; Deis v. Doll, 21 Fed. 523; Lloyd v. Miller, 19 Fed. 915; Field v. Ireland, 19 Fed. 835; Schmidt v. Freese, 12 Fed. 563; Field v. De Comean, 9 Fed. Cas. No. 4,765, 5 Ban. & A. 40, 17 Off. Gaz. 568 [affirmed in 116 U. S. 187, 6 S. Ct. 363, 29 L. ed. 596]; Forsyth v. Clapp, 9 Fed. Cas. No. 4,949, 6 Fish. Pat. Cas. 528, Holmes 278, 4 Off. Gaz. 527; Sickles v. Youngs, 22 Fed. Cas. No. 12,838, 3 Blatchf. 293; Sickles v. Evans, 22 Fed. Cas. No. 12,839, 2 Cliff. 203, 2 Fish. Pat. Cas. 417; Smith v. Marshall, 22 Fed. Cas. No. 13,077, 2 Ban. & A. 371, 10 Off. Gaz. 375; Wheeler v. Simpson, 29 Fed. Cas. No. 17,500, 1 Ban. & A. 420, 6 Off. Gaz. 435.

28. Westinghouse Mach. Co. v. Press Pub. Co., 127 Fed. 822 [reversed on other grounds in 135 Fed. 767, 68 C. C. A. 469]; Anderson v. Collins, 122 Fed. 451, 58 C. C. A. 669; Cimiotti Unhairing Co. v. Nearsale Unhairing Co., 115 Fed. 507, 53 C. C. A. 161 [affirming 113 Fed. 588]; Powell v. Leicester Mills Co., 108 Fed. 386, 47 C. C. A. 416; Rosenblatt v. Fraser Tablet Triturate Mfg. Co., 106 Fed. 733; Diamond State Iron Co. v. Goldie, 84 Fed. 972, 28 C. C. A. 589; Bowers v. Von Schmidt, 63 Fed. 572.

On the other hand literal application of claims does not make infringement where the principle of operation is different. Boyden Power-Brake Co. v. Westinghouse, 170 U. S. 537, 18 S. Ct. 707, 42 L. ed. 1136 [reversing 70 Fed. 816, 17 C. C. A. 430]; Standard Com-



if the function and result are the same;<sup>29</sup> and a part is no less equivalent because it performs additional functions.<sup>30</sup> Parts are also equivalents whether made integral or separate.<sup>31</sup> Parts are not equivalents if they do not operate to perform the same function.<sup>32</sup> They must perform substantially the same function in substantially the same way to produce the same result,<sup>33</sup> or where reorganization is necessary to effect the substitution.<sup>34</sup> Substitution of a material not known as an equivalent is not infringement.<sup>35</sup>

### (III) NECESSITY FOR KNOWLEDGE OF EQUIVALENT AT DATE OF PATENT.

To constitute infringement by the substitution of equivalents, it is essential that the equivalent was known at the date of the patent as a proper substitute.<sup>36</sup>

puting Scale Co. v. Computing Scale Co., 126 Fed. 639, 61 C. C. A. 541.

29. Hillard v. Fisher Book Typewriter, 159 Fed. 439; Eck v. Kutz, 132 Fed. 758; Dowagiac Mfg. Co. v. Minnesota Moline Plow Co., 118 Fed. 136, 55 C. C. A. 86; Adams Co. v. Schreiber, etc., Mfg. Co., 111 Fed. 182; Huntington Dry-Pulverizer Co. v. Whittaker Cement Co., 89 Fed. 323; Adams v. Keystone Mfg. Co., 41 Fed. 595; Celluloid Mfg. Co. v. American Zylonite Co., 31 Fed. 904; U. S. Metallic Packing Co. v. Tripp, 31 Fed. 350; Adams v. Bridgewater Iron Co., 26 Fed. 324; Shannon v. J. M. W. Jones Stationery, etc., Co., 9 Fed. 205, 10 Biss. 498; Adams v. Joliet Mfg. Co., 1 Fed. Cas. No. 56, 3 Ban. & A. 1, 12 Off. Gaz. 93; Smith v. Higgins, 22 Fed. Cas. Nos. 13,057, 13,059, 1 Fish. Pat. Cas. 537.

30. Universal Brush Co. v. Sonn, 146 Fed. 517 [reversed on other grounds in 154 Fed. 665, 83 C. C. A. 422]; Comptograph Co. v. Mechanical Accountant Co., 145 Fed. 331, 75 C. C. A. 205; Atlantic Giant-Powder Co. v. Goodyear, 2 Fed. Cas. No. 623, 3 Ban. & A. 161, 13 Off. Gaz. 45; Foss v. Herbert, 9 Fed. Cas. No. 4,957, 1 Biss. 121, 2 Fish. Pat. Cas. 31; Sarven v. Hall, 21 Fed. Cas. No. 12,369, 9 Blatchf. 524, 5 Fish. Pat. Cas. 415, 1 Off. Gaz. 437; Wheeler v. Clipper Mower, etc., Co., 29 Fed. Cas. No. 17,493, 10 Blatchf. 181, 6 Fish. Pat. Cas. 1, 2 Off. Gaz. 442.

31. Standard Caster, etc., Co. v. Caster Socket Co., 113 Fed. 162, 51 C. C. A. 109; Bundy Mfg. Co. v. Detroit Time-Register Co., 94 Fed. 524, 36 C. C. A. 375; Brown v. Reed Mfg. Co., 81 Fed. 48; Fryer v. New York Mut. L. Ins. Co., 30 Fed. 787; Baldwin v. Bernard, 2 Fed. Cas. No. 797, 9 Blatchf. 509 note, 5 Fish. Pat. Cas. 442, 2 Off. Gaz. 320; Baldwin v. Schultz, 2 Fed. Cas. No. 804, 9 Blatchf. 494, 5 Fish. Pat. Cas. 75, 2 Off. Gaz. 315, 319.

32. Hubbell v. U. S., 179 U. S. 86, 21 S. Ct. 28, 45 L. ed. 100; Dey Time Register Co. v. Syracuse Time Recorder Co., 152 Fed. 440; Campbell Printing-Press, etc., Co. v. Duplex Printing-Press Co., 86 Fed. 315; Scarborough v. Neff, 75 Fed. 579; Engle Sanitary, etc., Co. v. Elwood, 73 Fed. 484; Binder v. Atlanta Cotton Seed Oil Mills, 73 Fed. 480; Richardson v. American Pin Co., 73 Fed. 476; Jackson v. Birmingham Brass Co., 72 Fed. 269 [affirmed in 79 Fed. 801, 25 C. C. A. 196]; New York Paper-Bag Mach., etc., Co. v. Hollingsworth, etc., Co., 56 Fed. 224, 5 C. C. A. 490 [affirming 48 Fed. 562]; Williams v. Steam-Gauge, etc., Co., 47 Fed. 322; Bortree

v. Jackson, 43 Fed. 136; Peninsular Novelty Co. v. American Shoe-Tip Co., 39 Fed. 791; Huntington v. Hartford Heel-Plate Co., 36 Fed. 689; Matthews v. Chambers, 6 Fed. 874; Blake v. Rawson, 3 Fed. Cas. No. 1,499, 6 Fish. Pat. Cas. 74, Holmes 200, 3 Off. Gaz. 122; Bridge v. Brown, 4 Fed. Cas. No. 1,858, 6 Fish. Pat. Cas. 236, Holmes 205, 3 Off. Gaz. 121; Brown v. Rubber Step Mfg. Co., 4 Fed. Cas. No. 2,028, 3 Ban. & A. 232, 13 Off. Gaz. 369.

33. Rowell v. Lindsay, 113 U. S. 97, 5 S. Ct. 507, 28 L. ed. 906 [affirming 6 Fed. 290, 10 Biss. 217]; O. H. Jewell Filter Co. v. Jackson, 140 Fed. 340, 72 C. C. A. 304; International Mfg. Co. v. H. F. Brammer Mfg. Co., 138 Fed. 396, 71 C. C. A. 633; Kinloch Tel. Co. v. Western Electric Co., 113 Fed. 652, 51 C. C. A. 362; Wilt v. Grier, 5 Fed. 450; Burden v. Corning, 4 Fed. Cas. No. 2,143, 2 Fish. Pat. Cas. 477; Johnson v. Root, 13 Fed. Cas. No. 7,410, 2 Cliff. 637; May v. Johnson County, 16 Fed. Cas. No. 9,334.

Similarity of result is not sufficient.—Rich v. Baldwin, 133 Fed. 920, 66 C. C. A. 464; Diamond Drill, etc., Co. v. Kelly, 120 Fed. 289; Union Steam-Pump Co. v. Battle Creek Steam-Pump Co., 104 Fed. 337, 43 C. C. A. 560; Powell v. Leicester Mills Co., 103 Fed. 476 [reversed on other grounds in 108 Fed. 386, 47 C. C. A. 416]; Wilson v. McCormick Harvesting Mach. Co., 92 Fed. 167, 34 C. C. A. 280; Schmidt v. Freese, 12 Fed. 563.

34. American Pneumatic Tool Co. v. Philadelphia Pneumatic Tool Co., 123 Fed. 891; Pittsburg Meter Co. v. Pittsburg Supply Co., 109 Fed. 644, 48 C. C. A. 580; Crompton v. Belknap Mills, 30 Fed. Cas. No. 18,285, 3 Fish. Pat. Cas. 536.

35. Badische Anilin, etc., Fabrik v. Levinstein, 24 Ch. D. 156, 52 L. J. Ch. 704, 48 L. T. Rep. N. S. 822, 31 Wkly. Rep. 913 [affirmed in 12 App. Cas. 710, 57 L. T. Rep. N. S. 853].

36. Imhaeuser v. Buerk, 101 U. S. 647, 25 L. ed. 945; Seymour v. Osborne, 11 Wall. (U. S.) 516, 20 L. ed. 33; Magic Light Co. v. Economy Gas-Lamp Co., 97 Fed. 87, 38 C. C. A. 56; Jones Co. v. Munger Improved Cotton Mach. Mfg. Co., 49 Fed. 61, 1 C. C. A. 158; Rowell v. Lindsay, 6 Fed. 290, 10 Biss. 217 [affirmed in 113 U. S. 97, 5 S. Ct. 507, 28 L. ed. 906]; King v. Louisville Cement Co., 14 Fed. Cas. No. 7,798, 6 Fish. Pat. Cas. 336, 4 Off. Gaz. 181; Sands v. Wardwell, 21 Fed. Cas. No. 12,306, 3 Cliff. 277; Union Sugar Refinery v. Matthiesson, 24 Fed. Cas. No.



**h. Omission of Parts.**<sup>37</sup> A claim is not infringed when an element included therein is omitted and no equivalent is used;<sup>38</sup> and the rule applies, although the element is not really essential.<sup>39</sup> However, the omission of features not claimed does not avoid infringement.<sup>40</sup>

14,399, 3 Cliff. 639, 2 Fish. Pat. Cas. 600; Webster v. New Brunswick Carpet Co., 29 Fed. Cas. No. 17,337, 1 Ban. & A. 84, 5 Off. Gaz. 522; Welling v. Rubber-Coated Harness Trimming Co., 29 Fed. Cas. No. 17,382, 1 Ban. & A. 282, 7 Off. Gaz. 606.

**see 37. Omission of parts as involving invention**  
see *supra*, III, E, 17.

38. Black Diamond Coal-Min. Co. v. Excelsior Coal Co., 156 U. S. 611, 15 S. Ct. 482, 39 L. ed. 553; Phoenix Caster Co. v. Spiegel, 133 U. S. 360, 10 S. Ct. 409, 33 L. ed. 663; Peters v. Active Mfg. Co., 129 U. S. 530, 9 S. Ct. 389, 32 L. ed. 738; Prouty v. Ruggles, 16 Pet. (U. S.) 336, 10 L. ed. 985; Mallon v. Gregg, 137 Fed. 68, 69 C. C. A. 48; Westinghouse Electric, etc., Co. v. Cutter Electric, etc., Co., 136 Fed. 217 [*reversed* on other grounds in 143 Fed. 966, 75 C. C. A. 540]; Levy v. Harris, 124 Fed. 69 [*affirmed* in 130 Fed. 711, 65 C. C. A. 113]; Mayo Knitting Mach., etc., Co. v. Jenckes Mfg. Co., 121 Fed. 110 [*affirmed* in 133 Fed. 527, 66 C. C. A. 557]; American School-Furniture Co. v. J. M. Sauder Co., 113 Fed. 576; Moore v. Eggers, 107 Fed. 491, 46 C. C. A. 425; Parsons v. Minneapolis Threshing-Mach. Co., 106 Fed. 941; National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co., 106 Fed. 693, 45 C. C. A. 544; Thomson Meter Co. v. National Meter Co., 106 Fed. 519; Keyes v. United Indurated Fibre Co., 104 Fed. 1006, 44 C. C. A. 265; Goodyear Shoe Mach. Co. v. Spaulding, 101 Fed. 990; Crown Cork, etc., Co. v. Aluminum Stopper Co., 100 Fed. 849; Mesick v. Moore, 100 Fed. 845; Ryan v. Runyon, 93 Fed. 970, 36 C. C. A. 36; Regina Music-Box Co. v. Paillard, 85 Fed. 644; Keyes v. United Indurated Fibre Co., 82 Fed. 32; Kansas City Hay-Press Co. v. Devol, 81 Fed. 726, 26 C. C. A. 578; Roemer v. Peddie, 81 Fed. 380, 26 C. C. A. 440; Excelsior Coal Co. v. Oregon Imp. Co., 79 Fed. 355, 24 C. C. A. 640; Carter Mach. Co. v. Hanes, 78 Fed. 346, 24 C. C. A. 128; Adams Electric R. Co. v. Lindell R. Co., 77 Fed. 432, 23 C. C. A. 223; Murphy Mfg. Co. v. Excelsior Car-Roof Co., 76 Fed. 965, 22 C. C. A. 658; Wheaton v. Norton, 70 Fed. 833, 17 C. C. A. 447; Adeo v. J. L. Mott Iron-Works, 55 Fed. 876, 5 C. C. A. 288; Baumer v. Will, 53 Fed. 373; Adeo v. J. L. Mott Iron-Works, 46 Fed. 77; Mack v. Levy, 43 Fed. 69; Sun Vapor St. Light Co. v. Western St. Light Co., 41 Fed. 43; Catchpole v. Pulsifer, 35 Fed. 766; Ligowski Clay-Pigeon Co. v. Peoria Target Co., 35 Fed. 755; Kidd v. Ransom, 35 Fed. 588; Wight Fireproofing Co. v. Chicago Fireproof Co., 35 Fed. 582; Wheeler v. Hart, 32 Fed. 78 [*affirmed* in 140 U. S. 704, 11 S. Ct. 1031, 35 L. ed. 602]; Tobey Furniture Co. v. Colby, 26 Fed. 100; Sheeder v. Shannon, 25 Fed. 824 [*affirmed* in 131 U. S. 447, 9 S. Ct. 803, 33 L. ed. 224]; Taft v. Steere, 19 Fed. 600; Snow v. Lake Shore, etc., R. Co.,

18 Fed. 602 [*affirmed* in 121 U. S. 617, 7 S. Ct. 1343, 30 L. ed. 1004]; National Pump Cylinder Co. v. Simmons Hardware Co., 18 Fed. 324, 5 McCrary 592; Doane, etc., Mfg. Co. v. Smith, 15 Fed. 459; Fay v. Preble, 14 Fed. 652, 11 Biss. 422; Morgan Elevated R. Co. v. Pullman, 14 Fed. 648; Goss v. Cameron, 14 Fed. 576, 11 Biss. 389; Hayes v. Seton, 12 Fed. 120, 20 Blatchf. 484; Onderdonk v. Fanning, 9 Fed. 106, 19 Blatchf. 363; Rowell v. Lindsay, 6 Fed. 290, 10 Biss. 217 [*affirmed* in 113 U. S. 97, 5 S. Ct. 507, 28 L. ed. 906]; Baldwin v. Schultz, 2 Fed. Cas. No. 804, 9 Blatchf. 494, 5 Fish. Pat. Cas. 75, 2 Off. Gaz. 315, 319; Bliss v. Haight, 3 Fed. Cas. No. 1,548, 7 Blatchf. 7, 3 Fish. Pat. Cas. 621; Brown v. Hinkley, 4 Fed. Cas. No. 2,012, 6 Fish. Pat. Cas. 370, 3 Off. Gaz. 384; Burr v. Cowperthwait, 4 Fed. Cas. No. 2,188, 4 Blatchf. 163; Case v. Brown, 5 Fed. Cas. No. 2,488, 1 Biss. 382, 2 Fish. Pat. Cas. 268; Craig v. Smith, 6 Fed. Cas. No. 3,339, 1 Ban. & A. 556, 4 Dill. 349 [*affirmed* in 100 U. S. 226, 25 L. ed. 577]; Dodge v. Card, 7 Fed. Cas. No. 3,951, 1 Bond 393, 2 Fish. Pat. Cas. 116; Evarts v. Ford, 8 Fed. Cas. No. 4,574, 6 Fish. Pat. Cas. 587, 5 Off. Gaz. 58; Florence Mfg. Co. v. Boston Diatite Co., 9 Fed. Cas. No. 4,882, 1 Ban. & A. 396, Holmes 415, 6 Off. Gaz. 728; Hailes v. Van Wormer, 11 Fed. Cas. No. 5,904, 7 Blatchf. 443 [*affirmed* in 20 Wall. 353, 22 L. ed. 241]; Hale v. Stimpson, 11 Fed. Cas. No. 5,915, 2 Fish. Pat. Cas. 565; Haselden v. Ogden, 11 Fed. Cas. No. 6,190, 3 Fish. Pat. Cas. 378; Hayden v. Suffolk Mfg. Co., 11 Fed. Cas. No. 6,261, 4 Fish. Pat. Cas. 86 [*affirmed* in 3 Wall. 315, 18 L. ed. 761]; Hill v. Houghton, 12 Fed. Cas. No. 6,493, 1 Ban. & A. 291, 6 Off. Gaz. 3; Roberts v. Harnden, 20 Fed. Cas. No. 11,903, 2 Cliff. 500; Sands v. Wardwell, 21 Fed. Cas. No. 12,306, 3 Cliff. 277; Sanford v. Merri-mack Hat Co., 21 Fed. Cas. No. 12,313, 2 Ban. & A. 408, 4 Cliff. 404, 10 Off. Gaz. 466; Smith v. Higgins, 22 Fed. Cas. No. 13,060, 2 Fish. Pat. Cas. 97; Sweetser v. Helms, 23 Fed. Cas. No. 13,689, 2 Ban. & A. 263, 10 Off. Gaz. 4; Seed v. Higgins, 8 H. L. Cas. 550, 6 Jur. N. S. 1264, 30 L. J. Q. B. 314, 3 L. T. Rep. N. S. 101, 11 Eng. Reprint 544.

39. Wright v. Yuengling, 155 U. S. 47, 15 S. Ct. 1, 39 L. ed. 64; Henry Huber Co. v. J. L. Mott Iron Works, 113 Fed. 599; Elfelt v. Steinhart, 11 Fed. 896, 6 Sawy. 480; Dodge v. Fearey, 8 Fed. 329.

In Canada the omission of essential parts avoids infringement. Consolidated Car Heating Co. v. Came, [1903] A. C. 509, 72 L. J. P. C. 110, 89 L. T. Rep. N. S. 224. Omission will not avoid infringement where the essence is taken. Consolidated Car Heating Co. v. Came, 18 Quebec Super. Ct. 44.

40. Letson v. Alaska Packers' Assoc., 130 Fed. 129, 64 C. C. A. 463 [*modifying* 119 Fed. 599]; Hobbs Mfg. Co. v. Gooding, 111



i. **Addition of Parts.**<sup>41</sup> The addition of one or more parts or features to the construction claimed securing additional functions will not avoid infringement.<sup>42</sup> There is no infringement, however, where the combination claimed is changed or destroyed by the addition making a new combination.<sup>43</sup>

j. **Transposition of Elements.**<sup>44</sup> A mere change in the location of an element will not avoid infringement where the operation is substantially the same,<sup>45</sup> but a

Fed. 403, 49 C. C. A. 414; *Brammer v. Schroeder*, 106 Fed. 918, 46 C. C. A. 41; *National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co.*, 106 Fed. 693, 45 C. C. A. 544; *Bresnahan v. Tripp Giant Leveller Co.*, 102 Fed. 899, 43 C. C. A. 48; *Boston v. Allen*, 91 Fed. 248, 33 C. C. A. 485; *Mast v. Dempster Mills Mfg. Co.*, 82 Fed. 327, 27 C. C. A. 191; *National Cash-Register Co. v. American Cash-Register Co.*, 53 Fed. 367, 3 C. C. A. 559; *American Automaton Weighing Mach. Co. v. Blauvelt*, 50 Fed. 213; *National Cash-Register Co. v. Boston Cash Indicator, etc., Co.*, 45 Fed. 481; *National Car-Brake Shoe Co. v. Lake Shore, etc., R. Co.*, 4 Fed. 219, 9 Biss. 503; *Francis v. Mellor*, 9 Fed. Cas. No. 5,039, 5 Fish. Pat. Cas. 153, 1 Off. Gaz. 48, 8 Phila. (Pa.) 157; *Jurgensen v. Magnin*, 14 Fed. Cas. No. 7,586, 9 Blatchf. 294, 5 Fish. Pat. Cas. 237; *Macdonald v. Shepard*, 16 Fed. Cas. No. 8,767, 4 Ban. & A. 343.

41. Duplication of parts as involving invention see *supra*, III, E, 11.

42. *Rees v. Gould*, 15 Wall. (U. S.) 187, 21 L. ed. 39; *Walker Patent Pivoted Bin Co. v. Miller*, 132 Fed. 823 [*affirmed* in 139 Fed. 134, 71 C. C. A. 398]; *Dowagiac Mfg. Co. v. Brennan*, 118 Fed. 143 [*reversed* on other grounds in 127 Fed. 143, 62 C. C. A. 257]; *Brislin v. Carnegie Steel Co.*, 118 Fed. 579 [*reversed* on other grounds in 124 Fed. 213, 59 C. C. A. 651]; *Powell v. Leicester Mills Co.*, 108 Fed. 386, 47 C. C. A. 416 [*reversing* 103 Fed. 476]; *Newton v. McGuire*, 97 Fed. 614; *Consolidated Fastener Co. v. Hays*, 95 Fed. 168; *Jones v. Holman*, 58 Fed. 973 [*reversed* on other grounds in 61 Fed. 105, 680, 9 C. C. A. 385]; *Heaton-Peninsular Button-Fastener Co. v. Elliott Button-Fastener Co.*, 58 Fed. 220; *Williams v. Barnard*, 41 Fed. 358; *Baldwin v. T. G. Conway Co.*, 35 Fed. 519; *Filley v. Littlefield Stove Co.*, 30 Fed. 434; *Wirt v. Brown*, 30 Fed. 188; *Blake v. Robertson*, 3 Fed. Cas. No. 1,501, 6 Off. Gaz. 297 [*affirmed* in 94 U. S. 728, 24 L. ed. 245]; *Cleveland v. Towle*, 5 Fed. Cas. No. 2,888, 3 Fish. Pat. Cas. 525; *Earle v. Harlow*, 8 Fed. Cas. No. 4,246, 2 Ban. & A. 264, 9 Off. Gaz. 1018; *Imlay v. Norwich, etc., R. Co.*, 13 Fed. Cas. No. 7,012, 4 Blatchf. 227, 1 Fish. Pat. Cas. 340; *Johnson v. Root*, 13 Fed. Cas. No. 7,411, 1 Fish. Pat. Cas. 351; *Magie Ruffle Co. v. Elm City Co.*, 16 Fed. Cas. No. 8,949, 2 Ban. & A. 152, 13 Blatchf. 151, 8 Off. Gaz. 773; *Pitts v. Wemple*, 19 Fed. Cas. No. 11,195, 6 McLean 558; *Robertson v. Hill*, 20 Fed. Cas. No. 11,925, 6 Fish. Pat. Cas. 465, 4 Off. Gaz. 132; *Waterbury Brass Co. v. New York, etc., Brass Co.*, 29 Fed. Cas. No. 17,256, 3 Fish. Pat. Cas. 43; *Williams v. Boston, etc., R. Co.*, 29

Fed. Cas. No. 17,716, 4 Ban. & A. 441, 17 Blatchf. 21, 16 Off. Gaz. 906.

Making one of the parts perform additional functions does not avoid infringement. *Colby v. Card*, 63 Fed. 462 [*reversed* on other grounds in 64 Fed. 594, 12 C. C. A. 319]; *Pacific Cable R. Co. v. Butte City St. R. Co.*, 55 Fed. 760 [*reversed* in 60 Fed. 410, 9 C. C. A. 41]; *Massey v. Palm*, 51 Fed. 824; *Brush Electric Co. v. Ft. Wayne Electric Co.*, 44 Fed. 284; *Holmes Burglar Alarm Tel. Co. v. Domestic Tel., etc., Co.*, 42 Fed. 220; *Shaver v. Skinner Mfg. Co.*, 30 Fed. 68; *Yale Lock Mfg. Co. v. Norwich Nat. Bank*, 6 Fed. 377, 19 Blatchf. 123; *New York Rubber Co. v. Chaskel*, 18 Fed. Cas. No. 10,215, 9 Off. Gaz. 923; *Sloat v. Spring*, 22 Fed. Cas. No. 12,948a.

Duplicating one or more parts will not avoid infringement. *Diamond State Iron Co. v. Goldie*, 84 Fed. 972, 28 C. C. A. 589 [*affirming* 81 Fed. 173]; *Westinghouse v. New York Air-Brake Co.*, 59 Fed. 581 [*modified* in 63 Fed. 962, 11 C. C. A. 528]; *Butz Thermo-Electric Regulator Co. v. Jacobs Electric Co.*, 36 Fed. 191; *Blake v. Eagle Works Mfg. Co.*, 3 Fed. Cas. No. 1,494, 3 Biss. 77, 4 Fish. Pat. Cas. 591; *Kittle v. Frost*, 14 Fed. Cas. No. 7,856, 9 Blatchf. 214, 5 Fish. Pat. Cas. 213; *Pike v. Providence, etc., R. Co.*, 19 Fed. Cas. No. 11,613, 1 Ban. & A. 560, *Holmes* 445, 6 Off. Gaz. 575.

Interposing parts in combination will not avoid infringement where the operation of the combination is the same. *Union R. Co. v. Sprague Electric R., etc., Co.*, 88 Fed. 82, 31 C. C. A. 391; *Steel-Clad Bath Co. v. Davison*, 77 Fed. 736; *Loercher v. Crandal*, 11 Fed. 872, 20 Blatchf. 106.

43. *Voss v. Fisher*, 113 U. S. 213, 5 S. Ct. 511, 28 L. ed. 975; *Barr Co. v. New York, etc., Automatic Sprinkler Co.*, 35 Fed. 513; *Reckendorfer v. Faber*, 20 Fed. Cas. No. 11,625, 1 Ban. & A. 229, 12 Blatchf. 68, 5 Off. Gaz. 697 [*affirmed* in 92 U. S. 347, 23 L. ed. 719]; *Robertson v. Hill*, 20 Fed. Cas. No. 11,925, 6 Fish. Pat. Cas. 465, 4 Off. Gaz. 132.

44. Change of location of parts as involving invention see *supra*, III, E, 16.

45. *Wagner Typewriter Co. v. Wyckoff*, 151 Fed. 585, 81 C. C. A. 129 [*modifying* 138 Fed. 108]; *Pettibone v. Pennsylvania Steel Co.*, 133 Fed. 730 [*reversed* on other grounds in 141 Fed. 95]; *Consolidated Fastener Co. v. Hays*, 100 Fed. 984, 41 C. C. A. 142; *Schroeder v. Brammer*, 98 Fed. 880; *Sawyer Spindle Co. v. W. G. & A. R. Morrison Co.*, 54 Fed. 693; *Henzel v. California Electrical Works*, 51 Fed. 754, 2 C. C. A. 495; *Norton v. Jensen*, 49 Fed. 859, 1 C. C. A. 452; *California Electrical Works v. Henzel*, 48 Fed.



rearrangement producing different operations but the same result is not an infringement.<sup>46</sup>

**k. Repair.** The purchaser of a patented machine has the right to use it until worn out,<sup>47</sup> and therefore he may repair it and substitute new parts for old so long as the identity of the machine is not destroyed.<sup>48</sup> He may not, however,

375; Sawyer Spindle Co. v. Eureka Spindle Co., 33 Fed. 836 [affirmed in 145 U. S. 637, 12 S. Ct. 980, 36 L. ed. 849]; Kirk v. Du Bois, 33 Fed. 252; Belle Patent Button Fastener Co. v. Lucas, 28 Fed. 371; Hartford Mach. Screw Co. v. Reynolds, 26 Fed. 528; Hoyt v. Slocum, 26 Fed. 329; Putnam v. Hollender, 6 Fed. 882, 19 Blatchf. 48; Adams v. Joliet Mfg. Co., 1 Fed. Cas. No. 56, 3 Ban. & A. 1, 12 Off. Gaz. 93; Conover v. Dohrman, 6 Fed. Cas. No. 3,120, 6 Blatchf. 60, 3 Fish. Pat. Cas. 382; Decker v. Grote, 7 Fed. Cas. No. 3,726, 10 Blatchf. 331, 6 Fish. Pat. Cas. 143, 3 Off. Gaz. 65; Gale Mfg. Co. v. Prutzman, 9 Fed. Cas. No. 5,191a, 5 Ban. & A. 154, 17 Off. Gaz. 743; Hamilton v. Ives, 11 Fed. Cas. No. 5,982, 6 Fish. Pat. Cas. 244, 3 Off. Gaz. 30 [affirmed in 92 U. S. 426, 23 L. ed. 494]; King v. Maudelbaum, 14 Fed. Cas. No. 7,799, 8 Blatchf. 468, 4 Fish. Pat. Cas. 577; Knox v. Great Western Quicksilver Min. Co., 14 Fed. Cas. No. 7,907, 4 Ban. & A. 25, 7 Reporter 325, 6 Sawy. 430, 14 Off. Gaz. 897; Smith v. Higgins, 22 Fed. Cas. No. 13,058; Winans v. Danforth, 30 Fed. Cas. No. 17,859.

Mere reversal of position or operation does not avoid infringement. *Heap v. Greene*, 91 Fed. 792, 34 C. C. A. 86 [reversing 75 Fed. 405]; *Huntington Dry-Pulverizer Co. v. Whitaker Cement Co.*, 89 Fed. 323; *Soci  t   Anonyme Usine J. Cl  ret v. Rehfu  s*, 75 Fed. 657; *Western Electric Co. v. Sperry Electric Co.*, 58 Fed. 186, 7 C. C. A. 164, 59 Fed. 295, 8 C. C. A. 129; *Brown Mfg. Co. v. Mast*, 53 Fed. 578; *Masseth v. Palm*, 51 Fed. 824; *Blanchard's Gun-Stock Turning Factory v. Warner*, 3 Fed. Cas. No. 1,521, 1 Blatchf. 258, Fish. Pat. Rep. 184; *Buerk v. Imhaeuser*, 4 Fed. Cas. No. 2,106, 1 Ban. & A. 337, 5 Off. Gaz. 752 [affirmed in 101 U. S. 647, 25 L. ed. 945]; *Potter v. Schenck*, 19 Fed. Cas. No. 11,337, 1 Biss. 515, 3 Fish. Pat. Cas. 82; *Potter v. Whitney*, 19 Fed. Cas. No. 11,341, 3 Fish. Pat. Cas. 77, 1 Lowell 87; *Union Metallic Cartridge Co. v. U. S. Cartridge Co.*, 24 Fed. Cas. No. 14,369, 2 Ban. & A. 593, 11 Off. Gaz. 1113; *Wells v. Jacques*, 29 Fed. Cas. No. 17,398, 1 Ban. & A. 60, 5 Off. Gaz. 364.

Infringement of a process patent is not avoided by reversing one of the mechanical steps of the process, where the purpose and result of the step is the same. *Burdon Wire, etc., Co. v. Williams*, 128 Fed. 927.

46. *McCormick v. Talcott*, 20 How. (U. S.) 402, 15 L. ed. 930; *Campbell Printing-Press, etc., Co. v. Duplex Printing-Press Co.*, 101 Fed. 282, 41 C. C. A. 351; *Overweight Counterbalance Elevator Co. v. Improved Order Red Men's Hall Assoc.*, 94 Fed. 155, 36 C. C. A. 125; *Edison Electric Light Co. v. Electric Engineering, etc., Co.*, 83 Fed. 473,

27 C. C. A. 562; *Brown v. Stilwell, etc., Mfg. Co.*, 57 Fed. 731, 741, 6 C. C. A. 528 [reversing 49 Fed. 738]; *Reece Buttonhole Mach. Co. v. Globe Buttonhole Mach. Co.*, 54 Fed. 884 [reversed on other grounds in 61 Fed. 958, 10 C. C. A. 194]; *Bruff v. Waterbury Buckle Co.*, 29 Fed. 214; *Otis Bros. Mfg. Co. v. Crane Bros. Mfg. Co.*, 27 Fed. 550 [affirmed in 136 U. S. 646, 10 S. Ct. 1072, 34 L. ed. 553]; *National Car-Brake Shoe Co. v. Boston, etc., R. Co.*, 15 Fed. 462; *Pattee v. Moline Plow Co.*, 9 Fed. 821, 10 Biss. 377; *Gorham v. Mixer*, 10 Fed. Cas. No. 5,626, *Brunn. Col. Cas. 327*; *Habeman v. Whitman*, 11 Fed. Cas. No. 5,885a, 5 Ban. & A. 530.

Similarity of result is not sufficient. *McCormick v. Talcott*, 20 How. (U. S.) 402, 15 L. ed. 930; *Westinghouse Air Brake Co. v. New York Air Brake Co.*, 119 Fed. 874, 56 C. C. A. 404; *Ide v. Trorlicht, etc., Carpet Co.*, 115 Fed. 137, 53 C. C. A. 341; *Kinloch Tel. Co. v. Western Electric Co.*, 113 Fed. 659, 51 C. C. A. 369; *Adams Electric Co. v. Lindell R. Co.*, 77 Fed. 432, 23 C. C. A. 223; *Robbins v. Aurora Match Co.*, 43 Fed. 434; *Taylor v. Garretson*, 23 Fed. Cas. No. 13,792, 9 Blatchf. 156, 5 Fish. Pat. Cas. 116.

47. *Chaffee v. Boston Belting Co.*, 22 How. (U. S.) 217, 16 L. ed. 240; *Wilson v. Simpson*, 9 How. (U. S.) 109, 13 L. ed. 66; *Shickle, etc., Iron Co. v. St. Louis Car-Coupler Co.*, 77 Fed. 739, 23 C. C. A. 433; *Day v. Union India-Rubber Co.*, 7 Fed. Cas. No. 3,691, 3 Blatchf. 488 [affirmed in 20 How. 216, 15 L. ed. 883]; *May v. Chaffee*, 16 Fed. Cas. No. 9,332, 2 Dill. 385, 5 Fish. Pat. Cas. 160; *Spaulding v. Page*, 22 Fed. Cas. No. 13,219, 4 Fish. Pat. Cas. 641, 1 Sawy. 702.

48. *Chaffee v. Boston Belting Co.*, 22 How. (U. S.) 217, 16 L. ed. 240; *Wilson v. Simpson*, 9 How. (U. S.) 109, 13 L. ed. 66; *O'Rourke Engineering Constr. Co. v. McMullen*, 150 Fed. 338; *Morrin v. Robert White Engineering Works*, 138 Fed. 68 [modified and affirmed in 143 Fed. 519, 74 C. C. A. 466]; *Goodyear Shoe Mach. Co. v. Jackson*, 112 Fed. 146, 50 C. C. A. 159, 55 L. R. A. 692; *Alaska Packers' Assoc. v. Pacific Steam Whaling Co.*, 93 Fed. 672; *Shickle, etc., Iron Co. v. St. Louis Car-Coupler Co.*, 77 Fed. 739, 23 C. C. A. 433; *Young v. Foerster*, 37 Fed. 203 [affirmed in 159 U. S. 272, 15 S. Ct. 1044, 40 L. ed. 138]; *Aiken v. Manchester Print Works*, 1 Fed. Cas. No. 113, 2 Cliff. 435; *Farrington v. Detroit Water Com'rs*, 8 Fed. Cas. No. 4,687, 4 Fish. Pat. Cas. 216; *Steam Cutter Co. v. Sheldon*, 22 Fed. Cas. No. 13,331, 10 Blatchf. 1, 5 Fish. Pat. Cas. 477.

Patented process cannot be used in repairing. *Goodyear Dental Vulcanite Co. v. Preterre*, 10 Fed. Cas. No. 5,596, 3 Ban. & A. 471, 15 Blatchf. 274, 14 Off. Gaz. 346.



reconstruct or rebuild a worn-out machine.<sup>49</sup> No general rule can be laid down by which to determine the line of demarkation between legitimate repairs which a purchaser of a patented machine may rightfully make thereon, and a reconstruction or reproduction which will constitute infringement. Each case must in that regard be decided on its own facts, having reference to the scope and purpose of the invention and the fair and reasonable intention of the parties.<sup>50</sup>

1. **Superiority or Inferiority as a Test of Infringement.** Although superiority may indicate such difference as to avoid infringement,<sup>51</sup> the fact that the infringing article is superior to that made by the patentee will not avoid infringement so long as the essential features of the patented article are used,<sup>52</sup> nor will the fact

Parts for sale to others cannot be manufactured see *St. Louis Car-Coupling Co. v. Shickle, etc.*, *Iron Co.*, 70 Fed. 783 [*reversed* on other grounds in 77 Fed. 739].

Parts of different construction may be substituted to improve the device. *Thomson-Houston Electric Co. v. Kelsey Electric R. Specialty Co.*, 75 Fed. 1005, 22 C. C. A. 1 [*modifying* 72 Fed. 1016].

49. *Morrin v. Robert White Engineering Works*, 138 Fed. 68 [*modified and affirmed* in 143 Fed. 519, 74 C. C. A. 466]; *Pacific Steam Whaling Co. v. Alaska Packers' Assoc.*, 100 Fed. 462, 40 C. C. A. 494 [*affirming* 93 Fed. 672]; *Shickle, etc., Iron Co. v. St. Louis Car-Coupler Co.*, 77 Fed. 739, 23 C. C. A. 433; *Davis Electric Works v. Edison Electric Light Co.*, 60 Fed. 276, 8 C. C. A. 615 [*affirming* 58 Fed. 878]; *Bicknell v. Todd*, 3 Fed. Cas. No. 1,389, 5 McLean 236, *Fish. Pat. Rep.* 452; *Gottfried v. Phillip Best Brewing Co.*, 10 Fed. Cas. No. 5,633, 5 Ban. & A. 4, 17 Off. Gaz. 675; *Union Metallic Cartridge Co. v. U. S. Cartridge Co.*, 24 Fed. Cas. No. 14,369, 2 Ban. & A. 593, 11 Off. Gaz. 1113; *Wortendyke v. White*, 30 Fed. Cas. No. 18,050, 2 Ban. & A. 25; *Dunlop Pneumatic Tyre Co. v. Neal*, [1899] 1 Ch. 807, 68 L. J. Ch. 378, 80 L. T. Rep. N. S. 746, 47 Wkly. Rep. 632.

Changing and reconstructing patented machines and selling them under a different name is infringement. *National Phonograph Co. v. Fletcher*, 117 Fed. 149.

50. *Goodyear Shoe Mach. Co. v. Jackson*, 112 Fed. 146, 50 C. C. A. 159, 55 L. R. A. 692.

51. *Carter v. Baker*, 5 Fed. Cas. No. 2,472, 4 Fish. Pat. Cas. 404, 1 Sawy. 512; *Johnson v. Root*, 13 Fed. Cas. No. 7,411, 1 Fish. Pat. Cas. 351; *Singer v. Walmsley*, 22 Fed. Cas. No. 12,900, 1 Fish. Pat. Cas. 558; *Smith v. Woodruff*, 22 Fed. Cas. No. 13,128a, 6 Fish. Pat. Cas. 476.

52. *Hoyt v. Horne*, 145 U. S. 302, 12 S. Ct. 922, 36 L. ed. 713; *Morley Sewing Mach. Co. v. Lancaster*, 129 U. S. 263, 9 S. Ct. 299, 32 L. ed. 715; *Elizabeth v. American Nicholson Pavement Co.*, 97 U. S. 126, 24 L. ed. 1000; *Robertson v. Blake*, 94 U. S. 728, 24 L. ed. 245; *O'Reilly v. Morss*, 15 How. (U. S.) 62, 14 L. ed. 601; *Evans v. Eaton*, 7 Wheat. (U. S.) 356, 5 L. ed. 472; *Diamond Match Co. v. Ruby Match Co.*, 127 Fed. 341; *Electric Smelting, etc., Co. v. Pittsburg Reduction Co.*, 125 Fed. 926, 60 C. C. A. 636; *Brislin v. Carnegie Steel Co.*, 118 Fed. 579 [*reversed* on other grounds in 124

Fed. 213, 59 C. C. A. 651]; *Adams Co. v. Schreiber, etc., Mfg. Co.*, 111 Fed. 182 [*reversed* on other grounds in 117 Fed. 830, 54 C. C. A. 128]; *Crown Cork, etc., Co. v. Aluminum Stopper Co.*, 108 Fed. 845, 48 C. C. A. 72; *Bonnette Arc Lawn Sprinkler Co. v. Koehler*, 82 Fed. 428, 27 C. C. A. 200; *Whitely v. Fadner*, 73 Fed. 486; *Goshen Sweeper Co. v. Bissell Carpet-Sweeper Co.*, 72 Fed. 67, 19 C. C. A. 13; *Robbins v. Dueber Watch-Case Mfg. Co.*, 71 Fed. 186; *Traver v. Brown*, 62 Fed. 933; *Simmons v. Standard Oil Co.*, 62 Fed. 928; *Woodward v. Boston Lasting Mach. Co.*, 60 Fed. 283, 8 C. C. A. 622; *Morrow v. Shoemaker*, 59 Fed. 120 [*reversed* on other grounds in 61 Fed. 945, 10 C. C. A. 181]; *Gilbert v. Reinhardt Numbering Mach. Co.*, 58 Fed. 975; *Stonemetz Printers' Mach. Co. v. Brown Folding-Mach. Co.*, 57 Fed. 601 [*affirmed* in 58 Fed. 571, 7 C. C. A. 374]; *Pittsburg Reduction Co. v. Cowles Electric Smelting, etc., Co.*, 55 Fed. 301; *White v. Walbridge*, 46 Fed. 526; *National Typographic Co. v. New York Typographic Co.*, 46 Fed. 114; *Shaver v. Skinner Mfg. Co.*, 30 Fed. 68; *Royer v. Coupe*, 29 Fed. 358; *Filley v. Littlefield*, 25 Fed. 282; *Celluloid Mfg. Co. v. Chrolithion Collar, etc., Co.*, 23 Fed. 397, 23 Blatchf. 205; *Bostock v. Goodrich*, 21 Fed. 316; *Roe-mer v. Simon*, 20 Fed. 197; *Evory v. Burt*, 15 Fed. 112 [*reversed* on other grounds in 133 U. S. 349, 10 S. Ct. 394, 33 L. ed. 647]; *Foye v. Nichols*, 13 Fed. 125, 8 Sawy. 201; *Frost v. Marcus*, 13 Fed. 88; *American Bell Tel. Co. v. Spencer*, 8 Fed. 509; *Pennington v. King*, 7 Fed. 462; *Adams v. Joliet Mfg. Co.*, 1 Fed. Cas. No. 56, 3 Ban. & A. 1, 12 Off. Gaz. 93; *Alden v. Dewey*, 1 Fed. Cas. No. 153, 2 Robb Pat. Cas. 17, 1 Story 336; *American Whip Co. v. Lombard*, 1 Fed. Cas. No. 319, 3 Ban. & A. 598, 4 Cliff. 495, 14 Off. Gaz. 900; *Blake v. Eagle Works Mfg. Co.*, 3 Fed. Cas. No. 1,494, 3 Biss. 77, 4 Fish. Pat. Cas. 591; *Blake v. Robertson*, 3 Fed. Cas. No. 1,500, 11 Blatchf. 237, 6 Fish. Pat. Cas. 509; *Carstaedt v. U. S. Corset Co.*, 5 Fed. Cas. No. 2,468, 2 Ban. & A. 119, 13 Blatchf. 119, 9 Off. Gaz. 151; *Chicago Fruit-House Co. v. Busch*, 5 Fed. Cas. No. 2,669, 2 Biss. 472, 4 Fish. Pat. Cas. 395; *Coleman v. Liesor*, 6 Fed. Cas. No. 2,984; *Colt v. Massachusetts Arms Co.*, 6 Fed. Cas. No. 3,030, 1 Fish. Pat. Cas. 108; *Conover v. Rapp*, 6 Fed. Cas. No. 3,124, 4 Fish. Pat. Cas. 57; *Converse v. Cannon*, 6 Fed. Cas. No. 3,144, 2 Woods 7, 9 Off. Gaz. 105; *Cook*



that it is inferior.<sup>53</sup> Infringement is not avoided by intentionally making the device imperfect or defective.<sup>54</sup>

**m. Patented Improvement.** A device is none the less an infringement because it is covered by an improvement patent granted to the infringer.<sup>55</sup> Change in

*v. Howard*, 6 Fed. Cas. No. 3,160, 4 Fish. Pat. Cas. 269; *Crehore v. Norton*, 6 Fed. Cas. No. 3,381; *Decker v. Griffith*, 7 Fed. Cas. No. 3,724, 10 Blatchf. 343 note; *De Florez v. Reynolds*, 7 Fed. Cas. No. 3,742, 3 Ban. & A. 292, 14 Blatchf. 505; *Flint v. Roberts*, 9 Fed. Cas. No. 4,875, 4 Ban. & A. 165; *Forbes v. Barstow Stove Co.*, 9 Fed. Cas. No. 4,923, 2 Cliff. 379; *Foss v. Herbert*, 9 Fed. Cas. No. 4,957, 1 Biss. 121, 2 Fish. Pat. Cas. 31; *Goodyear v. Mathews*, 10 Fed. Cas. No. 5,576, 1 Paine 300, 1 Robb Pat. Cas. 50; *Goodyear v. Mullee*, 10 Fed. Cas. No. 5,579, 3 Fish. Pat. Cas. 420; *Gray v. James*, 10 Fed. Cas. No. 5,718, Pet. C. C. 394, 1 Robb Pat. Cas. 120; *Hays v. Sulzor*, 11 Fed. Cas. No. 6,271, 1 Bond 279, 1 Fish. Pat. Cas. 532; *Howe v. Morton*, 12 Fed. Cas. No. 6,769, 1 Fish. Pat. Cas. 586; *Howes v. Nute*, 12 Fed. Cas. No. 6,790, 4 Cliff. 173, 4 Fish. Pat. Cas. 263; *Imlay v. Norwich, etc., R. Co.*, 13 Fed. Cas. No. 7,012, 4 Blatchf. 227, 1 Fish. Pat. Cas. 340; *Kendrick v. Emmons*, 14 Fed. Cas. No. 7,695, 2 Ban. & A. 208, 9 Off. Gaz. 201; *McComb v. Brodie*, 15 Fed. Cas. No. 8,708, 5 Fish. Pat. Cas. 384, 1 Woods 153, 2 Off. Gaz. 117; *Odiorne v. Denney*, 18 Fed. Cas. No. 10,431, 3 Ban. & A. 287, 13 Off. Gaz. 965, 1 N. J. L. J. 183; *Pitts v. Wemple*, 19 Fed. Cas. No. 11,194, 1 Biss. 87, 5 Fish. Pat. Cas. 10; *Reutgen v. Kanows*, 20 Fed. Cas. No. 11,710, 1 Robb Pat. Cas. 1, 1 Wash. 168; *Sayles v. Chicago, etc., R. Co.*, 21 Fed. Cas. No. 12,415, 3 Biss. 52, 4 Fish. Pat. Cas. 584; *Stainthorp v. Humiston*, 22 Fed. Cas. No. 13,281, 4 Fish. Pat. Cas. 107; *Star Salt Caster Co. v. Crossman*, 22 Fed. Cas. No. 13,321, 3 Ban. & A. 281, 4 Cliff. 568; *Turrell v. Spaeth*, 24 Fed. Cas. No. 14,269, 3 Ban. & A. 458, 14 Off. Gaz. 377; *Union Paper-Bag Mach. Co. v. Pultz, etc., Co.*, 24 Fed. Cas. No. 14,392, 3 Ban. & A. 403, 15 Blatchf. 160, 15 Off. Gaz. 423; *Westinghouse v. Gardner, etc., Air Brake Co.*, 29 Fed. Cas. No. 17,450, 2 Ban. & A. 55, 9 Off. Gaz. 538; *Whipple v. Baldwin Mfg. Co.*, 29 Fed. Cas. No. 17,514, 4 Fish. Pat. Cas. 29; *Whitney v. Mowry*, 29 Fed. Cas. No. 17,592, 2 Bond 45, 3 Fish. Pat. Cas. 157; *Whitemore v. Cutter*, 29 Fed. Cas. No. 17,601, 1 Gall. 478, 1 Robb Pat. Cas. 40; *Wilbur v. Beecher*, 29 Fed. Cas. No. 17,634, 2 Blatchf. 132, Fish. Pat. Rep. 401; *Winans v. New York, etc., R. Co.*, 30 Fed. Cas. No. 17,864, 4 Fish. Pat. Cas. 1; *Woodcock v. Parker*, 30 Fed. Cas. No. 17,971, 1 Gall. 438, 1 Robb Pat. Cas. 37; *Woodworth v. Rogers*, 30 Fed. Cas. No. 18,018, 3 Woodb. & M. 135, 2 Robb Pat. Cas. 625; *United Tel. Co. v. Harrison*, 21 Ch. D. 720, 51 L. J. Ch. 705, 46 L. T. Rep. N. S. 620, 30 Wkly. Rep. 724; *American Dunlop Tire Co. v. Anderson Tire Co.*, 5 Can. Exch. 194.

Relative superiority of devices is irrelevant. *Stevens v. Pierpont*, 42 Conn. 360; *Lourie*

*Implement Co. v. Lenhart*, 130 Fed. 122, 64 C. C. A. 456; *May v. Fond du Lac County*, 27 Fed. 691 [reversed on other grounds in 137 U. S. 395, 11 S. Ct. 98, 34 L. ed. 714]; *Cox v. Griggs*, 6 Fed. Cas. No. 3,302, 1 Biss. 362, 2 Fish. Pat. Cas. 174; *Roberts v. Harnden*, 20 Fed. Cas. No. 11,903, 2 Cliff. 500; *Tilghman v. Werk*, 23 Fed. Cas. No. 14,046, 1 Bond 511, 2 Fish. Pat. Cas. 229.

53. *Cimiotti Unhairing Co. v. Bowsky*, 95 Fed. 474; *Hubbard v. King Ax Co.*, 89 Fed. 713; *Union R. Co. v. Sprague Electric R., etc., Co.*, 88 Fed. 82, 31 C. C. A. 391; *National Folding-Box, etc., Co. v. Elsas*, 86 Fed. 917, 30 C. C. A. 487; *Heap v. Greene*, 75 Fed. 405 [reversed on other grounds in 91 Fed. 792, 34 C. C. A. 861]; *Robinson v. Sutter*, 8 Fed. 828, 10 Biss. 100; *Forbes v. Barstow Stove Co.*, 9 Fed. Cas. No. 4,923, 2 Cliff. 379; *Union Paper-Bag Mach. Co. v. Binney*, 24 Fed. Cas. No. 14,387, 5 Fish. Pat. Cas. 166.

54. *Crown Cork, etc., Co. v. Standard Stopper Co.*, 136 Fed. 199; *A. R. Milner Seating Co. v. Yesbera*, 133 Fed. 916, 67 C. C. A. 210; *White v. Peerless Rubber Mfg. Co.*, 111 Fed. 190; *King Ax Co. v. Hubbard*, 97 Fed. 795, 38 C. C. A. 423; *Penfield v. Chambers*, 92 Fed. 630, 34 C. C. A. 579; *Whiteley v. Fadner*, 73 Fed. 486; *Tripp Giant Leveller Co. v. Bresnahan*, 70 Fed. 982 [affirmed in 72 Fed. 920, 19 C. C. A. 237]; *Sawyer Spindle Co. v. W. G. & A. R. Morrison Co.*, 52 Fed. 590; *Chicago Fruit-House Co. v. Busch*, 5 Fed. Cas. No. 2,669, 2 Biss. 472, 4 Fish. Pat. Cas. 395.

55. *Cantrell v. Wallick*, 117 U. S. 689, 6 S. Ct. 970, 29 L. ed. 1017; *Tilghman v. Proctor*, 102 U. S. 707, 26 L. ed. 279; *Blanchard v. Putnam*, 8 Wall. (U. S.) 420, 19 L. ed. 433; *Ries v. Barth Mfg. Co.*, 136 Fed. 850, 69 C. C. A. 528; *Bradford Belting Co. v. Kisinger-Ison Co.*, 113 Fed. 811, 51 C. C. A. 483; *Smith v. Uhrich*, 94 Fed. 865; *Bowers v. Von Schmidt*, 63 Fed. 572; *Putnam v. Keystone Bottle Stopper Co.*, 38 Fed. 234; *Tate v. Thomas*, 27 Fed. 306; *Wilson v. Cubley*, 26 Fed. 156; *Zeun v. Kaldenberg*, 16 Fed. 539; *Star Salt Caster Co. v. Alden*, 10 Fed. 555; *White v. Heath*, 10 Fed. 291; *Carter v. Baker*, 5 Fed. Cas. No. 2,472, 4 Fish. Pat. Cas. 404, 1 Sawy. 513; *Cleveland v. Towle*, 5 Fed. Cas. No. 2,888, 3 Fish. Pat. Cas. 525; *Jones v. Merrill*, 13 Fed. Cas. No. 7,481, 8 Off. Gaz. 401; *Morse Fountain-Pen Co. v. Esterbrook Steel-Pen Mfg. Co.*, 17 Fed. Cas. No. 9,862, 3 Fish. Pat. Cas. 515; *Storrs v. Howe*, 23 Fed. Cas. No. 13,495, 2 Ban. & A. 420, 4 Cliff. 388, 10 Off. Gaz. 421; *Wilson v. Barnum*, 30 Fed. Cas. No. 17,787, 2 Fish. Pat. Cas. 635, 2 Robb Pat. Cas. 749, 1 Wall Jr. 347.

Use of patented machine to perform a process previously patented by another is infringement. *Expanded Metal Co. v. Bradford*, 136 Fed. 876 [reversed on other grounds



the details of construction of a patented article may be patentable as improvements, but is no protection against the infringement of the original patent.<sup>56</sup> The original patentee cannot use the patented improvement.<sup>57</sup>

**7. DESIGNS.** An article infringes a design patent when it so nearly resembles the patented design in appearance as to lead ordinary purchasers to mistake one for the other. The test is the sameness of appearance to the ordinary observer giving ordinary attention to the matter.<sup>58</sup> Difference in structure or appearance which will enable experts to distinguish them will not prevent infringement.<sup>59</sup> But confusion which is due to lack of attention by purchasers or other causes than similarity of the patented form will not show infringement.<sup>60</sup> And it is

in 146 Fed. 984, 77 C. C. A. 230]; *Collette v. Lasnier*, 13 Can. Sup. Ct. 563; *Merrill v. Cousins*, 26 U. C. Q. B. 49.

Where the alleged infringer has a subsequently granted patent upon his device, the presumption is against infringement. *New Jersey Wire Cloth Co. v. Buffalo Expanded Metal Co.*, 131 Fed. 265 [affirmed in 135 Fed. 1021, 68 C. C. A. 672]; *Anderson v. Collins*, 122 Fed. 451, 58 C. C. A. 669; *Powell v. Leicester Mills Co.*, 103 Fed. 476 [reversed on other grounds in 108 Fed. 386, 47 C. C. A. 416]; *Norton v. Jensen*, 90 Fed. 415, 33 C. C. A. 141; *Griffith v. Shaw*, 89 Fed. 313; *St. Louis Car-Coupler Co. v. National Malleable Castings Co.*, 87 Fed. 885, 31 C. C. A. 265; *Kohler v. George Worthington Co.*, 77 Fed. 844; *Ransome v. Hyatt*, 69 Fed. 148, 16 C. C. A. 185; *National Harrow Co. v. Hanby*, 54 Fed. 493; *Brown v. Selby*, 4 Fed. Cas. No. 2,030, 2 Biss. 457, 4 Fish. Pat. Cas. 363; *Buerk v. Imhaeuser*, 4 Fed. Cas. No. 2,108, 2 Ban. & A. 465, 11 Off. Gaz. 112. *Contra*, *Bowers v. Pacific Coast Dredging, etc., Co.*, 99 Fed. 745; *Hardwick v. Masland*, 71 Fed. 887; *Holliday v. Pickhardt*, 12 Fed. 147.

**56.** *Tate v. Thomas*, 27 Fed. 306; *Wilson v. Cubley*, 26 Fed. 156; *White v. Heath*, 10 Fed. 291; *Carter v. Baker*, 5 Fed. Cas. No. 2,472, 4 Fish. Pat. Cas. 404, 1 Sawy. 512.

**57.** *Cantrell v. Wallick*, 117 U. S. 689, 6 S. Ct. 970, 29 L. ed. 1017; *Royer v. Coupe*, 29 Fed. 358; *Crehore v. Norton*, 6 Fed. Cas. No. 3,381; *Flint v. Roberts*, 9 Fed. Cas. No. 4,475, 4 Ban. & A. 165; *Gray v. James*, 10 Fed. Cas. No. 5,718, Pet. C. C. 394, 1 Robb Pat. Cas. 120; *Star Salt Caster Co. v. Crossman*, 22 Fed. Cas. No. 13,321, 3 Ban. & A. 281, 4 Cliff. 568; *Whipple v. Baldwin Mfg. Co.*, 29 Fed. Cas. No. 17,514, 4 Fish. Pat. Cas. 29.

**58.** *Smith v. Whitman Saddle Co.*, 148 U. S. 674, 13 S. Ct. 768, 37 L. ed. 606; *Gorham Mfg. Co. v. White*, 14 Wall. (U. S.) 511, 20 L. ed. 731; *Williams Calk Co. v. Neverslip Mfg. Co.*, 136 Fed. 210 [affirmed in 145 Fed. 928, 76 C. C. A. 466]; *Bevin Bros. Mfg. Co. v. Starr Bros. Bell Co.*, 114 Fed. 362; *Pelouze Scale, etc., Co. v. American Cutlery Co.*, 102 Fed. 916, 43 C. C. A. 52; *Myers v. Sternheim*, 97 Fed. 625, 38 C. C. A. 345; *Byram v. Friedberger*, 87 Fed. 559; *Whittall v. Lowell Mfg. Co.*, 79 Fed. 787; *Henderson v. Tompkins*, 60 Fed. 758; *Macbeth v. Gillinder*, 54 Fed. 171; *Ripley v. Elson Glass Co.*, 49 Fed. 927; *Dreyfus v.*

*Schneider*, 25 Fed. 481; *Dryfoos v. Friedman*, 18 Fed. 824, 21 Blatchf. 563; *Jennings v. Kibbe*, 10 Fed. 669, 20 Blatchf. 353; *Wood v. Dolby*, 7 Fed. 475, 19 Blatchf. 214; *McCrea v. Holdsworth*, L. R. 6 Ch. 418, 23 L. T. Rep. N. S. 444, 19 Wkly. Rep. 36.

**Use of different names or trade-marks.**—Where two designs are substantially similar the fact that different names or trade-marks are or may be used in connection with them will not sufficiently distinguish them. *Perry v. Starrett*, 19 Fed. Cas. No. 11,012, 3 Ban. & A. 485, 14 Off. Gaz. 599.

What was old at the date of the patent will not infringe. *Byram v. Friedberger*, 87 Fed. 559.

**Cases holding design infringed** see *Matthews, etc., Mfg. Co. v. American Lamp, etc., Co.*, 103 Fed. 634; *American Electrical Novelty, etc., Co. v. Acme Electric Lamp Co.*, 98 Fed. 895; *Whittall v. Lowell Mfg. Co.*, 79 Fed. 787; *Braddock Glass Co. v. Macbeth*, 64 Fed. 118, 12 C. C. A. 70; *Stewart v. Smith*, 58 Fed. 580, 7 C. C. A. 380 [affirming 55 Fed. 481]; *Macbeth v. Gillinder*, 54 Fed. 171; *Ripley v. Elson Glass Co.*, 49 Fed. 927; *Perry v. Starrett*, 19 Fed. Cas. No. 11,012, 3 Ban. & A. 485, 14 Off. Gaz. 599.

**Cases holding design not infringed** see *Buerkle v. Standard Heater Co.*, 105 Fed. 779; *Pelouze Scale, etc., Co. v. American Cutlery Co.*, 102 Fed. 916, 43 C. C. A. 52; *Byram v. Friedberger*, 100 Fed. 963, 41 C. C. A. 121 [affirming 87 Fed. 559]; *Magie Light Co. v. Economy Gas-Lamp Co.*, 97 Fed. 87, 38 C. C. A. 56; *Mesinger Bicycle Saddle Co. v. Humber*, 94 Fed. 672, 674; *Soehner v. Favorite Stove, etc., Co.*, 84 Fed. 182, 28 C. C. A. 317; *Frank v. Hess*, 84 Fed. 170; *Michigan Stove Co. v. Fuller-Warren Co.*, 81 Fed. 376; *Sutro Bros. Braid Co. v. Schloss*, 44 Fed. 356; *Dukes v. Bauerle*, 41 Fed. 784; *Crocker v. Cutter Tower Co.*, 29 Fed. 456 [affirmed in 140 U. S. 678, 11 S. Ct. 1019, 35 L. ed. 600]; *Jennings v. Kibbe*, 24 Fed. 697.

**59.** *Gorham Mfg. Co. v. White*, 14 Wall. (U. S.) 511, 20 L. ed. 731 [reversing 10 Fed. Cas. No. 5,627, 7 Blatchf. 513, 2 Whitm. Pat. Cas. 392]; *Hutter v. Broome*, 114 Fed. 655; *Redway v. Ohio Stove Co.*, 38 Fed. 582; *Tomkinson v. Willets Mfg. Co.*, 23 Fed. 895; *Miller v. Smith*, 5 Fed. 359; *Perry v. Starrett*, 19 Fed. Cas. No. 11,012, 3 Ban. & A. 485, 14 Off. Gaz. 599.

**60.** *Krutchschnitt v. Simmons*, 122 Fed. 1020, 58 C. C. A. 111 [affirming 118 Fed.



of course obvious that an invalid design patent will not support a claim of infringement.<sup>61</sup>

**8. INFRINGEMENT AFTER EXPIRATION OF PATENT.** Articles illegally made during the life of a patent cannot be lawfully sold after the patent has expired.<sup>62</sup> The illegality attaches to the things themselves. The person making them has no right to make them, no right to them when made.<sup>63</sup> But the part manufacture of articles not constituting an infringement, with intent to complete into the patented article immediately on the expiration of the patent, is not infringement, as the monopoly only exists during the life of the patent.<sup>64</sup>

**B. Contributory Infringement — 1. IN GENERAL.** Contributory infringement is the intentional aiding of one person by another in the unlawful making or selling or using of the patented invention,<sup>65</sup> and this is usually done by making or selling a part of the patented invention with the intent and purpose of so aiding.<sup>66</sup> The essence of contributory infringement lies in concerting with others in an unlawful invasion of the patentee's rights.<sup>67</sup> The burden of proof is on complainant to show an intention on the part of defendants to aid others in such infringement.<sup>68</sup>

**2. SELLING PARTS OF PATENTED INVENTION.** Selling parts adapted and intended for use in making the patented invention in violation of the patent is contributory infringement.<sup>69</sup> The mere fact that they might be so used, however, will not

851]; *Monroe v. Anderson*, 58 Fed. 398, 7 C. C. A. 272.

**61.** *Union Welting Co. v. McCarter*, 108 Fed. 398, 47 C. C. A. 428; *Feder v. Stewart*, etc., Co., 105 Fed. 628; *Kampfe v. Reichard*, 105 Fed. 622; *Rowe v. Blodgett*, etc., Co., 103 Fed. 873 [*affirmed* in 112 Fed. 161, 46 C. C. A. 214]; *Matthews*, etc., Mfg. Co. v. American Lamp, etc., Co., 103 Fed. 634; *Koenen v. Drake*, 101 Fed. 466, 41 C. C. A. 466; *Cary Mfg. Co. v. Neal*, 98 Fed. 617, 39 C. C. A. 189; *Westinghouse Electric*, etc., Co. v. *Triumph Electric Co.*, 97 Fed. 99, 38 C. C. A. 65; *Sagendorph v. Hughes*, 95 Fed. 478.

**62.** *Underwood Typewriter Co. v. Elliott-Fisher Co.*, 156 Fed. 588; *American Diamond Rock-Boring Co. v. Rutland Marble Co.*, 2 Fed. 355, 18 Blatchf. 147; *American Diamond Rock-Boring Co. v. Sheldon*, 1 Fed. 870, 18 Blatchf. 50; *Crossley v. Beverly*, 9 B. & C. 63, 17 E. C. L. 38, 3 C. & P. 513, 14 E. C. L. 690, 7 L. J. K. B. O. S. 127, M. & M. 283, 22 E. C. L. 522, 1 Russ. & M. 166 note, 5 Eng. Ch. 166 note, 39 Eng. Reprint 65 [*affirmed* in 4 L. J. Ch. 25]; *Richards v. Williamson*, 30 L. T. Rep. N. S. 746, 22 Wkly. Rep. 765.

**63.** *American Diamond Rock-Boring Co. v. Sheldon*, 1 Fed. 870, 18 Blatchf. 50.

**64.** *White v. Walbridge*, 46 Fed. 526.

**65.** *Howson Contrib. Infr. Pat. 1*; *Goodyear Shoe Mach. Co. v. Jackson*, 112 Fed. 146, 50 C. C. A. 159, 55 L. R. A. 692; *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288, 25 C. C. A. 267, 35 L. R. A. 728; *Thomson-Houston Electric Co. v. Kelsey Electric R. Specialty Co.*, 75 Fed. 1005, 22 C. C. A. 1; *Hatch v. Hall*, 30 Fed. 613; *American Cotton-Tie Supply Co. v. McCready*, 1 Fed. Cas. No. 295, 4 Ban. & A. 588, 17 Blatchf. 291, 17 Off. Gaz. 565.

**Intent to aid is necessary.** *Snyder v. Bunnell*, 29 Fed. 47; *Saxe v. Hammond*, 21 Fed.

Cas. No. 12,411, 1 Ban. & A. 629, Holmes 456, 7 Off. Gaz. 781.

**66.** *Goodyear Shoe Mach. Co. v. Jackson*, 112 Fed. 146, 50 C. C. A. 159, 55 L. R. A. 692.

**67.** *Goodyear Shoe Mach. Co. v. Jackson*, 112 Fed. 146, 50 C. C. A. 159, 55 L. R. A. 692.

**68.** *Thomson-Houston Electric Co. v. Kelsey Electric R. Specialty Co.*, 72 Fed. 1016; *Snyder v. Bunnell*, 29 Fed. 47; *Coolidge v. McCone*, 6 Fed. Cas. No. 3,186, 1 Ban. & A. 78, 2 Sawy. 571, 5 Off. Gaz. 458; *Saxe v. Hammond*, 21 Fed. Cas. No. 12,411, 1 Ban. & A. 629, Holmes 456.

**69.** *Leeds*, etc., Co. v. *Victor Talking Mach. Co.*, 154 Fed. 58, 83 C. C. A. 170; *Victor Talking Mach. Co. v. Leeds*, etc., Co., 150 Fed. 147; *A. B. Dick Co. v. Henry*, 149 Fed. 424; *Cutler-Hammer Mfg. Co. v. Union Electric Mfg. Co.*, 147 Fed. 266; *Canda v. Michigan Malleable Iron Co.*, 124 Fed. 486, 61 C. C. A. 194; *American Graphophone Co. v. Leeds*, 87 Fed. 873; *Thomson-Houston Electric Co. v. Ohio Brass Co.*, 80 Fed. 712, 26 C. C. A. 107 [*affirming* 78 Fed. 139]; *American Graphophone Co. v. Amet*, 74 Fed. 789; *St. Louis Car-Coupler Co. v. Shickle*, etc., Iron Co., 70 Fed. 783 [*affirmed* in 77 Fed. 739, 23 C. C. A. 433]; *Stearns v. Phillips*, 43 Fed. 792; *Travers v. Beyer*, 26 Fed. 450, 23 Blatchf. 423; *Schneider v. Pountney*, 21 Fed. 399; *Holly v. Vergennes Mach. Co.*, 4 Fed. 74, 18 Blatchf. 327; *Richardson v. Noyes*, 20 Fed. Cas. No. 11,792, 2 Ban. & A. 398, 10 Off. Gaz. 507; *Wallace v. Holmes*, 29 Fed. Cas. No. 17,100, 9 Blatchf. 65, 5 Fish. Pat. Cas. 37, 1 Off. Gaz. 117. *Contra*, *Byam v. Farr*, 4 Fed. Cas. No. 2,264, 1 Curt. 260. And see *Larochella v. Gauthier*, 14 Quebec Super. Ct. 87.

**Selling the ingredients of a composition with the expectation and intent that they be used in making it is infringement.** *Rum-*



make the seller an infringer if they are capable of other use,<sup>70</sup> and the seller did not intend that they should be used for purposes of infringement.<sup>71</sup> It is not contributory infringement to make and sell parts to licensees under the patent for legitimate purposes of repair,<sup>72</sup> or to make and ship parts abroad,<sup>73</sup> and there is no infringement if the parts are never put into actual use in the patented combination.<sup>74</sup> So the doctrine of contributory infringement has no application where the thing alleged to be contributed is one of general use, suitable to a great variety of other methods of use,<sup>75</sup> and especially where there is no agreement or definite purpose that the thing sold shall be employed with other things so as to infringe a patent right.<sup>76</sup>

### 3. SELLING ARTICLE USED WITH PATENTED INVENTION. The sale of an article

ford Chemical Works *v.* New York Baking Powder Co., 136 Fed. 873; Imperial Chemical Mfg. Co. *v.* Stein, 69 Fed. 616; Celluloid Mfg. Co. *v.* American Zylonite Co., 35 Fed. 417; Celluloid Mfg. Co. *v.* American Zylonite Co., 30 Fed. 437, 35 Fed. 417; Willis *v.* McCullen, 29 Fed. 641; Alabastine Co. *v.* Payne, 27 Fed. 559; Bowker *v.* Dows, 3 Fed. Cas. No. 1,734, 3 Ban. & A. 518, 15 Off. Gaz. 510; Rumford Chemical Works *v.* Hecker, 20 Fed. Cas. No. 12,133, 2 Ban. & A. 351, 10 Off. Gaz. 289.

One who sells a device, the natural use of which will make the purchaser an infringer, is guilty of contributory infringement. Davis *v.* Perry, 120 Fed. 941, 57 C. C. A. 231 [*reversing* 115 Fed. 333]; Loew Filter Co. *v.* German-American Filter Co., 107 Fed. 949, 47 C. C. A. 94 [*affirming*, 103 Fed. 303]; John R. Williams Co. *v.* Miller, etc., Mfg. Co., 107 Fed. 290; Westinghouse Electric, etc., Co. *v.* Dayton Fan, etc., Co., 106 Fed. 724; American Graphophone Co. *v.* Hawthorne, 92 Fed. 516; New York Filter Mfg. Co. *v.* Jackson, 91 Fed. 422; Boyd *v.* Cherry, 50 Fed. 279; Celluloid Mfg. Co. *v.* American Zylonite Co., 30 Fed. 437; Snyder *v.* Bunnell, 29 Fed. 47; Alabastine Co. *v.* Payne, 27 Fed. 559; American Diamond Rock Boring Co. *v.* Sullivan Mach. Co., 1 Fed. Cas. No. 298, 2 Ban. & A. 522, 14 Blatchf. 119; Bowker *v.* Dows, 3 Fed. Cas. No. 1,734, 3 Ban. & A. 518, 15 Off. Gaz. 510; Knight *v.* Gavit, 14 Fed. Cas. No. 7,884.

Merely omitting an element of the combination which must be supplied by the user will not avoid infringement. Heekin *v.* Baker, 127 Fed. 828 [*reversed* on other grounds in 138 Fed. 63, 70 C. C. A. 559]; Bishop, etc., Co. *v.* Levine, 119 Fed. 363; Red Jacket Mfg. Co. *v.* Davis, 82 Fed. 432, 27 C. C. A. 204.

Making and selling parts separately to be assembled by user is infringement. Lee *v.* Northwestern Stove Repair Co., 50 Fed. 202 [*reversed* on other grounds in 58 Fed. 182, 7 C. C. A. 160]; Strobidge *v.* Lindsay, 6 Fed. 510; Barnes *v.* Straus, 2 Fed. Cas. No. 1,022, 9 Blatchf. 553, 5 Fish. Pat. Cas. 531, 2 Off. Gaz. 62.

Manufacturing an improved element of a patented combination and substituting it in machines sold by the patentee is infringement. National Phonograph Co. *v.* Fletcher, 117 Fed. 149.

Perishable articles.—The rule has no appli-

cation to a perishable article which it is the object of the mechanism to deliver and which must be renewed periodically. Morgan Envelope Co. *v.* Albany Perforated Wrapping Paper Co., 152 U. S. 425, 14 S. Ct. 627, 33 L. ed. 500.

70. Standard Computing Scale Co. *v.* Computing Scale Co., 126 Fed. 639, 61 C. C. A. 541; Lane *v.* Park, 49 Fed. 454; Robbins *v.* Aurora Watch Co., 43 Fed. 521; Winne *v.* Bedell, 40 Fed. 463; Snyder *v.* Bunnell, 29 Fed. 47; Keystone Bridge Co. *v.* Phoenix Iron Co., 14 Fed. Cas. No. 7,751, 5 Fish. Pat. Cas. 468, 1 Off. Gaz. 471, 9 Phila. (Pa.) 374 [*affirmed* in 95 U. S. 274, 24 L. ed. 344].

71. Where wrongful use intended there is infringement. Cary Mfg. Co. *v.* Standard Metal Strap Co., 113 Fed. 429; Heaton-Peninsular Button-Fastener Co. *v.* Eureka Specialty Co., 77 Fed. 288, 25 C. C. A. 267, 35 L. R. A. 728; Boyd *v.* Cherry, 50 Fed. 279; Saxe *v.* Hammond, 21 Fed. Cas. No. 12,411, 1 Ban. & A. 629, Holmes 456, 7 Off. Gaz. 781; Wallace *v.* Holmes, 29 Fed. Cas. No. 17,100, 9 Blatchf. 65, 5 Fish. Pat. Cas. 37, 1 Off. Gaz. 117.

72. O'Rourke Engineering Constr. Co. *v.* McMullen, 150 Fed. 338; Shickle, etc., Iron Co. *v.* St. Louis Car-Coupler Co., 77 Fed. 739, 23 C. C. A. 433; Thomson-Houston Electric Co. *v.* Kelsey Electric R. Specialty Co., 75 Fed. 1005, 22 C. C. A. 1 [*modifying* 72 Fed. 1016]; Robbins *v.* Columbus Watch Co., 50 Fed. 545 [*affirmed* in 64 Fed. 384, 12 C. C. A. 174]. See also on this point Columbus Watch Co. *v.* Robbins, 52 Fed. 337, 3 C. C. A. 103.

73. Bullock Electric, etc., Co. *v.* Westinghouse Electric, etc., Co., 129 Fed. 105, 63 C. C. A. 607.

74. Campbell *v.* Kavanaugh, 11 Fed. 83, 20 Blatchf. 256.

75. Rumford Chemical Works *v.* Hygienic Chemical Co., 148 Fed. 862 [*affirmed* in 154 Fed. 65, 83 C. C. A. 177]; Cortelyou *v.* Johnson, 145 Fed. 933, 76 C. C. A. 455 [*affirmed* in 207 U. S. 196, 28 S. Ct. 105, and *reversing* 138 Fed. 1101]; Edison Electric Light Co. *v.* Peninsular Light, etc., Co., 95 Fed. 669 [*affirmed* in 101 Fed. 831, 43 C. C. A. 479]. And see Geis *v.* Kimber, 36 Fed. 105; Millner *v.* Schofield, 17 Fed. Cas. No. 9,609a, 4 Hughes 258.

76. Edison Electric Light Co. *v.* Peninsular Light, etc., Co., 95 Fed. 669 [*affirmed* in 101 Fed. 831, 43 C. C. A. 479].



not covered by the claims of a patent but capable of use with the patented invention is ordinarily not infringement.<sup>77</sup> A sale, however, with intent to induce a licensee under the patent to violate the terms of his license agreement is infringement.<sup>78</sup>

4. MISCELLANEOUS. Furnishing plans of an infringing device and sharing in the profits is infringement,<sup>79</sup> and so is the inducing of licensees to violate the conditions of a license.<sup>80</sup>

C. Suits — 1. IN GENERAL. Suit may be maintained at law or in equity to enforce the rights arising from granted patents,<sup>81</sup> or from contracts relating to them.<sup>82</sup>

2. JURISDICTION<sup>83</sup> — a. In General. The United States courts have exclusive jurisdiction of suits for infringement of patents whether at law or in equity without regard to the citizenship of the parties,<sup>84</sup> and this jurisdiction is vested in the

77. *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.*, 152 U. S. 425, 14 S. Ct. 627, 38 L. ed. 500; *Wagner Type-writer Co. v. F. S. Webster Co.*, 144 Fed. 405; *Gerard v. Diebold Safe, etc., Co.*, 54 Fed. 889, 4 C. C. A. 644 [affirming 48 Fed. 380]; *Bliss v. Merrill*, 33 Fed. 39.

Sale of article made by patented machine is no infringement. *Boyd v. Brown*, 3 Fed. Cas. No. 1,747, 3 McLean 295, 2 Robb Pat. Cas. 203.

78. *Bement v. National Harrow Co.*, 186 U. S. 70, 22 S. Ct. 747, 46 L. ed. 1053; *Rupp, etc., Co. v. Elliott*, 131 Fed. 730, 65 C. C. A. 544; *Brodrick Copygraph Co. v. Mayhew*, 131 Fed. 92 [affirmed in 137 Fed. 596, 70 C. C. A. 557]; *Tubular Rivet Co. v. O'Brien*, 93 Fed. 200; *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288, 25 C. C. A. 267, 35 L. R. A. 728.

79. *Trent v. Risdon Iron, etc., Works*, 102 Fed. 635, 42 C. C. A. 529 [modifying 92 Fed. 375]; *Toppan v. Tiffany Refrigerator Car Co.*, 39 Fed. 420.

80. *Cortelyou v. Johnson*, 138 Fed. 110 [reversed on other grounds in 145 Fed. 933, 76 C. C. A. 455, and that decision affirmed on other grounds in 207 U. S. 196, 28 S. Ct. 105].

81. U. S. Rev. St. (1878) §§. 629, 4919 [U. S. Comp. St. (1901) p. 3394].

Suits in equity may be brought for the infringement of a patent (U. S. Rev. St. (1878) § 4921, amended by Act March 3, 1897, 29 U. S. St. at L. 692 [U. S. Comp. St. (1901) p. 3395]; *Root v. Lake Shore, etc., R. Co.*, 105 U. S. 189, 26 L. ed. 975; *Morss v. Knapp*, 35 Fed. 218; *Bragg v. Stockton*, 27 Fed. 509; *Colgate v. Compagnie Francaise, etc.*, 23 Fed. 82, 23 Blatchf. 86; *Brickill v. New York*, 7 Fed. 479, 18 Blatchf. 273; *Livingston v. Jones*, 15 Fed. Cas. No. 8,414, 2 Fish. Pat. Cas. 207, 3 Wall. Jr. 330 [reversed on other grounds in 1 Wall. 155, 17 L. ed. 662]), and the ordinary rules of equity jurisprudence are applicable (*Keyes v. Pueblo Smelting, etc., Co.*, 31 Fed. 560).

82. See, generally, *supra*, XI.

83. See, generally, COURTS, 11 Cyc. 860, 988.

Jurisdiction of actions for infringement against foreign corporations see COURTS, 11 Cyc. 854.

84. U. S. Rev. St. (1878) § 711; *Cochrane v. Deener*, 94 U. S. 780, 24 L. ed. 139; *Ayling v. Hull*, 2 Fed. Cas. No. 686, 2 Cliff. 494.

State courts have no jurisdiction of questions involving infringement of patents. *Parkhurst v. Kinsman*, 6 N. J. Eq. 600; *Allison Bros. Co. v. Hart*, 56 Hun (N. Y.) 282, 9 N. Y. Suppl. 692; *Wilcox, etc., Sewing Mach. Co. v. Kruse, etc., Mfg. Co.*, 14 Daly (N. Y.) 16, 3 N. Y. St. 590.

Where there is involved a controverted question as to the validity or infringement of a patent, the federal courts have jurisdiction even of suits on contracts. *Marsh v. Nichols*, 140 U. S. 344, 11 S. Ct. 798, 35 L. ed. 413; *St. Paul Plow-Works v. Starling*, 127 U. S. 376, 8 S. Ct. 327, 32 L. ed. 251; *Pacific Contracting Co. v. Union Paving, etc., Co.*, 80 Fed. 737; *Dunham v. Bent*, 72 Fed. 60; *Everett v. Haulenbeek*, 68 Fed. 911; *Seibert Cylinder Oil-Cup Co. v. Manning*, 32 Fed. 625.

Where the question of infringement is raised, the federal courts have jurisdiction, although the party also has a remedy by action for breach of contract. *Rupp, etc., Co. v. Elliott*, 131 Fed. 730, 65 C. C. A. 544.

Where the subsisting contract is shown governing the rights of the parties and defendant admits the validity and his use of plaintiff's letters patent, the suit cannot be maintained between citizens of the same state in a federal court as arising under the patent laws. *Rich v. Atwater*, 16 Conn. 409; *White v. Rankin*, 144 U. S. 628, 12 S. Ct. 768, 36 L. ed. 569; *Marsh v. Nichols*, 140 U. S. 344, 11 S. Ct. 798, 35 L. ed. 413; *Walter A. Wood Mowing, etc., Mach. Co. v. Skinner*, 139 U. S. 293, 11 S. Ct. 528, 35 L. ed. 193; *Albright v. Teas*, 106 U. S. 613, 1 S. Ct. 550, 27 L. ed. 295; *Hartell v. Tilghman*, 99 U. S. 547, 25 L. ed. 357; *Brown v. Shannon*, 20 How. (U. S.) 55, 15 L. ed. 826; *Wilson v. Sanford*, 10 How. (U. S.) 99, 13 L. ed. 344; *Bowers v. Concanon*, 105 Fed. 525; *Alaska Packers' Assoc. v. Pacific Steam Whaling Co.*, 93 Fed. 672; *Aiken v. Manchester Print Works*, 1 Fed. Cas. No. 113, 2 Cliff. 435; *Parker v. Sears*, 18 Fed. Cas. No. 10,748, 1 Fish. Pat. Cas. 93. And see COURTS, 11 Cyc. 998.

Although the use of the invention and the  
[XIII, C, 2, a]



various circuit courts, in certain district courts, and in the supreme court of the District of Columbia.<sup>85</sup> The federal statutes confer jurisdiction upon the federal courts of equity equally with courts of law;<sup>86</sup> but their jurisdiction arises only where there are grounds for equitable interference and not where the remedy at law would be full and complete.<sup>87</sup> In this respect the matter of jurisdiction at law is determined by the same general principles that apply in other suits.<sup>88</sup> If it is not clear that the remedy at law would be adequate, equity has jurisdiction.<sup>89</sup>

**b. Suit For an Accounting.** An action for an account of profits and damages alone cannot be maintained in equity where there is no equitable ground of relief.<sup>90</sup>

validity of the patent are admitted and a license is alleged, the federal courts may have jurisdiction. *White v. Rankin*, 144 U. S. 628, 12 S. Ct. 768, 36 L. ed. 569; *Young Reversible Lock-Nut Co. v. Young Lock-Nut Co.*, 72 Fed. 62; *Elgin Wind Power, etc., Co. v. Nichols*, 65 Fed. 215, 12 C. C. A. 578.

Where infringement depends on breach of contract of assignment the breach must be established before the federal courts. *Routh v. Boyd*, 51 Fed. 821.

85. U. S. Rev. St. (1878) §§ 571, 629.

Supreme court of the District of Columbia has circuit court jurisdiction. *Cochrane v. Deener*, 94 U. S. 780, 24 L. ed. 139.

86. U. S. Rev. St. (1878) § 4921; *White v. Rankin*, 144 U. S. 628, 12 S. Ct. 768, 36 L. ed. 569; *McCoy v. Nelson*, 121 U. S. 484, 7 S. Ct. 1000, 30 L. ed. 1017; *Root v. Lake Shore, etc., R. Co.*, 105 U. S. 189, 26 L. ed. 975; *Jonathan Mills Mfg. Co. v. Whitehurst*, 56 Fed. 589; *Kirk v. Du Bois*, 28 Fed. 460; *Avery v. Wilson*, 20 Fed. 856; *Doughty v. West*, 7 Fed. Cas. No. 4,029, 2 Fish. Pat. Cas. 553; *Goodyear v. Hullihen*, 10 Fed. Cas. No. 5,573, 3 Fish. Pat. Cas. 251, 2 Hughes 492; *Livingston v. Jones*, 15 Fed. Cas. No. 8,414, 2 Fish. Pat. Cas. 207, 3 Wall. Jr. 330 [*reversed* on other grounds in 1 Wall. 155, 17 L. ed. 662]; *McMillin v. Barclay*, 16 Fed. Cas. No. 8,902, 5 Fish. Pat. Cas. 189, 4 Brewst. (Pa.) 275, 3 Pittsb. (Pa.) 377.

English practice.—Court may award damages as well as injunction (*Newell v. Wilson*, 2 De G. M. & G. 282, 51 Eng. Ch. 220, 42 Eng. Reprint 880; *Tuck v. Silver, Johns*, 218, 70 Eng. Reprint 403), and may order infringing article destroyed (*Vavasour v. Krupp*, 9 Ch. D. 351, 39 L. T. Rep. N. S. 437, 27 Wkly. Rep. 176).

87. *Root v. Lake Shore, etc., R. Co.*, 105 U. S. 189, 26 L. ed. 975; *Edison Phonograph Co. v. Hawthorne, etc., Mfg. Co.*, 108 Fed. 630; *Overweight Counterbalance Elevator Co. v. Standard Elevator, etc., Co.*, 96 Fed. 231; *Ross v. Ft. Wayne*, 58 Fed. 404 [*reversed* on other grounds in 63 Fed. 466, 11 C. C. A. 288]; *Drainage Construction Co. v. Chelsea*, 41 Fed. 47; *Ulman v. Chickering*, 33 Fed. 582; *Smith v. Sands*, 24 Fed. 470; *Hayward v. Andrews*, 12 Fed. 786; *Adams v. Meyrose*, 7 Fed. 208, 2 McCrary 360; *Livingston v. Jones*, 15 Fed. Cas. No. 8,414, 2 Fish. Pat. Cas. 207, 3 Wall. Jr. 330 [*reversed* on other grounds in 1 Wall. 155, 17 L. ed. 662]; *Sanders v. Logan*, 21 Fed. Cas. No. 12,295, 2 Fish. Pat. Cas. 167, 2 Pittsb. (Pa.) 241; *Sayles v. Richmond, etc., R. Co.*, 21 Fed. Cas.

No. 12,424, 4 Ban. & A. 239, 3 Hughes 172, 16 Off. Gaz. 43; *Vaughan v. Central Pac. R. Co.*, 28 Fed. Cas. No. 16,897, 3 Ban. & A. 27, 4 Sawy. 280; *Vaughan v. East Tennessee, etc., R. Co.*, 28 Fed. Cas. No. 16,898, 2 Ban. & A. 537, 1 Flipp. 621, 11 Off. Gaz. 789.

Where suit is primarily on contract, equity has no jurisdiction, although an account is asked. *Perry v. Noyes*, 96 Fed. 233.

Where bill alleges grounds for equity jurisdiction, admissions by defendant cannot oust jurisdiction. *Lilienthal v. Washburn*, 8 Fed. 707, 4 Woods 65.

Jurisdiction is not ousted by cessation of infringement by defendant. *Cayuta Wheel, etc., Co. v. Kennedy Valve Mfg. Co.*, 127 Fed. 355.

Right to injunction gives jurisdiction to a court of equity. *Henzel v. California Electrical Works*, 51 Fed. 754, 2 C. C. A. 495 [*affirming* 48 Fed. 375].

88. *Root v. Lake Shore, etc., R. Co.*, 105 U. S. 189, 26 L. ed. 975; *Woodmanse, etc., Mfg. Co. v. Williams*, 68 Fed. 489, 15 C. C. A. 520; *Brooks v. Miller*, 28 Fed. 615.

89. *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 65 Fed. 619; *Bicknell v. Todd*, 3 Fed. Cas. No. 1,389, Fish. Pat. Rep. 452, 5 McLean 236; *McMillan v. Barclay*, 16 Fed. Cas. No. 8,902, 5 Fish. Pat. Cas. 189, 4 Brewst. (Pa.) 275, 3 Pittsb. (Pa.) 377; *Vaughan v. East Tennessee, etc., R. Co.*, 28 Fed. Cas. No. 16,898, 2 Ban. & A. 537, 1 Flipp. 621, 11 Off. Gaz. 789.

90. *Root v. Lake Shore, etc., R. Co.*, 105 U. S. 189, 26 L. ed. 975; *Russell v. Kern*, 69 Fed. 94, 16 C. C. A. 154 [*affirming* 64 Fed. 581]; *Germain v. Wilgus*, 67 Fed. 597, 14 C. C. A. 561; *American Cable R. Co. v. Citizens' R. Co.*, 44 Fed. 484; *Consolidated Midlings Purifier Co. v. Wolf*, 28 Fed. 814; *Burdell v. Comstock*, 15 Fed. 395; *Draper v. Hudson*, 7 Fed. Cas. No. 4,069, 6 Fish. Pat. Cas. 327, Holmes 208, 3 Off. Gaz. 354; *Jenkins v. Greenwald*, 13 Fed. Cas. No. 7,270, 1 Bond 126, 2 Fish. Pat. Cas. 37; *Livingston v. Jones*, 15 Fed. Cas. No. 8,414, 2 Fish. Pat. Cas. 207, 3 Wall. Jr. 330 [*reversed* on other grounds in 1 Wall. 155, 17 L. ed. 662]; *Sayles v. Richmond, etc., R. Co.*, 21 Fed. Cas. No. 12,424, 4 Ban. & A. 239, 3 Hughes 172, 16 Off. Gaz. 43. *Contra*, *Atwood v. Portland Co.*, 10 Fed. 283; *Smith v. Baker*, 22 Fed. Cas. No. 13,010, 1 Ban. & A. 117, 5 Off. Gaz. 496, 10 Phila. (Pa.) 221. See also *infra*, XIII, C, 2, c.

An account is an incident to an injunction and cannot be had otherwise. *Smith v. Lon-*



Nevertheless, an account may be had where there is ground for equitable interference.<sup>91</sup>

**c. Expiration of Patent.** Where suit is brought upon a patent which has expired, equity ordinarily has no jurisdiction, the proper remedy being at law;<sup>92</sup> but where expired and unexpired patents are joined, equity may take jurisdiction;<sup>93</sup> and where jurisdiction is once acquired it will not ordinarily be ousted by the expiration of the patent.<sup>94</sup> A preliminary injunction against infringement will not be granted where, before the determination of the motion therefor, the patent sued on has expired.<sup>95</sup>

**3. PLACE TO SUE.** Suit for infringement must be brought in the district of which defendant is an inhabitant,<sup>96</sup> or in the district in which defendant, whether

don, etc., R. Co., 2 Eq. Rep. 428, 1 Kay 408, 23 L. J. Ch. 562, 2 Wkly. Rep. 310, 69 Eng. Reprint 173; Price's Patent Candle Co. v. Bauwen's Patent Candle Co., 4 Kay & J. 727, 70 Eng. Reprint 302.

91. Eclipse Bicycle Co. v. Farrow, 16 App. Cas. (D. C.) 468; McMillin v. St. Louis, etc., Transp. Co., 18 Fed. 260, 5 McCrary 561; Perry v. Corning, 19 Fed. Cas. No. 11,003, 6 Blatchf. 134.

Where jurisdiction acquired accounting may be continued, although impossible to grant the equitable relief. Busch v. Jones, 16 App. Cas. (D. C.) 23.

92. Root v. Lake Shore, etc., R. Co., 105 U. S. 189, 26 L. ed. 975; Adams v. Bridgewater Iron Co., 26 Fed. 324; Consolidated Safety-Valve Co. v. Ashton Valve Co., 26 Fed. 319; Lord v. Whitehead, etc., Mach. Co., 24 Fed. 801; Hewitt v. Pennsylvania Steel Co., 24 Fed. 367; Campbell v. Ward, 12 Fed. 150. *Contra*, Gordon v. Anthony, 10 Fed. Cas. No. 5,605, 4 Ban. & A. 248, 16 Blatchf. 234, 16 Off. Gaz. 1135; Howes v. Nute, 12 Fed. Cas. No. 6,790, 4 Cliff. 173, 4 Fish. Pat. Cas. 263; Sayles v. Dubuque, etc., R. Co., 21 Fed. Cas. No. 12,417, 3 Ban. & A. 219, 5 Dill. 561; Sickles v. Gloucester Mfg. Co., 22 Fed. Cas. No. 12,841, 4 Blatchf. 229, 1 Fish. Pat. Cas. 222; Stevens v. Kansas Pac. R. Co., 23 Fed. Cas. No. 13,401, 5 Dill. 486; Vaughan v. East Tennessee, etc., R. Co., 28 Fed. Cas. No. 16,898, 2 Ban. & A. 537, 1 Flipp. 621, 11 Off. Gaz. 789.

93. Huntington Dry Pulverizer Co. v. Virginia-Carolina Chemical Co., 130 Fed. 558.

94. Expiration of patent pending suit does not oust jurisdiction, and while preventing injunction will not prevent account. Busch v. Jones, 16 App. Cas. (D. C.) 23; Beedle v. Bennett, 122 U. S. 71, 7 S. Ct. 1090, 30 L. ed. 1074; Clark v. Wooster, 119 U. S. 322, 7 S. Ct. 217, 30 L. ed. 392; Huntington Dry Pulverizer Co. v. Virginia-Carolina Chemical Co., 130 Fed. 558; U. S. Mitis Co. v. Detroit Steel, etc., Co., 122 Fed. 863, 59 C. C. A. 589; Chinnock v. Paterson, etc., Tel. Co., 112 Fed. 531, 50 C. C. A. 384 [reversing 110 Fed. 199]; Bradner Adjustable Hanger Co. v. Waterbury Button Co., 106 Fed. 735; Ross v. Ft. Wayne, 63 Fed. 466, 11 C. C. A. 288; Singer Mfg. Co. v. Wilson Sewing Mach. Co., 38 Fed. 586; Kittle v. Rogers, 33 Fed. 49; Kittle v. Schneider, 30 Fed. 690; Kittle v. De Graaf, 30 Fed. 689; Brooks v. Miller, 28

Fed. 615; Adams v. Bridgewater Iron Co., 26 Fed. 324; Dick v. Struthers, 25 Fed. 103; New York Grape Sugar Co. v. Peoria Grape Sugar Co., 21 Fed. 878; Adams v. Howard, 19 Fed. 317; Gottfried v. Moerlein, 14 Fed. 170; Jones v. Barker, 11 Fed. 597; Bloomer v. Gilpin, 3 Fed. Cas. No. 1,558, 4 Fish. Pat. Cas. 50; Imlay v. Norwich, etc., R. Co., 13 Fed. Cas. No. 7,012, 4 Blatchf. 227, 1 Fish. Pat. Cas. 340; Jordan v. Dobson, 13 Fed. Cas. No. 7,519, 2 Abb. 398, 4 Fish. Pat. Cas. 232, 7 Phila. (Pa.) 533; Davenport v. Rylands, L. R. 1 Eq. 302, 12 Jur. N. S. 71, 35 L. J. Ch. 204, 14 L. T. Rep. N. S. 53, 14 Wkly. Rep. 243; Fox v. Dellestable, 15 Wkly. Rep. 194.

Where the equitable relief prayed may be obtained after expiration of the patent the suit may be sustained. Toledo Mower, etc., Co. v. Johnston Harvester Co., 24 Fed. 739, 23 Blatchf. 332.

Where patent was about to expire when suit filed and no special ground for equitable interference was shown, the suit was dismissed. Miller v. Schwarner, 130 Fed. 561; Heap v. Borchers, 108 Fed. 237; McDonald v. Miller, 84 Fed. 344; American Cable R. Co. v. Chicago City R. Co., 41 Fed. 522; Racine Seeder Co. v. Joliet Wire-Check Rower Co., 27 Fed. 367; Davis v. Smith, 19 Fed. 823.

Where impossible to obtain final decree before expiration of the patent the suit was dismissed. Bragg Mfg. Co. v. Hartford, 56 Fed. 292; American Cable R. Co. v. Chicago City R. Co., 41 Fed. 522.

95. Huntington Dry Pulverizer Co. v. Virginia-Carolina Chemical Co., 121 Fed. 136.

96. Act March 3, 1897, c. 395, 29 U. S. St. at L. 695 [U. S. Comp. St. (1901) p. 588].

**Sales anywhere enjoined.**—Resident of district may be enjoined from selling anywhere. Hatch v. Hall, 22 Fed. 438; Boyd v. McAlpin, 3 Fed. Cas. No. 1,748, 3 McLean 427, 2 Robb Pat. Cas. 277.

Where residence and business are in different districts there is no jurisdiction. Goodyear v. Chaffee, 10 Fed. Cas. No. 5,564, 3 Blatchf. 268.

**In Canada** suit must be brought in court nearest defendant's residence. Short v. Federation Brand Salmon Canning Co., 6 Brit. Col. 385, 436; Aitheson v. Maun, 9 Ont. Pr. 253, 473; Goldsmith v. Walton, 9 Ont. Pr. 10.



a person, partnership, or corporation, shall have committed acts of infringement, and has a regular and established place of business.<sup>97</sup> In the last case subpoena or process may be served upon the agent conducting the business.<sup>98</sup>

4. **GROUND.**<sup>99</sup> To constitute a basis for an infringement suit, there must have been an unauthorized use<sup>1</sup> by defendant of an invention covered by a valid patent owned by plaintiff.<sup>2</sup>

5. **CONDITIONS PRECEDENT.** Under U. S. Rev. St. (1878) § 4900 [U. S. Comp. St. (1901) p. 3388], a patentee or his assignee cannot in a suit against infringers recover damages, without alleging and proving either that patented articles made and sold by him, or the packages containing them, are marked "patented," or else that it gave notice to defendants of his patents and their infringement;<sup>3</sup> and in the event that direct notice to defendants is alleged and proved neither damages nor profits are recoverable, except for infringement after such notice was given.<sup>4</sup> The owner of a patent who has obtained an interlocutory decree adjudging its validity and infringement is not required to wait until it has become final before bringing suit against defendant for infringement by the same device in another district; nor is he precluded, by the fact that evidence has been taken in the second suit, from pleading therein the final decree when obtained in the first suit as an adjudication.<sup>5</sup>

6. **DEFENSES**<sup>6</sup> — a. **In General.** Defendant may show that he does not use the patented invention.<sup>7</sup> So also he may show that plaintiff is not the owner of the

97. *Westinghouse Electric, etc., Co. v. Stanley Electric Mfg. Co.*, 121 Fed. 101; *Chicago Pneumatic Tool Co. v. Philadelphia Pneumatic Tool Co.*, 118 Fed. 852; *Westinghouse Electric, etc., Co. v. Stanley Electric Mfg. Co.*, 116 Fed. 641.

Infringement committed in the district is necessary. *International Wireless Tel. Co. v. Fessenden*, 131 Fed. 491; *Streat v. American Rubber Co.*, 115 Fed. 634; *Wilson Packing Co. v. Clapp*, 30 Fed. Cas. No. 17,850, 3 Ban. & A. 243, 8 Biss. 154, 13 Off. Gaz. 368.

Place of business in the district at the time of suit is necessary. *Feder v. Fiedler*, 116 Fed. 378.

Defects in allegations and service are waived by appearance. U. S. Consol. Seeded Raisin Co. v. Phoenix Raisin Seeding, etc., Co., 124 Fed. 234.

98. Act March 3, 1897, 29 U. S. St. at L. 695 [U. S. Comp. St. (1901) p. 588]. And see *Eagle Mfg. Co. v. Miller*, 41 Fed. 351 [reversed on other grounds in 151 U. S. 186, 14 S. Ct. 310, 38 L. ed. 121].

Service upon one merely designated agent under state law is insufficient. U. S. Gramophone Co. v. Columbia Phonograph Co., 106 Fed. 220.

Agent and established place of business defined see *Thomson-Houston Electric Co. v. Bullock Electric Co.*, 101 Fed. 587.

99. Grounds for preliminary injunction see *infra*, XIII, C, 11, b.

Recovery back of payment see **PAYMENT**.

1. *Hapgood v. Hewitt*, 119 U. S. 226, 7 S. Ct. 193, 30 L. ed. 369; *Eunson v. Dodge*, 18 Wall. (U. S.) 414, 21 L. ed. 766; *Hammacher v. Wilson*, 26 Fed. 239 [affirmed in 145 U. S. 662, 12 S. Ct. 991, 36 L. ed. 853]; *Tilghman v. Hartell*, 23 Fed. Cas. No. 14,039, 2 Ban. & A. 260, 11 Phila. (Pa.) 500 [reversed on other grounds in 99 U. S. 547, 25 L. ed. 357]; *Westlake v. Cartter*, 29 Fed.

Cas. No. 17,451, 6 Fish. Pat. Cas. 519, 4 Off. Gaz. 636.

Use must be unauthorized.—*Betts v. Willmott*, L. R. 6 Ch. 239, 25 L. T. Rep. N. S. 188, 19 Wkly. Rep. 369.

Proof of infringement is necessary. *Bates v. Coe*, 98 U. S. 31, 25 L. ed. 68; *Fuller v. Yentzer*, 94 U. S. 288, 24 L. ed. 103. See also *infra*, XIII, C, 14, b.

That infringement must be before suit is brought see *Humane Bit Co. v. Barnett*, 117 Fed. 316; *Slessinger v. Buckingham*, 17 Fed. 454, 8 Sawy. 469.

2. *Henius v. Lublin*, 30 Fed. 838; *Miller v. Foree*, 9 Fed. 603; *Knight v. Baltimore, etc., R. Co.*, 14 Fed. Cas. No. 7,882, 3 Fish. Pat. Cas. 1, Taney 106; *Morgan v. McAdam*, 15 L. T. Rep. N. S. 348.

Before a patent is granted, no suit can be maintained. *Rein v. Clayton*, 37 Fed. 354, 3 L. R. A. 78; *Wyeth v. Stone*, 30 Fed. Cas. No. 18,107, 2 Robb Pat. Cas. 23, 1 Story 273.

3. *Dunlap v. Schofield*, 152 U. S. 244, 14 S. Ct. 576, 38 L. ed. 426. And see *Coupe v. Royer*, 155 U. S. 565, 15 S. Ct. 199, 39 L. ed. 263; *McComb v. Brodie*, 15 Fed. Cas. No. 8,708, 5 Fish. Pat. Cas. 384, 1 Woods 153, 2 Off. Gaz. 117.

Prior to the enactment of the statute under consideration it seems that previous notice or claim of right and exclusive use of device was not essential to enable the patentee to recover damages for infringement. *Ames v. Howard*, 1 Fed. Cas. No. 326, 1 Robb Pat. Cas. 689, 1 Sumn. 482.

4. *Lorain Steel Co. v. New York Switch, etc., Co.*, 153 Fed. 205.

5. *Bredin v. National Metal Weatherstrip Co.*, 147 Fed. 741 [affirmed in 157 Fed. 1003].

6. To suits for permanent injunction see *infra*, XIII, C, 11, c.

7. See *supra*, XIII, A, 6.



patent,<sup>9</sup> or is not entitled to maintain the suit against him thereon,<sup>9</sup> or that the patent upon which suit is brought is void.<sup>10</sup> The fact that the machine of a patent has never been put into commercial use does not preclude the owner of the patent from maintaining a suit in equity to enjoin its infringement.<sup>11</sup>

**b. Estoppel.** The general principles of estoppel apply in suits for infringement.<sup>12</sup>

**c. Combination in Restraint of Trade.** It is no defense to a suit upon a patent that the complainant has made an illegal combination with others in restraint of trade.<sup>13</sup>

Failure to deny is admission. *Parker v. Banker*, 18 Fed. Cas. No. 10,725, 6 McLean 631.

*B. Bunnett v. Smith*, 2 D. & L. 380, 8 Jur. 1634, 14 L. J. Exch. 47, 13 M. & W. 552. And see *infra*, XIII, C, 7, a.

Part ownership of a patent is a complete defense. *Aspinwall Mfg. Co. v. Gill*, 32 Fed. 697.

**9. License** is a complete defense (*Hapgood v. Hewitt*, 119 U. S. 226, 7 S. Ct. 193, 30 L. ed. 369; *Eunson v. Dodge*, 18 Wall. (U. S.) 414, 21 L. ed. 766; *Barber v. National Carbon Co.*, 129 Fed. 370, 64 C. C. A. 40, 5 L. R. A. N. S. 1154; *Hammacher v. Wilson*, 26 Fed. 239 [affirmed in 145 U. S. 662, 12 S. Ct. 991, 36 L. ed. 853]; *Loercher v. Crandal*, 11 Fed. 872, 20 Blatchf. 106; *Black v. Hubbard*, 3 Fed. Cas. No. 1,460, 3 Ban. & A. 39, 12 Off. Gaz. 842; *Tilghman v. Hartell*, 23 Fed. Cas. No. 14,039, 2 Ban. & A. 260, 9 Off. Gaz. 886, 11 Phila. (Pa.) 500 [reversed on other grounds in 99 U. S. 547, 25 L. ed. 357]; *Westlake v. Cartter*, 29 Fed. Cas. No. 17,451, 6 Fish. Pat. Cas. 519, 4 Off. Gaz. 636), except where its conditions are violated (*Jones v. Berger*, 58 Fed. 1006; *Timken v. Olin*, 41 Fed. 169; *Fetter v. Newhall*, 17 Fed. 841, 21 Blatchf. 445).

**10. Invalidity** is a complete defense.—*Bates v. Coe*, 98 U. S. 31, 25 L. ed. 68; *Von Schmidt v. Bowers*, 80 Fed. 121, 25 C. C. A. 323; *Henius v. Lublin*, 30 Fed. 838; *Shaw v. Colwell Lead Co.*, 11 Fed. 711, 20 Blatchf. 417; *Miller v. Foree*, 9 Fed. 603; *Knight v. Baltimore, etc., R. Co.*, 14 Fed. Cas. No. 7,882, 3 Fish. Pat. Cas. 1, Taney 106; *Morris v. Huntington*, 17 Fed. Cas. No. 9,831, 1 Paine 348, 1 Robb Pat. Cas. 448.

The defenses are not confined to those mentioned in U. S. Rev. St. (1878) § 4920, but include any showing that the patent is void. *Gardner v. Herz*, 118 U. S. 180, 6 S. Ct. 1027, 30 L. ed. 158; *Thompson v. Boisselier*, 114 U. S. 1, 5 S. Ct. 1042, 29 L. ed. 76; *Mahn v. Harwood*, 112 U. S. 354, 5 S. Ct. 174, 23 L. ed. 665.

**11. Eastern Paper Bag Co. v. Continental Paper Bag Co.**, 150 Fed. 741 [affirmed in 210 U. S. 405, 28 S. Ct. 748]. And see U. S. *Fastener Co. v. Bradley*, 149 Fed. 222, 79 C. C. A. 180.

**12. Thomson v. Wooster**, 114 U. S. 104, 5 S. Ct. 788, 29 L. ed. 105; *Russell v. Place*, 94 U. S. 606, 24 L. ed. 214; *Consolidated Rubber Tire Co. v. Finley Rubber Tire Co.*, 119 Fed. 705; *Jennings v. Rogers Silver Plate Co.*, 118 Fed. 339; *Burrell v. Elgin Creamery*

*Co.*, 96 Fed. 234; *Time Tel. Co. v. Himmer*, 19 Fed. 322. See also *supra*, VI, F.

**Estoppel as assignor.**—The assignor cannot ordinarily deny the validity of letters patent (*Griffith v. Shaw*, 89 Fed. 313; *Daniel v. Miller*, 81 Fed. 1000); but the rule does not apply either as against him or his co-defendants, where the latter are the principal infringers and he is acting merely as an employee (*Boston Lasting Mach. Co. v. Woodward*, 82 Fed. 97, 27 C. C. A. 69 [affirming 75 Fed. 272]), so he may dispute the alleged scope of the patent in view of the prior art (*Smith v. Ridgely*, 103 Fed. 875, 43 C. C. A. 365; *Griffith v. Shaw*, 89 Fed. 313).

One who fails to perform his agreement to assign a patent cannot sue his proposed assignee for infringement. *Schmitt v. Nelson Valve Co.*, 125 Fed. 754, 60 C. C. A. 522.

**Infringer cannot deny utility.** *Animarium Co. v. Filloon*, 102 Fed. 896 [reversing 98 Fed. 103].

**Co-complainant cannot license defendant and defeat the suit.** *Lalance, etc., Mfg. Co. v. Haberman Mfg. Co.*, 107 Fed. 487.

**Non-use or misuse of the invention by complainant does not operate as estoppel.** *Fulmer v. Berger*, 120 Fed. 274, 56 C. C. A. 588.

**Admissions in open court are binding.** *Kirchberger v. American Acetylene Burner Co.*, 124 Fed. 764 [affirmed in 128 Fed. 599, 64 C. C. A. 107].

**Holder of reissue not estopped to sue one who used the invention prior to reissue.** *Crown Cork, etc., Co. v. Aluminum Stopper Co.*, 108 Fed. 845, 48 C. C. A. 72 [reversing 100 Fed. 849].

**Filing an application for patent for the same thing does not estop defendant, but has weight.** *Haughey v. Lee*, 151 U. S. 282, 14 S. Ct. 331, 38 L. ed. 162; *R. Thomas, etc., Co. v. Electric Porcelain, etc., Co.*, 111 Fed. 923.

**13. Bement v. National Harrow Co.**, 186 U. S. 70, 22 S. Ct. 747, 46 L. ed. 1058; *Cimiotti Unhairing Co. v. American Fur Refining Co.*, 120 Fed. 672; *Otis Elevator Co. v. Geiger*, 107 Fed. 131; *National Folding-Box, etc., Co. v. Robertson*, 99 Fed. 985; *Brown Saddle Co. v. Troxel*, 98 Fed. 620; *Bonsack Mach. Co. v. Smith*, 70 Fed. 383; *Edison Electric Light Co. v. Sawyer-Man Electric Co.*, 53 Fed. 592, 3 C. C. A. 605 [modifying 52 Fed. 300]. But see *Good v. Daland*, 121 N. Y. 1, 24 N. E. 15; *Indiana Mfg. Co. v. J. I. Case Threshing Mach. Co.*, 148 Fed. 21.



d. **Limitations and Laches**—(i) *LIMITATIONS*. By express provisions of a recent federal enactment no damages can be recovered for acts of infringement occurring more than six years before suit is brought.<sup>14</sup> So by express provision this statute applies to all existing causes of action;<sup>15</sup> and it is held to apply to actions at law as well as to suits in equity.<sup>16</sup> In all cases where a federal statute of limitation exists, state statutes of limitation can have no application.<sup>17</sup> But prior to 1870,<sup>18</sup> and subsequent to 1874,<sup>19</sup> no federal statutes existed limiting the time within which actions for infringement of patents must be brought, and the question frequently arose whether actions at law were subject to state statutes of limitation, there being considerable conflict in the decisions.<sup>20</sup> This question was finally set at rest by the supreme court of the United States, which held that in the absence of federal legislation the statutes of limitation of the several states were applicable.<sup>21</sup>

(ii) *LACHES*—(A) *In General*—(1) *As BAR TO PERMANENT INJUNCTION*. Mere delay in bringing a suit for infringement, unaccompanied by such deceitful acts or silence on the part of the patentee, and by such circumstances as amount to an equitable estoppel, will not warrant the application of the doctrine of laches to such a suit within the time fixed by statute for the commencement of the analogous action at law.<sup>22</sup> Thus mere delay in bringing suit for infringement of a patent will not prevent the owner thereof from obtaining relief in a court of equity when the infringement has been persisted in with knowledge of the patent, and there have been no acts of commission or omission on the part of the

14. U. S. Rev. St. (1878) § 4921, as amended March 3, 1897, 29 U. S. St. at L. 693 [U. S. Comp. St. (1901) p. 3395].

15. U. S. Rev. St. (1878) § 4921, as amended March 3, 1897, 29 U. S. St. at L. 693 [U. S. Comp. St. (1901) p. 3395]; *American Pneumatic Tool Co. v. Pratt, etc., Co.*, 106 Fed. 229.

16. *Peters v. Hanger*, 134 Fed. 586, 67 C. C. A. 386.

17. *Hayden v. Oriental Mills*, 22 Fed. 103; *Sayles v. Louisville City R. Co.*, 9 Fed. 512; *Sayles v. Oregon Cent. R. Co.*, 21 Fed. Cas. No. 12,423, 4 Ban. & A. 429, 8 Reporter 424, 6 Sawy. 31; *Sayles v. Dubuque, etc., R. Co.*, 21 Fed. Cas. No. 12,417, 3 Ban. & A. 219, 5 Dill. 561; *Sayles v. Richmond, etc., R. Co.*, 21 Fed. Cas. No. 12,424, 4 Ban. & A. 239, 3 Hughes 172, 7 Reporter 743, 16 Off. Gaz. 43; *Vaughan v. East Tennessee, etc., R. Co.*, 28 Fed. Cas. No. 16,898, 2 Ban. & A. 537, 1 Flipp. 621, 11 Off. Gaz. 789.

18. *Campbell v. New York*, 81 Fed. 182; *Hayden v. Oriental Mills*, 22 Fed. 103; *Parker v. Hallock*, 18 Fed. Cas. No. 10,735, 2 Fish. Pat. Cas. 543 note; *Wood v. Cleveland Rolling-Mill Co.*, 30 Fed. Cas. No. 17,941, 4 Fish. Pat. Cas. 550.

19. *Campbell v. Haverhill*, 155 U. S. 610, 15 S. Ct. 217, 39 L. ed. 280; *May v. Logan*, 30 Fed. 250.

20. Cases holding that state statutes control.—*Hayden v. Oriental Mills*, 15 Fed. 605; *Parker v. Hawk*, 18 Fed. Cas. No. 10,737, 2 Fish. Pat. Cas. 58.

Cases adopting the contrary view.—*Brickill v. Baltimore*, 52 Fed. 737; *Brickill v. Buffalo*, 49 Fed. 371; *California Artificial Stone Paving Co. v. Starr*, 48 Fed. 560; *McGinnis v. Erie County*, 45 Fed. 91; *May v. Ralls County*, 31 Fed. 473; *May v. Cass*

*County*, 30 Fed. 762; *May v. Logan County*, 30 Fed. 250; *Hayward v. St. Louis*, 11 Fed. 427, 3 McCrary 614; *Collins v. Peebles*, 6 Fed. Cas. No. 3,017, 2 Fish. Pat. Cas. 541.

21. *Campbell v. Haverhill*, 155 U. S. 610, 15 S. Ct. 217, 39 L. ed. 280.

22. *Ide v. Trorlicht, etc., Carpet Co.*, 115 Fed. 137, 53 C. C. A. 341; *Stearns-Roger Mfg. Co. v. Brown*, 114 Fed. 939, 52 C. C. A. 559; *Imperial Chemical Mfg. Co. v. Stein*, 77 Fed. 612, 23 C. C. A. 353 [reversing 69 Fed. 616]; *Taylor v. Sawyer Spindle Co.*, 75 Fed. 301, 22 C. C. A. 203; *Bragg Mfg. Co. v. Hartford*, 56 Fed. 292; *Price v. Joliet Steel Co.*, 46 Fed. 107; *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 18 Fed. 638, 21 Blatchf. 519; *Atlantic Giant-Powder Co. v. Rand*, 2 Fed. Cas. No. 626, 4 Ban. & A. 263, 16 Blatchf. 250, 16 Off. Gaz. 87; *Stevens v. Felt*, 23 Fed. Cas. No. 13,397. The mere discontinuance of proceedings against infringers and forbearance to sue any of the parties thereto for a period of a year or more thereafter cannot be construed into an acquiescence in the infringement complained of. *Thompson v. Jewett*, 23 Fed. Cas. No. 13,961.

Conduct held to constitute laches see *Wilcox, etc., Co. v. Farrand Organ Co.*, 139 Fed. 46; *American Tube Works v. Bridgewater Iron Co.*, 132 Fed. 16, 65 C. C. A. 636 (three years after knowledge of infringement); *Meyrowitz Mfg. Co. v. Eccleston*, 98 Fed. 437; *McLaughlin v. People's R. Co.*, 21 Fed. 574; *Goodyear v. Honsinger*, 10 Fed. Cas. No. 5,572, 2 Biss. 1, 3 Fish. Pat. Cas. 147; *Wyeth v. Stone*, 30 Fed. Cas. No. 18,107, 2 Robb Pat. Cas. 23, 1 Story 273.

Conduct held not to constitute laches see *New York Phonograph Co. v. Edison*, 136 Fed. 600; *Carter v. Wollschlaeger*, 53 Fed. 573.



patentee to encourage its use,<sup>23</sup> nor where it appears that during the delay another suit was pending for infringement by a machine substantially the same as defendant's.<sup>24</sup> An injunction will not, however, be granted in any case where the party applying for it has not shown good faith, conscience, activity, and diligence, nor where there is any doubt or uncertainty as to the facts.<sup>25</sup> So where a patentee, with knowledge of a device made by defendant, makes no claim of infringement for several years, he will be held estopped to thereafter place a different construction on his patent, for the purpose of making out a case of infringement.<sup>26</sup> A patentee cannot maintain an action of infringement against a mere user who, in common with the public generally, has used the patented device for a period of eleven years with the full knowledge of the patentee and without objection.<sup>27</sup> Where there is no acquiescence on the part of the patentee, nor conscious infringement on the part of the defendants, there is no moral delinquency on either side, or an actual estoppel; and both parties being innocent, diligence will be required of him whose property is to be protected, and the patentee will be left to his action for damages.<sup>28</sup>

(2) AS BAR TO PRELIMINARY INJUNCTION. The granting or withholding of a preliminary injunction in an infringement suit is within the proper discretion of the court. Where a patentee has known of infringement of his patent, and has acquiesced therein for a considerable length of time, a preliminary injunction will not be granted without an explanation of such acquiescence.<sup>29</sup> It will be withheld when apparently sought for the purpose of obtaining an undue advantage,<sup>30</sup> for the purpose of creating mischief,<sup>31</sup> or of coercing a compromise.<sup>32</sup> But mere

23. *Wilcox, etc., Co. v. Farrand Organ Co.*, 139 Fed. 46.

24. *Plecker v. Poorman*, 147 Fed. 528.

25. *Cooper v. Mattheys*, 6 Fed. Cas. No. 3,200, 5 Pa. L. J. 38. And see *Beid-Archer Co. v. North American Chemical, etc., Co.*, 147 Fed. 746.

26. *McGill v. Whitehead, etc., Co.*, 137 Fed. 97; *Westinghouse Electric, etc., Co. v. Wagner Electric Mfg. Co.*, 129 Fed. 604.

A delay of ten years by a patent owner after knowledge of an alleged infringement, and correspondence with defendant, who in good faith contended for a construction of the patent avoiding infringement, is such laches as will bar all relief in equity. *Starrett v. J. Stevens Arms, etc., Co.*, 96 Fed. 244.

27. *Edison Electric Light Co. v. Equitable L. Assur. Soc.*, 55 Fed. 478.

28. *Merriam v. Smith*, 11 Fed. 588.

29. *Brush Electric Co. v. Electric Storage Battery Co.*, 64 Fed. 775; *Price v. Joliet Steel Co.*, 46 Fed. 107; *Waite v. Chichester Chair Co.*, 45 Fed. 258; *Keyes v. Pueblo Smelting, etc., Co.*, 31 Fed. 560; *Ladd v. Cameron*, 25 Fed. 37; *Mundy v. Kendall*, 23 Fed. 591; *United Nickel Co. v. New Home Sewing Mach. Co.*, 17 Fed. 528, 21 Blatchf. 415; *Goodyear v. Honsinger*, 10 Fed. Cas. No. 5,572, 2 Biss. 1, 3 Fish. Pat. Cas. 147; *Green v. French*, 10 Fed. Cas. No. 5,757, 4 Ban. & A. 169, 16 Off. Gaz. 215; *North v. Kershaw*, 18 Fed. Cas. No. 10,311, 4 Blatchf. 70; *Sloat v. Plymton*, 22 Fed. Cas. No. 12,948; *Sperry v. Ribbans*, 22 Fed. Cas. No. 13,238, 3 Ban. & A. 260; *Spring v. Domestic Sewing-Mach. Co.*, 22 Fed. Cas. No. 13,258, 4 Ban. & A. 427, 16 Off. Gaz. 721; *Whitney v. Rollstone Mach. Works*, 29 Fed. Cas. No.

17,596, 2 Ban. & A. 170, 8 Off. Gaz. 908; *Bovill v. Crate, L. R.* 1 Eq. 388; *Bridson v. Benecke*, 12 Beav. 1, 50 Eng. Reprint 960; *Flavel v. Harrison*, 10 Hare 467, 17 Jur. 368, 22 L. J. Ch. 866, 1 Wkly. Rep. 213, 44 Eng. Ch. 452, 68 Eng. Reprint 1010; *Baxter v. Combe*, 1 Ir. Ch. 284.

A delay of eighteen months, after knowledge of an infringement, in applying for a preliminary injunction, is of itself good ground for its refusal. *Hockholzer v. Eager*, 12 Fed. Cas. No. 6,556, 2 Sawy. 361.

A delay of three months in filing a bill after the infringement was ascertained, defendant not having been induced to change his position, is no ground for refusing an injunction. *Union Paper-Bag Mach. Co. v. Binney*, 24 Fed. Cas. No. 14,387, 5 Fish. Pat. Cas. 166.

One who is known to the patentee to be using his patent in apparent good faith is entitled to definite and early information of the patentee's construction of his own rights, and of his intention to enforce them. *Morris v. Lowell Mfg. Co.*, 17 Fed. Cas. No. 9,833, 3 Fish. Pat. Cas. 37.

A preliminary injunction will not issue against a mere user of a machine, when the patentee has known for several years that the makers thereof were manufacturing such machines and did not warn or proceed against them or any one else. *Ballou Shoe-Mach. Co. v. Dizer*, 85 Fed. 864.

30. *Ney Mfg. Co. v. Superior Drill Co.*, 56 Fed. 152.

31. *Nilson v. Thompson*, Web. Pat. Cas. 275.

32. *Parker v. Sears*, 18 Fed. Cas. No. 10,748, 1 Fish. Pat. Cas. 93, 4 Pa. L. J. Rep. 443.



forbearance to sue for a reasonable time, after notice given, will not, in the absence of any affirmative encouragement to defendant, affect plaintiff's right to a preliminary injunction in a plain case.<sup>33</sup> Nor will a delay of several years, after knowledge of defendant's infringement, affect the right to a preliminary injunction, where his proceedings had been the subject of dispute and negotiation during the whole period.<sup>34</sup> And where it seems apparent that an injunction at the final hearing is inevitable, an injunction *pendente lite* will be granted, notwithstanding laches of the complainant in asserting his rights.<sup>35</sup>

(3) AS BAR TO ACCOUNTING FOR PROFITS. Mere delay in seeking relief against infringers is in general sufficient to preclude a patentee from the right to an account for past profits, although it may not prevent an injunction.<sup>36</sup> *A fortiori* where the infringers have acted in good faith, and there has been acquiescence and inexcusable laches on the part of the patentee, a decree for an accounting will not be granted.<sup>37</sup> It has been held, however, that there must be something more than mere lapse of time to bar an accounting.<sup>38</sup>

(B) *Excuses For Delay*—(1) IGNORANCE OF INFRINGEMENT. Long acquiescence and laches on the part of a patentee may be excused by satisfactory proof that he had no knowledge or means of knowledge that his patent was being infringed.<sup>39</sup> But a patentee cannot stand by with "easy indifference" when there are facts sufficient to put him on notice, and then plead ignorance as an excuse for his laches.<sup>40</sup> Where the complainant's suspicions of infringement are allayed by the direct misrepresentations of defendant, delay in applying for an injunction does not constitute laches.<sup>41</sup>

(2) OTHER EXCUSES. Delay in prosecuting other infringers while the validity of the patent is in active litigation does not constitute laches.<sup>42</sup> So delay in suing an infringer may be excused on the ground that the infringing article, as at first constructed by defendant, was not believed by complainant to be commercially harmful, the grounds for such belief being reasonable.<sup>43</sup> Nor is laches to be imputed to a patent owner because of his failure to prosecute to judgment a suit against an infringer after the latter has become totally insolvent,<sup>44</sup> or when it appears that the complainant was disabled from carrying on litigation by lack of

33. *Loring v. Booth*, 52 Fed. 150; *Collignon v. Hayes*, 8 Fed. 912.

34. *National Heeling-Mach. Co. v. Abbott*, 77 Fed. 462.

35. *Brush Electric Co. v. Electric Imp. Co.*, 45 Fed. 241.

36. *Price v. Joliet Steel Co.*, 46 Fed. 107; *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 18 Fed. 638, 21 Blatchf. 519.

Where a patent has been infringed by defendant for seven years, with the knowledge of the complainant, and without a word of protest, a decree for an accounting will not be granted. *Westinghouse Air Brake Co. v. New York Air Brake Co.*, 111 Fed. 741.

A delay of fourteen years in bringing suit, while the owner of the patent knew that defendant was continually engaged in infringing, is a bar to a decree for an accounting. *Covert v. Travers Bros. Co.*, 96 Fed. 568.

37. *Keller v. Stolzenbach*, 28 Fed. 81.

38. *American Street Car Advertising Co. v. Jones*, 122 Fed. 803 [*reversed* on other grounds in 142 Fed. 974, 74 C. C. A. 236].

39. *Wortendyke v. White*, 30 Fed. Cas. No. 18,050, 2 Ban. & A. 25.

40. *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 24 Fed. 604.

41. *Wortendyke v. White*, 30 Fed. Cas. No. 18,050, 2 Ban. & A. 25.

42. *Hutter v. Koscherak*, 137 Fed. 92; *U. S. Mitis Co. v. Detroit Steel, etc., Co.*, 122 Fed. 863, 59 C. C. A. 589 (six months after adjudication of validity); *Timolat v. Franklin Boiler Works Co.*, 122 Fed. 69, 58 C. C. A. 405; *Stearns-Roger Mfg. Co. v. Brown*, 114 Fed. 939, 52 C. C. A. 559; *New York Filter Mfg. Co. v. Jackson*, 91 Fed. 422; *New York Filter Mfg. Co. v. Loomis-Manning Filter Co.*, 91 Fed. 421; *Norton v. Eagle Automatic Can Co.*, 57 Fed. 929; *Jonathan Mills Mfg. Co. v. Whitehurst*, 56 Fed. 589; *American Bell Tel. Co. v. Southern Tel. Co.*, 34 Fed. 795; *Atlantic Giant-Powder Co. v. Rand*, 2 Fed. Cas. No. 626, 4 Ban. & A. 263, 16 Blatchf. 250, 16 Off. Gaz. 87; *Colgate v. Gold, etc., Tel. Co.*, 6 Fed. Cas. No. 2,991, 4 Ban. & A. 415, 16 Blatchf. 503, 16 Off. Gaz. 583; *Green v. French*, 10 Fed. Cas. No. 5,757, 4 Ban. & A. 169, 16 Off. Gaz. 215, 2 N. J. L. J. 148.

A patentee is not obliged to proceed against all infringers at the same time, and acquiescence will not be inferred from his neglect to do so. *McWilliams Mfg. Co. v. Blundell*, 11 Fed. 419.

43. *Accumulator Co. v. Edison Electric Illuminating Co.*, 63 Fed. 979.

44. *Huntington Dry-Pulverizer Co. v. Newell Universal Mill Co.*, 91 Fed. 661.



financial means.<sup>45</sup> It is no excuse for delay that his coöwners of the patent would not agree to prosecute infringers.<sup>46</sup>

(c) *Laches of Prior Owner.* The negligence or acquiescence of a former owner of a patent in an alleged infringement has, in equity, the same effect upon his assignee's rights as his own neglect or acquiescence.<sup>47</sup> Subsequent purchasers of a patent succeed only to the rights of their assignors and are chargeable with their laches in failing for a considerable time after knowledge of an infringement to take steps to stop it.<sup>48</sup>

7. PERSONS ENTITLED TO SUE AND PARTIES PLAINTIFF<sup>49</sup>—a. In General. A party interested as patentee, assignee, or grantee,<sup>50</sup> and any one holding the patent in

45. *Bradford v. Belknap Motor Co.*, 105 Fed. 63 [affirmed in 115 Fed. 711, 53 C. C. A. 293].

While a patent is in a court of bankruptcy, laches can be imputed to no one. *Kittle v. Hall*, 29 Fed. 508. It is not the duty of an assignee in bankruptcy to institute suits for the infringement of a patent owned by the bankrupt, and his failure to do so is not negligence. *Kittle v. Hall*, *supra*.

46. *Richardson v. D. M. Osborne, etc., Co.*, 93 Fed. 828, 36 C. C. A. 610 [affirming 82 Fed. 95].

47. *Woodmanse, etc., Mfg. Co. v. Williams*, 68 Fed. 489, 15 C. C. A. 520.

48. *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 24 Fed. 604; *Spring v. Domestic Sewing-Mach. Co.*, 22 Fed. Cas. No. 12,258, 4 Ban. & A. 427, 16 Off. Gaz. 721, 2 N. J. L. J. 274.

A party who purchases a patent which has for years been freely plundered by a multitude of trespassers does not answer the charge of laches by showing that he commenced immediately after he acquired title to bring the wrong-doers to account. *Kittle v. Hall*, 29 Fed. 508.

49. See, generally, PARTIES.

50. U. S. Rev. St. (1878) § 4919 [U. S. Comp. St. (1901) p. 3394].

Until he has parted with his legal title to the patent, the patentee may sue. *Philadelphia, etc., R. Co. v. Trimble*, 10 Wall. (U. S.) 367, 19 L. ed. 948; *Ormsby v. Connors*, 133 Fed. 548; *Freese v. Swartzchild*, 35 Fed. 141; *Still v. Reading*, 9 Fed. 40, 4 Woods 345; *Hussey v. Whitely*, 12 Fed. Cas. No. 6,950, 1 Bond 407, 2 Fish. Pat. Cas. 120; *Park v. Little*, 18 Fed. Cas. No. 10,715, 1 Robb Pat. Cas. 17, 3 Wash. 196; *Sanford v. Messer*, 21 Fed. Cas. No. 12,314, 5 Fish. Pat. Cas. 411, *Holmes* 149, 2 Off. Gaz. 470.

Owner necessary party.—The legal owner is a necessary party complainant. *Tilghman v. Proctor*, 125 U. S. 136, 8 S. Ct. 894, 31 L. ed. 664; *Yale Lock Mfg. Co. v. Sargent*, 117 U. S. 536, 6 S. Ct. 934, 29 L. ed. 954; *Milwaukee Carving Co. v. Brunswick-Balke Collender Co.*, 126 Fed. 171, 61 C. C. A. 175; *Owatonna Mfg. Co. v. Fargo*, 94 Fed. 519; *Gormully, etc., Mfg. Co. v. Stanley Cycle Mfg. Co.*, 90 Fed. 279; *Carpenter v. Eberhard Mfg. Co.*, 78 Fed. 127; *Dueber Watch-Case Mfg. Co. v. Fahys Watch-Case Co.*, 45 Fed. 697; *Herbert v. Adams*, 12 Fed. Cas. No. 6,394, 4 Mason 15, 1 Robb Pat. Cas. 505; *North v. Kershaw*, 18 Fed. Cas. No.

10,311, 4 Blatchf. 70; *Potter v. Wilson*, 19 Fed. Cas. No. 11,342, 2 Fish. Pat. Cas. 102.

Joinder.—All legal owners must join. *Tyler v. Tuel*, 6 Cranch (U. S.) 324, 3 L. ed. 237; *Postal Tel. Cable Co. v. Netter*, 102 Fed. 691; *Van Orden v. Nashville*, 67 Fed. 331; *Edgerton v. Breck*, 8 Fed. Cas. No. 4,279, 5 Ban. & A. 42; *Jordan v. Dobson*, 13 Fed. Cas. No. 7,519, 4 Fish. Pat. Cas. 232, 7 Phila. (Pa.) 533; *Knight v. Gavit*, 14 Fed. Cas. No. 7,884; *Stein v. Goddard*, 22 Fed. Cas. No. 13,353, 1 McAllister 82; *Valentine v. Marshal*, 28 Fed. Cas. No. 16,812a; *Whittemore v. Cutter*, 29 Fed. Cas. No. 17,600, 1 Gall. 429, 1 Robb Pat. Cas. 28. Compare *Sheehan v. Great Eastern R. Co.*, 16 Ch. D. 59, 50 L. J. Ch. 68, 43 L. T. Rep. N. S. 432, 29 Wkly. Rep. 69.

Disclaimer.—One who appears from record to be part-owner may disclaim ownership. *Graham v. Geneva Lake Crawford Mfg. Co.*, 11 Fed. 138.

Legal and equitable owners should join in equity suit. *Chisholm v. Johnson*, 106 Fed. 191; *Clement Mfg. Co. v. Upson, etc., Co.*, 40 Fed. 471; *Otis Bros. Mfg. Co. v. Crane Bros. Mfg. Co.*, 27 Fed. 550 [affirmed in 136 U. S. 646, 10 S. Ct. 1072, 34 L. ed. 553]; *Goodyear v. Allyn*, 10 Fed. Cas. No. 5,555, 6 Blatchf. 33, 3 Fish. Pat. Cas. 374; *Goodyear v. New Jersey Cent. R. Co.*, 10 Fed. Cas. No. 5,563, 1 Fish. Pat. Cas. 626, 2 Wall. Jr. 356; *Stimpson v. Rogers*, 23 Fed. Cas. No. 13,457, 4 Blatchf. 333.

An attorney in fact cannot bring suit. *Goldsmith v. American Paper Collar Co.*, 2 Fed. 239, 18 Blatchf. 82.

Selling agent cannot bring suit. *Adams v. North British R. Co.*, 29 L. T. Rep. N. S. 367.

Only those having interest in patent should be joined as plaintiffs. *Chisholm v. Johnson*, 106 Fed. 191.

Amendment.—Suit should not be dismissed for misjoinder but amendment permitted (*Tesla Electric Co. v. Scott*, 97 Fed. 588), or party dismissed from suit (*Edgerton v. Breck*, 8 Fed. Cas. No. 4,279, 5 Ban. & A. 42).

Technical defense as to legal ownership by complainant is not favored. *McMichael, etc., Mfg. Co. v. Ruth*, 128 Fed. 706, 63 C. C. A. 304 [reversing 123 Fed. 888]; *Kansas City Hay-Press Co. v. Devol*, 81 Fed. 726, 26 C. C. A. 578 [reversing 72 Fed. 717], 84 Fed. 463, 28 C. C. A. 464; *A. B. Dick Co. v. Henry*, 75 Fed. 388; *Kearney v. Lehigh Val-*



trust, including the executor or administrator, may bring suit for infringement in his own name.<sup>51</sup>

**b. Licenses**—(1) *IN SUITS AGAINST STRANGERS*. A licensee of a patent cannot bring a suit in his own name, either at law or in equity, for its infringement by a stranger.<sup>52</sup> An action at law for the benefit of an exclusive license must be brought in the name of the patentee alone.<sup>53</sup> A suit in equity may be

ley R. Co., 27 Fed. 699; *Graham v. McCormick*, 11 Fed. 859, 10 Biss. 39; *Graham v. Geneva Lake Crawford Mfg. Co.*, 11 Fed. 138.

**Patentee may sue for past infringement after assigning patent.** *Moore v. Marsh*, 7 Wall. (U. S.) 515, 19 L. ed. 37.

**That territorial assignee may sue without joining patentee** see *Waterman v. Mackenzie*, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923; *Wilson v. Rousseau*, 4 How. (U. S.) 646, 11 L. ed. 1141; *Russell v. Kendall*, 58 Fed. 381; *Canton Steel Roofing Co. v. Kanneberg*, 51 Fed. 599; *Bicknell v. Todd*, 3 Fed. Cas. No. 1,389, Fish. Pat. Rep. 452, 5 McLean 236; *Perry v. Corning*, 19 Fed. Cas. No. 11,004, 7 Blatchf. 195; *Washburn v. Gould*, 29 Fed. Cas. No. 17,214, 2 Robb Pat. Cas. 206, 3 Story 122.

**Assignee of entire interest may sue without joining patentee.** *Waterman v. Mackenzie*, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923; *Gayler v. Wilder*, 10 How. (U. S.) 477, 13 L. ed. 504; *Lincoln Ironworks v. W. H. McWhirter Co.*, 131 Fed. 880; *Newton v. Buck*, 72 Fed. 777 [reversed on other grounds in 77 Fed. 614, 23 C. C. A. 355]; *Rapp v. Kelling*, 41 Fed. 792; *Siebert Cylinder Oil-Cup Co. v. Beggs*, 32 Fed. 790; *Herman v. Herman*, 29 Fed. 92; *Nellis v. Pennock Mfg. Co.*, 13 Fed. 451; *Seibert Cylinder Oil-Cup Co. v. Phillips Lubricator Co.*, 10 Fed. 677; *Jenkins v. Greenwald*, 13 Fed. Cas. No. 7,270, 1 Bond 126, 2 Fish. Pat. Cas. 37; *Suydam v. Day*, 23 Fed. Cas. No. 13,654, 2 Blatchf. 20, Fish. Pat. Rep. 88.

**Assignee of part should join the patentee with him.** *Yates v. Great Western R. Co.*, 24 Grant Ch. (U. C.) 495.

**Conditions in the assignment do not necessarily take away the right of assignee to sue alone.** *Littlefield v. Perry*, 21 Wall. (U. S.) 205, 22 L. ed. 577; *Union Trust Co. v. Walker Electric Co.*, 122 Fed. 814; *Platt v. Fire-Extinguisher Mfg. Co.*, 59 Fed. 897, 8 C. C. A. 357; *Russell v. Kern*, 58 Fed. 382; *Pope Mfg. Co. v. Clark*, 46 Fed. 789; *Hobbie v. Smith*, 27 Fed. 656; *Frankfort Whisky Process Co. v. Pepper*, 26 Fed. 336.

**51. One holding legal title in trust may sue.** *Waterman v. Mackenzie*, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923; *Bryan v. Stevens*, 4 Fed. Cas. No. 2,066a; *Dibble v. Augur*, 7 Fed. Cas. No. 3,879, 7 Blatchf. 86; *Knight v. Gavit*, 14 Fed. Cas. No. 7,884.

**Executor or administrator may sue.**—*De La Vergne Refrigerating Mach. Co. v. Featherstone*, 147 U. S. 209, 13 S. Ct. 283, 37 L. ed. 138; *Illinois Cent. R. Co. v. Turrill*, 110 U. S. 301, 4 S. Ct. 5, 28 L. ed. 154; *Providence Rubber Co. v. Goodyear*, 9 Wall. (U. S.) 788, 19 L. ed. 566; *May v. Logan*

*County*, 30 Fed. 250; *Hodge v. North Missouri R. Co.*, 12 Fed. Cas. No. 6,561, 1 Dill. 104, 4 Fish. Pat. Cas. 161.

**Assignee of foreign administrator may sue, although no ancillary letters of administration taken out.** *Smith v. Mercer*, 22 Fed. Cas. No. 13,078, 5 Pa. L. J. 529.

**Heirs need not join administrator.** *Haarmann v. Lueders*, 109 Fed. 325; *Hodge v. North Missouri R. Co.*, 12 Fed. Cas. No. 6,561, 1 Dill. 104, 4 Fish. Pat. Cas. 161.

**Assignee of heirs.**—One having assignment from heirs after administrator discharged has title and may sue. *Winkler v. Studebaker Bros. Mfg. Co.*, 105 Fed. 190. *Cestui que trust* for profits need not be joined. *Goodyear v. Day*, 10 Fed. Cas. No. 5,566.

**Mortgagor may sue without joining mortgagee.** *Van Gelder v. Sowerby Bridge United Dist. Flour Soc.*, 44 Ch. D. 374, 59 L. J. Ch. 535, 63 L. T. Rep. N. S. 132, 38 Wkly. Rep. 625.

**52. Watertown v. Mackenzie**, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923; *Birdsell v. Shaliol*, 112 U. S. 485, 5 S. Ct. 244, 28 L. ed. 768; *Paper-Bag Mach. Cases*, 105 U. S. 766, 26 L. ed. 959; *Gayler v. Wilder*, 10 How. (U. S.) 477, 13 L. ed. 504; *Excelsior Wooden Pipe Co. v. Seattle*, 117 Fed. 140, 55 C. C. A. 156; *Bowers Hydraulic Dredging Co. v. Vare*, 112 Fed. 63; *New York Continental Jewell Filtration Co. v. Sullivan*, 111 Fed. 179; *Chauche v. Pare*, 75 Fed. 283, 21 C. C. A. 329; *Moore Mfg., etc., Co. v. Cronk Hanger Co.*, 69 Fed. 998; *Brush Electric Co. v. California Electric Light Co.*, 52 Fed. 945, 3 C. C. A. 368; *Rice v. Boss*, 46 Fed. 195; *Cottle v. Krementz*, 25 Fed. 494; *Bogart v. Hinds*, 25 Fed. 484; *Wilson v. Chickering*, 14 Fed. 917; *Gamewell Fire-Alarm Tel. Co. v. Brooklyn*, 14 Fed. 255; *Blanchard v. Eldridge*, 3 Fed. Cas. No. 1,510, 2 Robb Pat. Cas. 737, 1 Wall. Jr. 337; *Grover, etc., Sewing-Mach. Co. v. Sloat*, 11 Fed. Cas. No. 5,846, 2 Fish. Pat. Cas. 112; *Hill v. Whitcomb*, 12 Fed. Cas. No. 6,502, 1 Ban. & A. 34; *Holmes* 317, 5 Off. Gaz. 430; *Nelson v. McMann*, 17 Fed. Cas. No. 10,109, 4 Ban. & A. 203, 16 Blatchf. 139, 16 Off. Gaz. 761; *Potter v. Holland*, 19 Fed. Cas. No. 11,329, 4 Blatchf. 206, 1 Fish. Pat. Cas. 327; *Sanford v. Messer*, 21 Fed. Cas. No. 12,314, 5 Fish. Pat. Cas. 411; *Holmes* 149, 2 Off. Gaz. 470; *Suydam v. Day*, 23 Fed. Cas. No. 13,654, 2 Blatchf. 20, Fish. Pat. Rep. 88. *Compare* *Brammer v. Jones*, 4 Fed. Cas. No. 1,806, 2 Bond 100, 3 Fish. Pat. Cas. 340.

**53. Waterman v. Mackenzie**, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923; *Birdsell v. Shaliol*, 112 U. S. 485, 5 S. Ct. 244, 28 L. ed. 768; *Goodyear v. McBurney*, 10 Fed. Cas. No. 5,574, 3 Blatchf. 32; *Nelson v. McMann*,



brought by the patentee and the exclusive licensee together.<sup>54</sup> Indeed, an exclusive licensee may join the patentee with him as party complainant even against his will.<sup>55</sup> But a simple licensee has no such interest as to make him either a necessary or a proper party to an infringement suit.<sup>56</sup> Nor is a licensee whose license is not such as to amount to an assignment of the patent a necessary party complainant in such a suit.<sup>57</sup>

(II) *IN SUITS AGAINST PATENTEE*. Where, however, the patentee himself is the infringer, the licensee may, to prevent an absolute failure of justice, sue him in equity in his own name.<sup>58</sup>

**8. PERSONS LIABLE AND PARTIES DEFENDANT**<sup>59</sup>—**a. In Actions at Law.** The general principle of law is that all who participate in the infringement of a patent are liable in an action at law for damages which may have been sustained by the patentee by reason thereof.<sup>60</sup> If one joint owner of a patent for a machine uses or sells such patentee's machine without the authority of his coöwner as respects the right of the latter, he is liable to an action at law by such coöwner for an infringement of the patent.<sup>61</sup> The rule is, both on principle and authority, that servants and agents who make use of or sell for another a patented article are liable in an action at law to the patentee for damages sustained by him.<sup>62</sup> A

17 Fed. Cas. No. 10,109, 4 Ban. & A. 203, 16 Blatchf. 139, 16 Off. Gaz. 761.

54. *Waterman v. Mackenzie*, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923; *Birdsell v. Shaliol*, 112 U. S. 485, 5 S. Ct. 244, 28 L. ed. 768; *Paper Bag Mach. Cases*, 105 U. S. 766, 26 L. ed. 959; *Littlefield v. Perry*, 21 Wall. (U. S.) 205, 22 L. ed. 577; *Gayler v. Wilder*, 10 How. (U. S.) 477, 13 L. ed. 504; *Woolworth v. Wilson*, 4 How. (U. S.) 712, 11 L. ed. 1171; *Daimler Mfg. Co. v. Conklin*, 145 Fed. 955; *New York Continental Jewell Filtration Co. v. Sullivan*, 111 Fed. 179; *Sharples v. Moseley, etc., Mfg. Co.*, 75 Fed. 595; *Dorsey Revolving Harvester Rake Co. v. Bradley Mfg. Co.*, 7 Fed. Cas. No. 4,015, 1 Ban. & A. 330, 12 Blatchf. 202; *Goodyear v. McBurney*, 10 Fed. Cas. No. 5,574, 3 Blatchf. 32; *Nelson v. McMann*, 17 Fed. Cas. No. 10,109, 4 Ban. & A. 203, 16 Blatchf. 139, 16 Off. Gaz. 761.

When suit by patentee alone improper.—The owner of a patent who has granted an exclusive license thereunder for certain territory cannot, suing alone, recover profits made by an infringer which, but for the infringement, would have inured to the sole benefit of the licensee. *Bredin v. Solmson*, 145 Fed. 944.

55. *Excelsior Wooden Pipe Co. v. Seattle*, 117 Fed. 140, 55 C. C. A. 156; *Excelsior Wooden-Pipe Co. v. Allen*, 104 Fed. 553, 44 C. C. A. 30; *Brush Electric Co. v. California Electric Light Co.*, 52 Fed. 945, 3 C. C. A. 368; *Brush Electric Co. v. Electric Imp. Co.*, 49 Fed. 73; *Brush-Swan Electric Light Co. v. Thomson-Houston Electric Co.*, 48 Fed. 224.

Licensee and patentee necessary parties.—Where an exclusive license has been granted, the licensee and the patentee are both necessary parties to an infringement suit. *Bowers Hydraulic Dredging Co. v. Vare*, 112 Fed. 63; *Hammond v. Hunt*, 11 Fed. Cas. No. 6,003, 4 Ban. & A. 111.

56. *Blair v. Lippincott Glass Co.*, 52 Fed. 226.

57. *Gayler v. Wilder*, 10 How. (U. S.) 477, 13 L. ed. 504; *Shepherd v. Deitsch*, 138 Fed. 83 [reversed on other grounds in 146 Fed. 756, 77 C. C. A. 246]; *Peters v. Union Biscuit Co.*, 120 Fed. 672; *Union Switch, etc., Co. v. Johnson R. Signal Co.*, 52 Fed. 867 [reversed on other grounds in 55 Fed. 487, 5 C. C. A. 204]; *Nellis v. Pennock Mfg. Co.*, 13 Fed. 451; *Aultman v. Holley*, 2 Fed. Cas. No. 656, 11 Blatchf. 317, 6 Fish. Pat. Cas. 534, 5 Off. Gaz. 3; *Potter v. Wilson*, 19 Fed. Cas. No. 11,342, 2 Fish. Pat. Cas. 102.

58. *Waterman v. Mackenzie*, 138 U. S. 252, 11 S. Ct. 334, 34 L. ed. 923; *Littlefield v. Perry*, 21 Wall. (U. S.) 205, 22 L. ed. 577; *Smith v. Ridgely*, 103 Fed. 875, 43 C. C. A. 365; *Waterman v. Shipman*, 55 Fed. 982, 5 C. C. A. 371; *Adrian v. McCormick Harvesting Mach. Co.*, 55 Fed. 288 [affirmed in 56 Fed. 918, 6 C. C. A. 168].

59. See, generally, **PARTIES**.  
Liability of counties see 11 Cyc. 497.

Liability of municipal corporations see 28 Cyc. 49.

60. *Graham v. Earl*, 82 Fed. 737; *Cramer v. Fry*, 68 Fed. 201; *National Car-Brake Shoe Co. v. Terre Haute Car, etc., Co.*, 19 Fed. 514. See also *York, etc., R. Co. v. Winans*, 17 How. (U. S.) 30, 15 L. ed. 27. But see *United Nickel Co. v. Worthington*, 13 Fed. 392, where the court laid down the doctrine that only those persons can be held to damages who own or have some interest in the business of making, using, or selling the thing which is an infringement; such doctrine, however, being disapproved in *Graham v. Earl, supra*.

The fact that a postmaster who infringed a patent turned the moneys saved by its use over to the government does not affect his personal liability to such patentee for such infringement. *Campbell v. James*, 2 Fed. 338, 18 Blatchf. 92.

61. *Pitts v. Hall*, 19 Fed. Cas. No. 11,193, 3 Blatchf. 201.

62. *Cramer v. Fray*, 68 Fed. 201; *Bryce v.*



mere purchaser of infringing articles is not liable in an action at law as an infringer.<sup>63</sup> Whenever an agent of a corporation proceeding within the general scope of his powers and of the powers delegated to it by him infringes a patent, the corporation is liable to the patentee in an action at law for damages.<sup>64</sup> So too where a private corporation, as a principal, coöperates with another corporation in the infringement of a patent, it is directly responsible to the patentee in an action at law for the resulting damage.<sup>65</sup> As to whether an action at law may be maintained by a patentee against officers of a corporation which infringes his patent, there is a conflict of authority; some cases holding that such an action is not maintainable, even where such officers personally conducted the business which constituted the infringement,<sup>66</sup> while other cases hold that such officers, whenever they actually participate in the infringement, are liable.<sup>67</sup>

**b. In Suits in Equity**<sup>68</sup>—(1) *PERSONS LIABLE*—(A) *Private Corporations and Their Officers*. A private corporation is liable in a suit in equity to recover profits resulting from the infringement of a patent by one of its agents while proceeding within the scope of its powers.<sup>69</sup> A suit for an accounting cannot be maintained against an individual who is not alleged to have infringed the patent except in his official capacity as an officer of the corporation charged to have committed the infringement where it is not shown that the corporation is insolvent,<sup>70</sup> or that there is any other obstacle in the way of obtaining full relief against the corporation.<sup>71</sup> But one who in his capacity as officer of a private corporation actively participates in an infringement of a patent by it will be restrained by injunction.<sup>72</sup>

(B) *Officers of United States*. An officer of the United States is personally liable to be sued at law for his own infringement of a patent, notwithstanding all of his acts in relation thereto were performed under orders of the government; but a suit in equity will not lie as no injunction can be granted.<sup>73</sup>

Dorr, 4 Fed. Cas. No. 2,070, 3 McLean 582, 2 Robb Pat. Cas. 302. See also Morse v. Davis, 17 Fed. Cas. No. 9,855, 5 Blatchf. 40.

63. Blanchard's Gun-Stock Turning Factory v. Jacobs, 3 Fed. Cas. No. 1,520, 2 Blatchf. 69, Fish. Pat. Rep. 158.

64. Poppenhusen v. New York Gutta Percha Comb Co., 19 Fed. Cas. No. 11,283, 2 Fish. Pat. Cas. 62. See also York, etc., R. Co. v. Winans, 17 How. (U. S.) 30, 15 L. ed. 27.

65. York, etc., R. Co. v. Winans, 17 How. (U. S.) 30, 15 L. ed. 27.

66. United Nickel Co. v. Worthington, 13 Fed. 392.

Unless he has acted beyond the scope of his powers infringement by a corporation causes no right of action at law for damages against one of its officers individually. Cazier v. Mackie-Lovejoy Mfg. Co., 138 Fed. 654, 71 C. C. A. 104.

67. National Car-Brake Shoe Co. v. Terre Haute Car, etc., Co., 19 Fed. 514. See also Cahoone Barnett Mfg. Co. v. Rubber, etc., Harness Co., 45 Fed. 582.

68. Liability of counties see 11 Cyc. 497. Liability of municipal corporations see 23 Cyc. 49.

69. Elizabeth v. American Nicholson Pavement Co., 97 U. S. 126, 24 L. ed. 1000.

70. Glucose Sugar Refining Co. v. St. Louis Syrup, etc., Co., 135 Fed. 540; Hutter v. De Q. Bottle Stopper Co., 128 Fed. 283, 62 C. C. A. 652; Greene v. Buckley, 120 Fed.

955 [reversed on other grounds in 135 Fed. 520, 68 C. C. A. 70]; Loomis-Manning Filter Co. v. Manhattan Filter Co., 117 Fed. 325 [affirmed in 128 Fed. 1023]; Bowers v. Atlantic, etc., Co., 104 Fed. 887; Mergenthaler Linotype Co. v. Ridder, 65 Fed. 853; Howard v. St. Paul Plov-Works, 35 Fed. 743.

71. Loomis-Manning Filter Co. v. Manhattan Filter Co., 117 Fed. 325 [affirmed in 128 Fed. 1023]; Mergenthaler Linotype Co. v. Ridder, 65 Fed. 853.

72. Cahoone Barnett Mfg. Co. v. Rubber, etc., Harness Co., 45 Fed. 582; Iowa Barb Steel-Wire Co. v. Southern Barbed-Wire Co., 30 Fed. 123; American Cotton-Tie Supply Co. v. McCready, 1 Fed. Cas. No. 295, 4 Ban. & A. 588, 17 Blatchf. 291, 8 Reporter 811, 17 Off. Gaz. 565; Goodyear v. Phelps, 10 Fed. Cas. No. 5,581, 3 Blatchf. 91; Poppenhusen v. Falke, 19 Fed. Cas. No. 11,279, 4 Blatchf. 493, 2 Fish. Pat. Cas. 181. Officers of non-resident corporation, made defendants and served with process in a suit for infringement of a patent while acting for the corporation, may be restrained from such infringement, although the corporation is not a party, and is not within the jurisdiction of the court. Edison Electric Light Co. v. Packard Electric Co., 61 Fed. 1002.

73. Belknap v. Schild, 161 U. S. 10, 16 S. Ct. 443, 40 L. ed. 599; International Postal Supply Co. v. Bruce, 114 Fed. 509 [affirmed in 132 Fed. 1006, 65 C. C. A. 130 (affirmed in 194 U. S. 601, 24 S. Ct. 820, 48 L. ed. 1134)]; Head v. Porter, 48 Fed. 481; Fore-



(c) *Joint Owner of Patent.* A joint owner of a patent who uses an infringing device is liable in equity to his co-owner for the wrong done.<sup>74</sup>

(d) *Agents and Servants.* One who as agent for another person sells an article which is an infringement of a patent may be restrained by injunction,<sup>75</sup> even where he had no pecuniary interest in the sale;<sup>76</sup> but such an agent is not liable to be compelled to account to the patentee for the profits of the sale of the infringing article,<sup>77</sup> unless it appears that he was pecuniarily interested in the sale.<sup>78</sup> And the use by one as the agent of another person of a patented device does not render him liable to account for infringement of the patent.<sup>79</sup>

(e) *Joint and Several Liability.* All persons participating in the infringement of a patent are jointly<sup>80</sup> or severally<sup>81</sup> liable on a bill for such an infringement.

(ii) *PARTIES*—(A) *In General.* Officers of a private corporation are neither necessary nor proper parties defendant in a suit in equity against the corporation for the infringement of a patent, where they perform no act of infringement,<sup>82</sup> and were not pecuniarily interested therein;<sup>83</sup> but such officers, where they have personally infringed and are joint tort-feasors, may be made co-defendants with a corporation,<sup>84</sup> and may also, for injunctive purposes, be made co-defendants, where they have, in their capacity as officers of a corporation, actively participated in an infringement.<sup>85</sup> The owner of infringing machines and a lessee from him may

hand *v. Porter*, 15 Fed. 256. But see *James v. Campbell*, 104 U. S. 356, 26 L. ed. 786.

74. *Herring v. Gas Consumers' Assoc.*, 9 Fed. 556, 3 McCrary 206.

75. *Featherstone v. Ormonde Cycle Co.*, 53 Fed. 110; *Steiger v. Heidelberg*, 4 Fed. 455, 18 Blatchf. 426; *Buck v. Cobb*, 4 Fed. Cas. No. 2,079, *Brunn. Col. Cas.* 550; *Good-year v. Phelps*, 10 Fed. Cas. No. 5,581, 3 Blatchf. 91; *Maltby v. Bobo*, 16 Fed. Cas. No. 8,998, 2 Ban. & A. 459, 14 Blatchf. 53.

76. *Featherstone v. Ormonde Cycle Co.*, 53 Fed. 110; *Maltby v. Bobo*, 16 Fed. Cas. No. 8,998, 2 Ban. & A. 459, 14 Blatchf. 53.

77. *Featherstone v. Ormonde Cycle Co.*, 53 Fed. 110. See also *Young v. Foerster*, 37 Fed. 203.

78. *Steiger v. Heidelberg*, 4 Fed. 455, 18 Blatchf. 426.

79. *Emigh v. Chamberlain*, 8 Fed. Cas. No. 4,447, 1 Biss. 367, 2 Fish. Pat. Cas. 192. A workman, however, who uses an infringing article, his own property, is liable to be compelled to account to the patentee. *Wooster v. Marks*, 30 Fed. Cas. No. 18,038, 5 Ban. & A. 56, 17 Blatchf. 368, 9 Reporter 201.

80. *American Bell Tel. Co. v. Albright*, 32 Fed. 287; *Jennings v. Dolan*, 29 Fed. 861.

*Applications of rule.*—Where one defendant operates a planing machine and two others owned it, an injunction should properly issue against the three. *Woodworth v. Edwards*, 30 Fed. Cas. No. 18,014, 2 Robb Pat. Cas. 610, 3 Woodb. & M. 120. Where one who has contracted to erect a building lets a portion of the work to a subcontractor, and in the prosecution of their respective parts each infringes the patent rights of another, both are liable as joint infringers. *Jackson v. Nagle*, 47 Fed. 703.

Where there is a privity of connection between the different defendants with reference to the subject-matter of the action, they are jointly liable on a bill for infringing a patent. *Wells v. Jacques*, 29 Fed. Cas. No. 17,398, 1 Ban. & A. 60, 5 Off. Gaz. 364.

Although when it comes to an accounting, complainant must prove that a given defendant is liable to him in profits or damages, under risk of which the court may possibly order concerning costs, yet an injunction should go against all of the defendants participating in the infringement. *Standard Paint Co. v. Bird*, 65 Fed. 509 [reversed on other grounds in 68 Fed. 483, 15 C. C. A. 516]; *Starrett v. Athol Mach. Co.*, 14 Fed. 910.

*Defendants held not jointly liable.*—Contractors laid a pavement for a city which infringed the patent of one A, and the city paid them as much therefor as it would have paid to A had he done the work, thus realizing no profits from the infringement. It was held that in a suit in equity to recover profits against the city and the contractors, notwithstanding the latter answered jointly, the latter alone were responsible, although the former might have been enjoined before the completion of the work and would undoubtedly have been liable in an action for damages. *Elizabeth v. American Nicholson Pavement Co.*, 97 U. S. 126, 24 L. ed. 1000.

81. *Jennings v. Dolan*, 29 Fed. 861.

82. *Hutter v. De Q. Bottle Stopper Co.*, 128 Fed. 283, 62 C. C. A. 652.

83. *Matthews, etc., Mfg. Co. v. Trenton Lamp Co.*, 73 Fed. 212.

84. *Whiting Safety Catch Co. v. Western Wheeled Scraper Co.*, 148 Fed. 396; *Iowa Barb Steel-Wire Co. v. Southern Barbed-Wire Co.*, 30 Fed. 123.

On a complaint alleging that a corporation and its president have infringed plaintiff's patent, the joining of the president as co-defendant with the corporation is proper, although there is no specific allegation that he directed or participated in the infringement complained of. *Cleveland Forge, etc., Co. v. U. S. Rolling-Stock Co.*, 41 Fed. 476.

85. *Nichols v. Pearce*, 18 Fed. Cas. No. 10,246, 7 Blatchf. 5.



be joined as defendants in a suit for infringement.<sup>86</sup> And a corporation and an individual may be joined as defendants in a suit for infringement of a patent, where it is alleged that the individual defendant owns practically all the stock of the corporation and personally directs its affairs, and that they conspired together to commit the acts of infringement.<sup>87</sup> A party alleged to be encouraging the manufacture and sale by the other defendants of the infringing device and who was closely connected with the transactions complained of is a proper party to the bill.<sup>88</sup>

(b) *Receivers of Private Corporation.* A private corporation and its receiver may be joined as defendants in a bill for the infringement of a patent.<sup>89</sup>

(c) *Agents and Servants.* One who is pecuniarily interested in the manufacture of an infringing article and acts as agent for its sale may be joined with the manufacturer as a defendant in a suit for the infringement.<sup>90</sup>

e. *Addition or Substitution of Parties.* The ordinary rules apply as to the addition or substitution of parties.<sup>91</sup>

9. *JOINDER OF CAUSES OF ACTION.* A single suit may be brought for the infringement of several patents where the inventions covered by those patents are embodied in one infringing process, machine, manufacture, or composition of matter.<sup>92</sup> In the absence of such conjoint use, a single suit cannot be maintained.<sup>93</sup>

86. *Wells v. Jacques*, 29 Fed. Cas. No. 17,398, 1 Ban. & A. 60, 5 Off. Gaz. 364.

87. *Whiting Safety Catch Co. v. Western Wheeled Scraper Co.*, 148 Fed. 396.

88. *Simplex Electric Heating Co. v. Leonard*, 147 Fed. 744, 148 Fed. 1023.

89. *Union Switch, etc., Co. v. Philadelphia, etc., R. Co.*, 69 Fed. 833.

90. *Lattimore Mfg. Co. v. Jones*, 133 Fed. 550 [reversed on other grounds in 138 Fed. 62, 70 C. C. A. 558].

91. See cases cited *infra*, this note.

*Survivor.*—Upon the death of defendant cause of action survives against estate and the suit may be revived. *Griswold v. Hilton*, 87 Fed. 256; *Head v. Porter*, 70 Fed. 498; *Hohorst v. Howard*, 37 Fed. 97; *Kirk v. Du Bois*, 28 Fed. 460; *Smith v. Baker*, 22 Fed. Cas. No. 13,010, 1 Ban. & A. 117, 5 Off. Gaz. 496, 10 Phila. (Pa.) 221. *Contra*, *Draper v. Hudson*, 7 Fed. Cas. No. 4,069, 6 Fish. Pat. Cas. 327, *Holmes* 208, 3 Off. Gaz. 354.

Suit against administrator survives after finding of infringement and reference to master. *Atterbury v. Gill*, 2 Fed. Cas. No. 638, 3 Ban. & A. 174, 2 Flipp. 239, 13 Off. Gaz. 276.

*Substitution or joinder of assignee.*—Assignee after suit may be substituted by original bill in the nature of a supplemental bill (*Leadam v. Ringgold*, 140 Fed. 611; *Ross v. Ft. Wayne*, 63 Fed. 466, 11 C. C. A. 288); but assignee after suit not joined where no right to past damages (*New York Belting, etc., Co. v. New Jersey Car-Spring, etc., Co.*, 47 Fed. 504).

The owner of an equitable right or interest in a patent may be added as complainant upon request. *Patterson v. Stapler*, 7 Fed. 210.

*Intervention.*—The general rules as to intervention of parties apply. *Ring Refrigerator, etc., Co. v. St. Louis Ice Mfg., etc., Co.*, 67 Fed. 535; *Standard Oil Co. v. Southern Pac. Co.*, 54 Fed. 521, 4 C. C. A. 491; *Thomas-Huston Electric Co. v. Sperry Elec-*

*tric Co.*, 46 Fed. 75; *Curran v. St. Charles Car Co.*, 32 Fed. 835.

Addition of defendant by supplemental bill see *Parkhurst v. Kinsman*, 18 Fed. Cas. No. 10,758, 2 Blatchf. 72, Fish. Pat. Rep. 175, 8 N. Y. Leg. Obs. 73.

92. *Kansas City Hay-Press Co. v. Devol*, 81 Fed. 726, 26 C. C. A. 578; *Huber v. Myers Sanitary Depot*, 34 Fed. 752; *Deering v. Winona Harvester Works*, 24 Fed. 90; *Case v. Redfield*, 5 Fed. Cas. No. 2,494, 4 McLean 526, 2 Robb Pat. Cas. 741; *Gillespie v. Cummings*, 10 Fed. Cas. No. 5,434, 1 Ban. & A. 587, 3 Sawy. 259; *Nourse v. Allen*, 18 Fed. Cas. No. 10,367, 4 Blatchf. 376, 3 Fish. Pat. Cas. 63; *Richardson v. Noyes*, 20 Fed. Cas. No. 11,792, 2 Ban. & A. 398, 10 Off. Gaz. 507.

Where conjoint use is alleged, the bill is not multifarious. *Edison Phonograph Co. v. Victor Talking Mach. Co.*, 120 Fed. 305; *Continental Gin Co. v. F. H. Lummus Sons' Co.*, 110 Fed. 390; *Elliot, etc., Book-Type-writer Co. v. Fisher Typewriter Co.*, 109 Fed. 330.

*Allegation that the inventions are used in one machine* is a sufficient allegation of conjoint use. *Horman Patent Mfg. Co. v. Brooklyn City R. Co.*, 12 Fed. Cas. No. 6,703, 4 Ban. & A. 86, 15 Blatchf. 444, 7 Reporter 295.

*Proof of the conjoint use of several inventions but not all will sustain the suit.* *Chisholm v. Johnson*, 106 Fed. 191; *Kansas City Hay-Press Co. v. Devol*, 81 Fed. 726, 26 C. C. A. 578.

*Validity of patents and damages are determined separately for each.* *Consolidated Electric Light Co. v. Brush-Swan Electric Light Co.*, 20 Fed. 502.

In England, where suit is brought on numerous patents, plaintiff may be required to limit the number. *Saccharin Corp. v. Wild*, [1903] 1 Ch. 410, 72 L. J. Ch. 272, 88 L. T. Rep. N. S. 101; *Saccharin Corp. v. White*, 88 L. T. Rep. N. S. 850.

93. *Louden Mach. Co. v. Ward*, 96 Fed.



**10. SUIT ON SEPARATE CLAIMS OF ONE PATENT.** Suit may be maintained upon some of the claims of a patent and not others,<sup>94</sup> and it is not defeated by the invalidity of the others.<sup>95</sup>

**11. INJUNCTIONS<sup>96</sup>—a. In General.** Injunctions are granted to preserve property rights in patents upon the same principle that they are granted to preserve other property rights and the same general rules control.<sup>97</sup>

232; *Diamond Match Co. v. Ohio Match Co.*, 80 Fed. 117; *Rose v. Hirsh*, 77 Fed. 469, 23 C. C. A. 246 [*affirming* 71 Fed. 881]; *Union Switch, etc., Co. v. Philadelphia, etc., R. Co.*, 68 Fed. 913; *Griffith v. Segar*, 29 Fed. 707; *Shickle v. South St. Louis Foundry Co.*, 22 Fed. 105; *Consolidated Electric Light Co. v. Brush-Swan Electric Light Co.*, 20 Fed. 502; *Lilliendahl v. Detwiler*, 18 Fed. 176; *Barney v. Peck*, 16 Fed. 413; *Nellis v. Pennock Mfg. Co.*, 13 Fed. 451; *Hayes v. Dayton*, 8 Fed. 702, 18 Blatchf. 420.

94. U. S. Rev. St. (1878) § 4922 [U. S. Comp. St. (1901) p. 3396]; *Gordon v. Warder*, 150 U. S. 47, 14 S. Ct. 32, 37 L. ed. 992; *Russell v. Winchester Repeating Arms*, 97 Fed. 634; *Blake v. Smith*, 3 Fed. Cas. No. 1,502; *Cook v. Ernest*, 6 Fed. Cas. No. 3,155, 5 Fish. Pat. Cas. 396, 1 Woods 195, 2 Off. Gaz. 89; *McComb v. Brodie*, 15 Fed. Cas. No. 8,708, 5 Fish. Pat. Cas. 384, 1 Woods 153, 2 Off. Gaz. 117; *Moody v. Fiske*, 17 Fed. Cas. No. 9,745, 2 Mason 112, 1 Robb Pat. Cas. 312; *Wyeth v. Stone*, 30 Fed. Cas. No. 18,107, 2 Robb Pat. Cas. 23, 1 Story 273.

95. U. S. Rev. St. (1878) §§ 4917, 4922 [U. S. Comp. St. (1901) pp. 3393, 3396]; *Whitney v. Boston R. Co.*, 50 Fed. 72 [*reversed* on other grounds in 53 Fed. 913]; *Burdett v. Estey*, 4 Fed. Cas. No. 2,145, 4 Ban. & A. 7, 15 Blatchf. 349, 15 Off. Gaz. 877. See also *supra*, IX.

96. See, generally, INJUNCTIONS, 22 Cyc. 724.

97. *Westinghouse Air-Brake Co. v. Carpenter*, 32 Fed. 484; *Keyes v. Pueblo Smelting, etc., Co.*, 31 Fed. 560; *Brick v. Staten Island R. Co.*, 25 Fed. 553; *Merriam v. Smith*, 11 Fed. 588; *American Cotton-Tie Co. v. McCready*, 1 Fed. Cas. No. 295, 4 Ban. & A. 588, 17 Blatchf. 291, 8 Reporter 811, 17 Off. Gaz. 565; *Cook v. Ernest*, 6 Fed. Cas. No. 3,155, 5 Fish. Pat. Cas. 396, 1 Woods 195, 2 Off. Gaz. 89; *Sargent v. Larned*, 22 Fed. Cas. No. 12,364, 2 Curt. 340.

Even where a license contract is alleged an injunction may be granted.—*Busch v. Jones*, 184 U. S. 598, 22 S. Ct. 511, 46 L. ed. 707; *Hat-Sweat Mfg. Co. v. Porter*, 3 Fed. 745; *Brown v. Lapham*, 27 Fed. 77, 23 Blatchf. 475.

**Gambling device.**—Injunction will not be granted on patent covering gambling device. *Reliance Novelty Co. v. Dworzek*, 80 Fed. 902.

**Use in public contract.**—An infringer may be enjoined, although the device was used in a public contract which the patentee could not get. *Colgate v. International Ocean Tel. Co.*, 6 Fed. Cas. No. 2,993, 4 Ban. & A. 609, 17 Blatchf. 308, 9 Reporter 166, 17 Off. Gaz. 194.

**Use for government.**—No injunction against government officer using invention for government. *International Postal Supply Co. v. Bruce*, 114 Fed. 509 [*affirmed* in 132 Fed. 1006, 65 C. C. A. 130 (*affirmed* in 194 U. S. 601, 24 S. Ct. 820, 48 L. ed. 1134)].

A contributory infringer may be enjoined. *Thomson-Houston Electric Co. v. Ohio Brass Co.*, 80 Fed. 712, 26 C. C. A. 107.

A mere user may be enjoined (*Busch v. Jones*, 16 App. Cas. (D. C.) 23; *Bresnahan v. Tripp Giant Leveller Co.*, 72 Fed. 920, 19 C. C. A. 237; *Thompson v. American Bank-Note Co.*, 35 Fed. 203; *Tucker v. Burditt*, 24 Fed. Cas. No. 14,216, 4 Ban. & A. 569), but only in a clear case (*Jefferson Electric Light, etc., Co. v. Westinghouse Electric, etc., Co.*, 134 Fed. 392, 67 C. C. A. 189; *Westinghouse Air-Brake Co. v. Burton Stock-Car Co.*, 70 Fed. 619; *Howe v. Newton*, 12 Fed. Cas. No. 6,771, 2 Fish. Pat. Cas. 531; *Morris v. Lowell Mfg. Co.*, 17 Fed. Cas. No. 9,833, 3 Fish. Pat. Cas. 67).

Although the patentee has never used the invention himself an injunction may be granted. *Crown Cork, etc., Co. v. Aluminum Stopper Co.*, 108 Fed. 845, 48 C. C. A. 72; *Campbell Printing-Press Mfg. Co. v. Manhattan R. Co.*, 49 Fed. 930; *American Bell Tel. Co. v. Cushman Tel., etc., Co.*, 36 Fed. 488, 1 L. R. A. 799.

**Actual infringement** is not necessary to warrant an injunction.—An injunction may be granted if an intent to infringe is established. *Westinghouse Mach. Co. v. Press Pub. Co.*, 127 Fed. 822 [*reversed* on other grounds in 135 Fed. 767, 68 C. C. A. 469]; *National Meter Co. v. Thomson Meter Co.*, 106 Fed. 531; *Brill v. St. Louis Car Co.*, 80 Fed. 909; *Johnson R. Signal Co. v. Union Switch, etc., Co.*, 55 Fed. 487, 5 C. C. A. 204; *Sessions v. Gould*, 49 Fed. 855 [*affirmed* in 63 Fed. 1001, 11 C. C. A. 546]; *Butz Thermo-Electric Regulator Co. v. Jacobs Electric Co.*, 36 Fed. 191; *Poppenhusen v. New York Gutta Percha Comb Co.*, 19 Fed. Cas. No. 11,281, 4 Blatchf. 184, 2 Fish. Pat. Cas. 74; *Woodworth v. Stone*, 30 Fed. Cas. No. 18,021, 2 Robb Pat. Cas. 296, 3 Story 749; *Frearson v. Loe*, 9 Ch. D. 48, 27 Wkly. Rep. 183.

**Restraining complainant from bringing further suits.**—In a suit for infringement of a patent, a court of equity has the power upon petition of defendant to restrain complainant from bringing further suits against the purchasers or users of the patented article, and will do so when it appears that the suits are vexatious and oppressive. *National Cash-Register Co. v. Boston Cash Indicator, etc., Co.*, 41 Fed. 51; *Ide v. Ball Engine Co.*, 31 Fed. 901; *Allis v. Stowell*, 16 Fed. 783;



**b. Preliminary Injunction**—(1) *IN GENERAL*. A preliminary injunction is granted only in the discretion of the court<sup>98</sup> to prevent irreparable injury,<sup>99</sup> and the right to and necessity for the injunction must be clearly shown.<sup>1</sup> The court will not attempt to decide doubtful questions on motion for a preliminary injunction.<sup>2</sup> In case of doubt such injunction will not be granted,<sup>3</sup> especially where

*Motte v. Bennett*, 17 Fed. Cas. No. 9,884, 2 Fish. Pat. Cas. 642.

Where plaintiff is guilty of deception injunction will be refused. *Ironclad Mfg. Co. v. Sugar Loaf Dairy Co.*, 140 Fed. 108.

98. *American Nicholson Pavement Co. v. Elizabeth*, 1 Fed. Cas. No. 312, 4 Fish. Pat. Cas. 189, 18 Pittsb. Leg. J. (Pa.) 85; *Earth Closet Co. v. Fenner*, 8 Fed. Cas. No. 4,249, 5 Fish. Pat. Cas. 15; *Irwin v. Dane*, 13 Fed. Cas. No. 7,081, 2 Biss. 442, 4 Fish. Pat. Cas. 359; *Potter v. Whitney*, 19 Fed. Cas. No. 11,341, 3 Fish. Pat. Cas. 77, 1 Lowell 87; *Union Paper-Bag Mach. Co. v. Binney*, 24 Fed. Cas. No. 14,387, 5 Fish. Pat. Cas. 166.

The court has no discretion even after decision on appeal holding that the patent is valid and infringed. *In re Chicago Sugar Refining Co.*, 87 Fed. 750, 31 C. C. A. 221.

Even after hearing on the merits a temporary injunction may be granted. *Cimiotti Unhairing Co. v. American Fur Refining Co.*, 117 Fed. 623.

**Notice**.—May be granted without notice. *Yuengling v. Johnson*, 30 Fed. Cas. No. 18,195, 3 Ban. & A. 99, 1 Hughes 607.

99. Irreparable injury is the foundation for motion for injunction. *Bowers Dredging Co. v. New York Dredging Co.*, 77 Fed. 980; *Columbia Wire Co. v. Freeman Wire Co.*, 71 Fed. 302; *Norton v. Eagle Automatic Can Co.*, 57 Fed. 929; *New York Grape Sugar Co. v. American Grape Sugar Co.*, 10 Fed. 835, 20 Blatchf. 386; *Batten v. Silliman*, 2 Fed. Cas. No. 1,106, 3 Wall. Jr. 124; *Dorsey Revolving Harvester Rake Co. v. Bradley Mfg. Co.*, 7 Fed. Cas. No. 4,015, 1 Ban. & A. 330, 12 Blatchf. 202; *Morris v. Lowell Mfg. Co.*, 17 Fed. Cas. No. 9,833, 3 Fish. Pat. Cas. 67; *North v. Kershaw*, 18 Fed. Cas. No. 10,311, 4 Blatchf. 70; *Parker v. Sears*, 18 Fed. Cas. No. 10,748, 1 Fish. Pat. Cas. 93, 4 Pa. L. J. 443.

1. *International Tooth-Crown Co. v. Mills*, 22 Fed. 659; *Cooper v. Mattheys*, 6 Fed. Cas. No. 3,200, 5 Pa. L. J. 38; *Parker v. Sears*, 18 Fed. Cas. No. 10,748, 1 Fish. Pat. Cas. 93, 4 Pa. L. J. 443; *Sickels v. Youngs*, 22 Fed. Cas. No. 12,838, 3 Blatchf. 293.

2. *Thomson-Houston Electric Co. v. Exeter Co.*, 110 Fed. 986; *Sprague Electric R., etc., Co. v. Nassau Electric R. Co.*, 95 Fed. 821, 37 C. C. A. 286; *Welsbach Light Co. v. Apollo Incandescent Gaslight Co.*, 94 Fed. 1005.

3. *Bridson v. McAlpine*, 8 Beav. 229, 50 Eng. Reprint 90; *Bacon v. Spottiswoode*, 1 Beav. 382, 3 Jur. 476, 994, 17 Eng. Ch. 382, 48 Eng. Reprint 988, 4 Myl. & C. 433, 18 Eng. Ch. 433, 41 Eng. Reprint 167; *Collard v. Allsion*, 4 Myl. & C. 487, 18 Eng. Ch. 487, 41 Eng. Reprint 188; *Goodwin v. Fader*, 19 Can. L. T. Occ. Notes 364.

Refused where infringement doubtful see *Thomson-Houston Electric Co. v. Wagner Electric Mfg. Co.*, 130 Fed. 902; *Armat Moving Picture Co. v. Edison Mfg. Co.*, 125 Fed. 939, 60 C. C. A. 380; *Stearns-Roger Mfg. Co. v. Brown*, 114 Fed. 939, 52 C. C. A. 559; *National Folding-Box, etc., Co. v. Munson*, 99 Fed. 86; *National Folding-Box, etc., Co. v. Brown*, 98 Fed. 437; *Blakey v. National Mfg. Co.*, 95 Fed. 136, 37 C. C. A. 27; *Consolidated Fastener Co. v. American Fastener Co.*, 94 Fed. 523; *Whippary Co. v. United Indurated Fibre Co.*, 87 Fed. 215, 30 C. C. A. 615; *Menasha Pulley Co. v. Dodge*, 85 Fed. 971, 29 C. C. A. 508, 86 Fed. 904, 30 C. C. A. 455; *Société Anonyme, etc., v. Allen*, 84 Fed. 812; *American Pneumatic Tool Co. v. Bigelow Co.*, 77 Fed. 988, 23 C. C. A. 603; *Union Switch, etc., Co. v. Philadelphia, etc., R. Co.*, 75 Fed. 1004; *Western Tel. Constr. Co. v. Stromberg*, 66 Fed. 550; *George Ertel Co. v. Stahl*, 65 Fed. 519, 13 C. C. A. 31; *Brush Electric Co. v. Electric Storage Battery Co.*, 64 Fed. 775; *Hammond Buckle Co. v. Goodyear Rubber Co.*, 49 Fed. 274; *Standard Paint Co. v. Reynolds*, 43 Fed. 304; *American Fire Hose Mfg. Co. v. Cornelius Callahan Co.*, 41 Fed. 50; *Russell v. Hyde*, 39 Fed. 614; *Morss v. Knapp*, 39 Fed. 608; *Thompson v. Rand-Avery Supply Co.*, 38 Fed. 112; *Steam-Gauge, etc., Co. v. St. Louis R. Supplies Mfg. Co.*, 25 Fed. 491; *Gold, etc., Tel. Co. v. Commercial Tel. Co.*, 22 Fed. 838; *Zinsser v. Colledge*, 17 Fed. 538; *Allis v. Stowell*, 15 Fed. 242; *Hardy v. Marble*, 10 Fed. 752; *Cross v. Livermore*, 9 Fed. 607; *Steam-Gauge, etc., Co. v. Miller*, 8 Fed. 314; *Pullman v. Baltimore, etc., R. Co.*, 5 Fed. 72, 4 Hughes 236; *Blake v. Boissellier*, 3 Fed. Cas. No. 1,493a, 5 Ban. & A. 352, 16 Off. Gaz. 854; *Dodge v. Card*, 7 Fed. Cas. No. 3,951, 1 Bond 393, 2 Fish. Pat. Cas. 116; *Goodyear v. New Jersey Cent. R. Co.*, 10 Fed. Cas. No. 5,563, 1 Fish. Pat. Cas. 626, 2 Wall. Jr. 356; *Mowry v. Grand St., etc., Co.*, 17 Fed. Cas. No. 9,893, 10 Blatchf. 89, 5 Fish. Pat. Cas. 586; *Winans v. Eaton*, 30 Fed. Cas. No. 17,861, 1 Fish. Pat. Cas. 181; *Woodworth v. Hall*, 30 Fed. Cas. No. 18,016, 1 Woodb. & M. 248, 2 Robb Pat. Cas. 495.

**Validity and infringement** must be shown beyond doubt. *Brookfield v. Elmer Glassworks*, 132 Fed. 312; *Welsbach Light Co. v. Cosmopolitan Incandescent Gaslight Co.*, 100 Fed. 648; *Consolidated Fastener Co. v. American Fastener Co.*, 94 Fed. 523; *American Nicholson Pavement Co. v. Elizabeth*, 1 Fed. Cas. No. 312, 4 Fish. Pat. Cas. 189; *Parker v. Sears*, 18 Fed. Cas. No. 10,748, 1 Fish. Pat. Cas. 93.

Cases in which preliminary injunction refused see *National Phonograph Co. v. American Graphophone Co.*, 136 Fed. 231; *A. B.*



defendant is financially responsible.<sup>4</sup> It is ground to deny a preliminary injunction that there has been laches on the part of plaintiff;<sup>5</sup> that the alleged infringer has a later patent under which he is working;<sup>6</sup> or that the patent is about to

Dick Co. v. Roper, 126 Fed. 966; Westinghouse Air-Brake Co. v. Christensen Engineering Co., 121 Fed. 558; U. S. Gramophone Co. v. National Gramophone Co., 107 Fed. 129; Westinghouse Air-Brake Co. v. Christensen Engineering Co., 103 Fed. 491; Western Electric Co. v. Anthracite Tel. Co., 100 Fed. 301; Vermilya v. Erie R. Co., 89 Fed. 96; Société Anonyme v. Allen, 84 Fed. 812; Welsbach Light Co. v. Benedict, etc., Mfg. Co., 82 Fed. 747; Société Fabriques, etc. v. Franco-American Trading Co., 82 Fed. 439; Carter-Cruine Co. v. Watson, 69 Fed. 267; Dickerson v. Matheson, 57 Fed. 524, 6 C. C. A. 466; Johnson v. Aldrich, 40 Fed. 675; Amazeen Mach. Co. v. Knight, 39 Fed. 612; Western Union Tel. Co. v. Baltimore, etc., Tel. Co., 25 Fed. 30; Gold, etc., Tel. Co. v. Pearce, 19 Fed. 419; Tillinghast v. Hicks, 13 Fed. 388; Steam-Gauge, etc., Co. v. Miller, 11 Fed. 718; Toohy v. Harding, 1 Fed. 174, 4 Hughes 253; Andrews v. Spear, 1 Fed. Cas. No. 380, 3 Ban. & A. 82, 4 Dill. 472; Earth Closet Co. v. Fenner, 8 Fed. Cas. No. 4,249, 5 Fish. Pat. Cas. 15; Gear v. Holmes, 10 Fed. Cas. No. 5,292, 6 Fish. Pat. Cas. 595; Jones v. McMurray, 13 Fed. Cas. No. 7,479, 3 Ban. & A. 130, 2 Hughes 527, 13 Off. Gaz. 6; Jones v. Merrill, 13 Fed. Cas. No. 7,481, 8 Off. Gaz. 401; North v. Kershaw, 18 Fed. Cas. No. 10,311, 4 Blatchf. 70.

Cases in which preliminary injunction granted see Continental Wire Fence Co. v. Pendergast, 126 Fed. 381; Stearns-Roger Mfg. Co. v. Brown, 114 Fed. 939, 52 C. C. A. 559; National Folding-Box, etc., Co. v. Robertson, 99 Fed. 985; Welsbach Light Co. v. Rex Incandescent Light Co., 94 Fed. 1006; Welsbach Light Co. v. Rex Incandescent Light Co., 94 Fed. 1004; New York Filter Mfg. Co. v. Chemical Bldg. Co., 93 Fed. 827; Alaska Packers' Assoc. v. Pacific Steam Whaling Co., 93 Fed. 672; Electric Car Co. v. Nassau Electric R. Co., 89 Fed. 204; Peck, etc., Co. v. Fray, 88 Fed. 784; Westinghouse Air-Brake Co. v. Great Northern R. Co., 88 Fed. 258, 31 C. C. A. 525; United Indurated Fibre Co. v. Whippany Mfg. Co., 83 Fed. 485; Pacific Contracting Co. v. Union Paving, etc., Co., 80 Fed. 737; Thomson-Houston Electric Co. v. Ohio Brass Co., 78 Fed. 139; Allington, etc., Mfg. Co. v. Booth, 72 Fed. 772 [affirmed in 78 Fed. 878, 24 C. C. A. 378]; Columbia Wire Co. v. Freeman Wire Co., 71 Fed. 302; Corser v. Brattleboro Overall Co., 59 Fed. 781; Carter v. Wollschlaeger, 53 Fed. 573; New York Grape Sugar Co. v. American Grape Sugar Co., 10 Fed. 835, 20 Blatchf. 386; White v. Heath, 10 Fed. 291; Plimpton v. Winslow, 3 Fed. 333; Aiken v. Dolan, 1 Fed. Cas. No. 110, 3 Fish. Pat. Cas. 197; Clum v. Brewer, 5 Fed. Cas. No. 2,909, 2 Curt. 506; Colt v. Young, 6 Fed. Cas. No. 3,032, 2 Blatchf. 471; Irwin v. Dane, 13 Fed. Cas. No. 7,081, 2 Biss. 442, 4 Fish. Pat. Cas. 359; Miller v. Androscoggin Pulp Co., 17

Fed. Cas. No. 9,559, 5 Fish. Pat. Cas. 340, Holmes 142, 1 Off. Gaz. 409; Parker v. Sears, 18 Fed. Cas. No. 10,748, 1 Fish. Pat. Cas. 93; Pentlarge v. Beeston, 19 Fed. Cas. No. 10,963, 3 Ban. & A. 142, 14 Blatchf. 352; Potter v. Fuller, 19 Fed. Cas. No. 11,327, 2 Fish. Pat. Cas. 251; Sanders v. Logan, 21 Fed. Cas. No. 12,295, 2 Fish. Pat. Cas. 167, 2 Pittsb. (Pa.) 241; Sickels v. Mitchell, 22 Fed. Cas. No. 12,835, 3 Blatchf. 548.

4. Thomson-Houston Electric Co. v. Wagner Electric Mfg. Co., 130 Fed. 902; Diamond Match Co. v. Union Match Co., 129 Fed. 602; Hallock v. Babcock Mfg. Co., 124 Fed. 226; Bradley v. Eccles, 120 Fed. 947; Seoville Mfg. Co. v. Patent Button Co., 99 Fed. 743; Huntington Dry-Pulverizer Co. v. Alpha Portland Cement Co., 91 Fed. 534; Overweight Counterbalance Elevator Co. v. Cahill, etc., Elevator Co., 86 Fed. 338; Nilsen v. Jefferson, 78 Fed. 366; George Ertel Co. v. Stahl, 65 Fed. 519, 13 C. C. A. 31; Rogers Typographic Co. v. Mergenthaler Linotype Co., 58 Fed. 693; Standard Elevator Co. v. Crane Elevator Co., 56 Fed. 718, 6 C. C. A. 100; Williams v. McNeely, 56 Fed. 265; Ironclad Mfg. Co. v. Jacob J. Vollrath Mfg. Co., 52 Fed. 143; Dietz Co. v. C. T. Ham Mfg. Co., 47 Fed. 320; Southwestern Brush Electric Light, etc., Co. v. Louisiana Electric Light Co., 45 Fed. 893; Kane v. Huggins Cracker, etc., Co., 44 Fed. 287; Consolidated Roller-Mill Co. v. Richmond City Mill-Works, 40 Fed. 474; Hurlburt v. Carter, 39 Fed. 802; National Hat-Pouncing Mach. Co. v. Hedden, 29 Fed. 147; United Nickel Co. v. New Home Sewing Mach. Co., 17 Fed. 528, 21 Blatchf. 415; Hoe v. Boston Daily Advertising Corp., 14 Fed. 914; New York Grape Sugar Co. v. American Grape Sugar Co., 10 Fed. 835, 20 Blatchf. 386; Pullman v. Baltimore, etc., R. Co., 5 Fed. 72, 4 Hughes 236; Essex Hosiery Mfg. Co. v. Door Mfg. Co., 8 Fed. Cas. No. 4,533; Guidet v. Palmer, 11 Fed. Cas. No. 5,859, 10 Blatchf. 217, 6 Fish. Pat. Cas. 82; McGuire v. Eames, 16 Fed. Cas. No. 8,814, 3 Ban. & A. 499, 15 Blatchf. 312; Morris v. Lowell Mfg. Co., 17 Fed. Cas. No. 9,833, 3 Fish. Pat. Cas. 67.

5. Ladd v. Cameron, 25 Fed. 37; Hall v. Speer, 11 Fed. Cas. No. 5,947, 1 Pittsb. (Pa.) 513. See *supra*, XIII, C, 6, d.

6. American Nicholson Pavement Co. v. Elizabeth, 1 Fed. Cas. No. 312, 4 Fish. Pat. Cas. 189; American Shoe-Tip Co. v. National Shoe-Toe Protector Co., 1 Fed. Cas. No. 317, 2 Ban. & A. 551, 11 Off. Gaz. 740; Congress Rubber Co. v. American Elastic Cloth Co., 6 Fed. Cas. No. 3,099a; Goodyear v. Dunbar, 10 Fed. Cas. No. 5,570, 1 Fish. Pat. Cas. 472, 3 Wall. Jr. 310; Mitchell v. Barclay, 17 Fed. Cas. No. 9,659; Sargent v. Carter, 21 Fed. Cas. No. 12,362, 1 Fish. Pat. Cas. 277; Sargent Mfg. Co. v. Woodruff, 21 Fed. Cas. No. 12,368, 5 Biss. 444. Compare Jones v. Merrill, 13 Fed. Cas. No. 7,481, 8 Off. Gaz.



expire.<sup>7</sup> And an injunction may be refused where the granting thereof would work great injury to defendant and its refusal would injure plaintiff in a much less degree.<sup>8</sup> It is not a ground to deny an injunction that defendant has discontinued infringement and promised not to renew it.<sup>9</sup> An injunction will not be refused because of mere inconvenience to the public or to defendant,<sup>10</sup> but where the granting thereof would injure the public and defendant gives security it may be refused.<sup>11</sup> It is not a ground for denying an injunction that it may be used for advertising purposes to injure defendant.<sup>12</sup>

(II) *ISSUANCE AND VALIDITY OF PATENT.* No injunction can be granted before issuance of a patent,<sup>13</sup> and the fact that the complainant owns a patent and the defendant infringes it will not ordinarily justify a preliminary injunction.<sup>14</sup>

401; *Morse Fountain-Pen Co. v. Esterbrook Steel-Pen Mfg. Co.*, 17 Fed. Cas. No. 9,862, 3 Fish. Pat. Cas. 515; *Wilson v. Barnum*, 30 Fed. Cas. No. 17,787, 2 Fish. Pat. Cas. 635, 2 Robb Pat. Cas. 749, 1 Wall. Jr. 347.

**Reason for rule.**—The grant of letters patent to him is virtually a decision by the patent office that there is a substantial difference between the inventions, and, while the presumption may be overcome, it is not to be disregarded on a motion for preliminary injunction. *American Nicholson Pavement Co. v. Elizabeth*, 1 Fed. Cas. No. 312, 4 Fish. Pat. Cas. 189.

7. *Keyes v. Eureka Consol. Min. Co.*, 158 U. S. 150, 15 S. Ct. 772, 39 L. ed. 929; *Parker v. Sears*, 18 Fed. Cas. No. 10,748, 1 Fish. Pat. Cas. 93. *Contra*, *Westinghouse Air-Brake Co. v. Carpenter*, 32 Fed. 484; *Rumford Chemical Works v. Vice*, 20 Fed. Cas. No. 12,136, 2 Ban. & A. 584, 14 Blatchf. 179, 11 Off. Gaz. 600. See also *supra*, XIII, C, 2, c.

**After expiration of patent the sale of articles made before such expiration may be enjoined.** *New York Belting, etc., Co. v. Magowan*, 27 Fed. 111.

8. *Bowers Dredging Co. v. New York Dredging Co.*, 77 Fed. 980; *Root v. Mt. Adams, etc., R. Co.*, 40 Fed. 760; *Day v. Candee*, 7 Fed. Cas. No. 3,676, 3 Fish. Pat. Cas. 9; *Hockholzer v. Eager*, 12 Fed. Cas. No. 6,556, 2 Sawy. 361; *Morris v. Lowell Mfg. Co.*, 17 Fed. Cas. No. 9,833, 3 Fish. Pat. Cas. 67; *Potter v. Whitney*, 19 Fed. Cas. No. 11,341, 3 Fish. Pat. Cas. 77, 1 Lowell 87.

**Limitation of rule.**—An injunction will not be refused for hardship on defendant where the infringement is wilful (*Thomson-Houston Electric Co. v. Jeffrey Mfg. Co.*, 144 Fed. 130; *United Indurated Fibre Co. v. Whippary Mfg. Co.*, 83 Fed. 485; *Norton v. Eagle Automatic Can Co.*, 57 Fed. 929), or where the validity of the patent is fully established and its infringement clear (*Hodge v. Hudson River R. Co.*, 12 Fed. Cas. No. 6,560, 6 Blatchf. 165).

9. *Johnson v. Foos Mfg. Co.*, 141 Fed. 73, 72 C. C. A. 105; *General Electric Co. v. Bullock Electric Mfg. Co.*, 138 Fed. 412; *Brookfield v. Elmer Glassworks*, 132 Fed. 312; *Consolidated Fastener Co. v. Toppen*, 113 Fed. 697; *New York Filter Mfg. Co. v. Chemical Bldg. Co.*, 93 Fed. 827; *Braddock Glass Co. v. Mac-*

*beth*, 64 Fed. 118, 12 C. C. A. 70; *New York Belting, etc., Co. v. Gutta Percha, etc., Mfg. Co.*, 56 Fed. 264; *Sawyer Spindle Co. v. Turner*, 55 Fed. 979; *Celluloid Mfg. Co. v. Arlington Mfg. Co.*, 34 Fed. 324; *Goodyear v. Berry*, 10 Fed. Cas. No. 5,556, 2 Bond 189, 3 Fish. Pat. Cas. 439; *Jenkins v. Greenwald*, 13 Fed. Cas. No. 7,270, 1 Bond 126, 2 Fish. Pat. Cas. 37; *Potter v. Crowwell*, 19 Fed. Cas. No. 11,323, 1 Abb. 89, 3 Fish. Pat. Cas. 112; *Rumford Chemical Works v. Vice*, 20 Fed. Cas. No. 12,136, 2 Ban. & A. 584, 14 Blatchf. 179, 11 Off. Gaz. 600; *Sickels v. Mitchell*, 22 Fed. Cas. No. 12,835, 3 Blatchf. 548; *Geary v. Norton*, 1 De G. & Sm. 9, 63 Eng. Reprint 949. *Contra*, *General Electric Co. v. Pittsburg-Buffalo Co.*, 144 Fed. 439; *Silver v. J. P. Eustis Mfg. Co.*, 130 Fed. 348; *General Electric Co. v. New England Electric Mfg. Co.*, 123 Fed. 310; *Edison Gen. Electric Co. v. New England Electric Mfg. Co.*, 121 Fed. 125; *National Cash-Register Co. v. Boston Cash Indicator, etc., Co.*, 41 Fed. 144; *Brammer v. Jones*, 4 Fed. Cas. No. 1,806, 2 Bond 100, 3 Fish. Pat. Cas. 340.

10. *Lanyon Zinc Co. v. Brown*, 115 Fed. 150, 53 C. C. A. 354; *Pelzer v. Binghamton*, 95 Fed. 823, 37 C. C. A. 288; *Poughkeepsie v. National Meter Co.*, 89 Fed. 1014, 32 C. C. A. 463; *Westinghouse Air-Brake Co. v. Great Northern R. Co.*, 86 Fed. 132; *New York Filter Mfg. Co. v. Niagara Falls Waterworks Co.*, 80 Fed. 924, 26 C. C. A. 252; *Thomson-Houston Electric Co. v. Union R. Co.*, 78 Fed. 365; *National Meter Co. v. Poughkeepsie*, 75 Fed. 405; *Goodyear v. New Jersey Cent. R. Co.*, 10 Fed. Cas. No. 5,563, 1 Fish. Pat. Cas. 626, 2 Wall. Jr. 356; *Sickels v. Tileston*, 22 Fed. Cas. No. 12,837, 4 Blatchf. 109.

11. *American Ordnance Co. v. Driggs-Seabury Co.*, 87 Fed. 947; *Campbell Printing-Press, etc., Co. v. Manhattan R. Co.*, 47 Fed. 663; *Southwestern Brush Electric Light, etc., Co. v. Louisiana Electric Light Co.*, 45 Fed. 893; *Guidet v. Palmer*, 11 Fed. Cas. No. 5,859, 10 Blatchf. 217, 6 Fish. Pat. Cas. 82.

12. *New York Belting, etc., Co. v. Gutta Percha, etc., Mfg. Co.*, 56 Fed. 264.

13. *Gayler v. Wilder*, 10 How. (U. S.) 477, 13 L. ed. 504; *Standard Scale, etc., Co. v. McDonald*, 127 Fed. 709; *Hoeltge v. Hoeller*, 12 Fed. Cas. No. 6,574, 2 Bond 386.

14. *Société Anonyme, etc. v. Allen*, 84 Fed. 812; *Palmer Pneumatic Tire Co. v. Newton*



The validity of the patent must be made to clearly appear and the injunction will be refused where its validity is doubtful.<sup>15</sup> Ordinarily, where the validity of the patent has neither been adjudicated nor acquiesced in by the public, an injunction will be refused,<sup>16</sup> although there are some limitations of the rule.<sup>17</sup>

Rubber Works, 73 Fed. 218; Grover, etc., Sewing-Mach. Co. v. Williams, 11 Fed. Cas. No. 5,847, 2 Fish. Pat. Cas. 133; Mitchell v. Barclay, 17 Fed. Cas. No. 9,650; Orr v. Littlefield, 18 Fed. Cas. No. 10,590, 2 Robb Pat. Cas. 323, 1 Woodb. & M. 13.

15. *Aquarama Co. v. Old Mill Co.*, 115 Fed. 806, 53 C. C. A. 376; *Welsbach Light Co. v. Cosmopolitan Incandescent Light Co.*, 104 Fed. 83, 43 C. C. A. 418; *Hatch Storage Battery Co. v. Electric Storage Battery Co.*, 100 Fed. 975; *Welsbach Light Co. v. Cosmopolitan Incandescent Gaslight Co.*, 100 Fed. 648; *Duff Mfg. Co. v. Kalamazoo Railway-Supply Co.*, 100 Fed. 357; *Overhead R., etc., Co. v. Hiller*, 98 Fed. 620; *Welsbach Light Co. v. Rex Incandescent Light Co.*, 94 Fed. 1005; *Bowers Dredging Co. v. New York Dredging Co.*, 77 Fed. 980; *New York Paper-Bag Mach., etc., Co. v. Western Paper-Bag Co.*, 75 Fed. 395; *George Ertel Co. v. Stahl*, 65 Fed. 519, 13 C. C. A. 31; *Mack v. Spencer*, 44 Fed. 346; *Standard Paint Co. v. Reynold*, 43 Fed. 304; *Glaenzer v. Wiederer*, 33 Fed. 583; *Huber v. Myers Sanitary Depot*, 33 Fed. 48; *Baldwin v. Conway*, 32 Fed. 795; *Canfield Rubber Co. v. Gross*, 32 Fed. 226; *Osborn v. Judd*, 29 Fed. 96; *Consolidated Safety-Valve Co. v. Ashton Valve Co.*, 26 Fed. 319; *Bradley Mfg. Co. v. Charles Parker Co.*, 17 Fed. 240; *Brewster v. Parry*, 14 Fed. 694; *Illingworth v. Spaulding*, 9 Fed. 154; *Consolidated Safety-Valve Co. v. Crosby Steam-Gauge, etc., Co.*, 7 Fed. 768; *White v. S. Harris, etc., Mfg. Co.*, 3 Fed. 161; *American Shoe-Tip Co. v. National Shoe-Toe Protector Co.*, 1 Fed. Cas. No. 317, 2 Ban. & A. 551, 11 Off. Gaz. 740; *Isaacs v. Cooper*, 13 Fed. Cas. No. 7,096, 1 Robb Pat. Cas. 332, 4 Wash. 259; *Jones v. Hodges*, 13 Fed. Cas. No. 7,469, *Holmes* 37; *McGuire v. Eames*, 16 Fed. Cas. No. 8,814, 3 Ban. & A. 499, 15 Blatchf. 312; *Mannie v. Everett*, 16 Fed. Cas. No. 9,039; *Poppenhuisen v. Falke*, 19 Fed. Cas. No. 11,279, 4 Blatchf. 493, 2 Fish. Pat. Cas. 181; *Sullivan v. Redfield*, 23 Fed. Cas. No. 13,597, 1 Paine 441, 1 Robb Pat. Cas. 477; *Wilson Packing Co. v. Clapp*, 30 Fed. Cas. No. 17,850, 3 Ban. & A. 243, 8 Biss. 154, 13 Off. Gaz. 368; *Winans v. Eaton*, 30 Fed. Cas. No. 17,861, 1 Fish. Pat. Cas. 181; *Sugg v. Silber*, 2 Q. B. D. 493; *Davenport v. Rylands*, L. R. 1 Eq. 302, 12 Jur. N. S. 71, 35 L. J. Ch. 204, 14 L. T. Rep. N. S. 53, 14 Wkly. Rep. 243; *Hill v. Evans*, 4 De G. F. & J. 288, 8 Jur. N. S. 525, 31 L. J. Ch. 457, 1 L. T. Rep. N. S. 90, 65 Eng. Ch. 223, 45 Eng. Reprint 1195; *Foxwell v. Webster*, 4 De G. J. & S. 77, 10 Jur. N. S. 137, 9 L. T. Rep. N. S. 528, 12 Wkly. Rep. 186, 69 Eng. Ch. 60, 46 Eng. Ch. 60, 46 Eng. Reprint 844; *Curtis v. Cutts*, 3 Jur. 34, 8 L. J. Ch. 184; *Davenport v. Jepson*, 1 New Rep. 173.

16. *Sharp v. Bellinger*, 155 Fed. 139; *Earll v. Rochester, etc., R. Co.*, 157 Fed. 241; *Hall Signal Co. v. General R. Signal Co.*, 153 Fed. 907, 82 C. C. A. 653; *Karfiol v. Rothner*, 151 Fed. 777; *Bristol Oil, etc., Co. v. Beacon*, 143 Fed. 550; *Alphons Custodis Chimney Const. Co. v. H. R. Heinicke*, 135 Fed. 552; *Silver v. J. P. Eustis Mfg. Co.*, 130 Fed. 348; *Newhall v. McCabe Hanger Mfg. Co.*, 125 Fed. 919, 60 C. C. A. 629; *Pennsylvania Globe Gaslight Co. v. American Lighting Co.*, 117 Fed. 324; *Reed Mfg. Co. v. Smith, etc., Co.*, 107 Fed. 719, 46 C. C. A. 601; *Planters' Compress Co. v. Moore, etc., Co.*, 106 Fed. 500; *American Sulphite Pulp Co. v. Burgess Sulphate Fibre Co.*, 103 Fed. 975; *Smith v. Meriden Britannia Co.*, 97 Fed. 987, 39 C. C. A. 32 [*affirming* 92 Fed. 1003]; *Elliott v. Harris*, 92 Fed. 374; *Richmond Mica Co. v. De Clyne*, 90 Fed. 661; *Wilson v. Consolidated Store-Service Co.*, 88 Fed. 286, 31 C. C. A. 533; *Williams v. Breitling Metal-Ware Mfg. Co.*, 77 Fed. 285, 23 C. C. A. 171; *Johnson v. Aldrich*, 40 Fed. 675; *Raymond v. Boston Woven Hose Co.*, 39 Fed. 365; *Dickerson v. De la Vergne Refrigerating Mach. Co.*, 35 Fed. 143; *Edward Barr Co. v. New York, etc., Automatic Sprinkler Co.*, 32 Fed. 79, 24 Blatchf. 566; *Johnson Ruffler Co. v. Avery Mach. Co.*, 28 Fed. 193; *Fish v. Domestic Sewing Mach. Co.*, 12 Fed. 495; *Kirby Bung Mfg. Co. v. White*, 1 Fed. 604, 1 McCrary 155; *Doughty v. West*, 7 Fed. Cas. No. 4,029, 2 Fish. Pat. Cas. 553; *Earth Closet Co. v. Fenner*, 8 Fed. Cas. No. 4,249, 5 Fish. Pat. Cas. 15; *Jones v. Field*, 13 Fed. Cas. No. 7,461, 2 Ban. & A. 39, 12 Blatchf. 494; *Noe v. Prentice*, 18 Fed. Cas. No. 10,284; *North v. Kershaw*, 18 Fed. Cas. No. 10,311, 4 Blatchf. 70; *Stevens v. Felt*, 23 Fed. Cas. No. 13,397.

17. *Limitations of rule.*—The rule, it has been said, applies only when there is some question as to the validity of the patents. *Fuller v. Gilmore*, 121 Fed. 129; *Foster v. Crossin*, 23 Fed. 400. It does not apply where the invention is both new and useful and there is no evidence assailing the validity of the patent (*Fuller v. Gilmore, supra*; *Wilson v. Consolidated Store-Service Co.*, 88 Fed. 286, 31 C. C. A. 533; *Hussey Mfg. Co. v. Deering*, 20 Fed. 795); where defendant has for three years been making and selling the patented article under a license subsequently terminated, and since the termination of the license has been marking the articles sold by him as made under the patent (*Adam v. Folger*, 120 Fed. 260, 56 C. C. A. 540); where it clearly appears that the patent has been intentionally infringed under a patent procured for that purpose (*Plimpton v. Winslow*, 3 Fed. 333); or where there is no prior patent or publication submitted, nor any statement as to the prior state of



(iii) *PUBLIC ACQUIESCENCE IN VALIDITY.* A long continued and public acquiescence in the claims of the patentee may justify the acceptance of the patent as valid for the purpose of a preliminary injunction<sup>18</sup> without an adjudication of validity.<sup>19</sup> What constitutes acquiescence depends on the facts of each particular case.<sup>20</sup>

(iv) *PREVIOUS ADJUDICATIONS*<sup>21</sup>—(A) *As a Prerequisite to the Allowance of Injunctions.* A prior adjudication at law sustaining the patent is not an absolute prerequisite to an injunction,<sup>22</sup> although the court in its discretion may require it.<sup>23</sup> While the right should be clear, it may be made to appear otherwise than by a judgment or decree.<sup>24</sup> A preliminary injunction may be granted without

the art, the presumption induced by the granting of the patent being sufficient to warrant the issuing of an injunction (*Seidenberg v. Davidson*, 112 Fed. 431). Suit on the facts appearing defendant may be estopped to deny the validity of the patent. *Burr v. Kimbark*, 28 Fed. 574; *Onderdonk v. Fanning*, 4 Fed. 148; *American Shoe-Tip Co. v. National Shoe-Tip Protector Co.*, 1 Fed. Cas. No. 317, 2 Ban. & A. 551, 11 Off. Gaz. 740.

18. *Westinghouse Electric, etc., Co. v. Stanley Instrument Co.*, 133 Fed. 167, 63 C. C. A. 523; *Smith v. Meriden Britannia Co.*, 97 Fed. 987, 39 C. C. A. 32; *Peck, etc., Co. v. Fray*, 88 Fed. 784; *Columbia Wire Co. v. Freeman Wire Co.*, 71 Fed. 302; *Kennedy v. Penn Iron, etc., Co.*, 67 Fed. 339; *Corser v. Brattleboro Overall Co.*, 59 Fed. 781; *Blount v. Societe Anonyme, etc.*, 53 Fed. 98, 3 C. C. A. 455; *Sessions v. Gould*, 49 Fed. 855; *McWilliams Mfg. Co. v. Blundell*, 11 Fed. 419; *Tyler v. Crane*, 7 Fed. 775; *American Shoe-Tip Co. v. National Shoe-Toe Protector Co.*, 1 Fed. Cas. No. 317, 2 Ban. & A. 551, 11 Off. Gaz. 740; *Burleigh Rock Drill Co. v. Lobdell*, 4 Fed. Cas. No. 2,166, 1 Ban. & A. 625, *Holmes* 450, 7 Off. Gaz. 836; *Chase v. Wesson*, 5 Fed. Cas. No. 2,631, 6 Fish. Pat. Cas. 517, *Holmes* 274, 4 Off. Gaz. 476; *Orr v. Badger*, 18 Fed. Cas. No. 10,587; *Orr v. Littlefield*, 18 Fed. Cas. No. 10,590, 2 Robb Pat. Cas. 323, 1 Woodb. & M. 13; *Sargent v. Seagrave*, 21 Fed. Cas. No. 12,365, 2 Curt. 553; *Thomas v. Weeks*, 23 Fed. Cas. No. 13,914, Fish. Pat. Rep. 5, 2 Paine 92; *Woodworth v. Hall*, 30 Fed. Cas. No. 18,016, 2 Robb Pat. Cas. 495, 1 Woodb. & M. 248. Acquiescence must be clearly shown. *Keasbey, etc., Co. v. Philip Carey Mfg. Co.*, 139 Fed. 571; *American Coat Pad Co. v. Phoenix Pad Co.*, 113 Fed. 629, 51 C. C. A. 339; *Keasbey, etc., Co. v. Phillip Carey Co.*, 110 Fed. 747; *Mannie v. Everett*, 16 Fed. Cas. No. 9,039.

Acquiescence in claim of right before issuance of patent may be entitled to weight in considering whether the patentee is entitled to a preliminary injunction. *Sargent v. Seagrave*, 21 Fed. Cas. No. 12,365, 2 Curt. 553.

Acquiescence in the original patent does not apply to a reissue. *Grover, etc., Sewing-Mach. Co. v. Williams*, 11 Fed. Cas. No. 5,847, 2 Fish. Pat. Cas. 133.

Mere failure to infringe is not acquiescence. *Welsbach Light Co. v. Benedict, etc., Mfg. Co.*, 82 Fed. 747; *Stahl v. Williams*, 52 Fed.

648; *Guidet v. Palmer*, 11 Fed. Cas. No. 5,859, 10 Blatchf. 217, 6 Fish. Pat. Cas. 82.

19. *Hill v. Thompson*, Holt N. P. 636, 3 E. C. L. 249, 3 Meriv. 622, 17 Rev. Rep. 156, 36 Eng. Reprint 239, 2 Moore C. P. 424, 8 Taunt. 375, 20 Rev. Rep. 488, 4 E. C. L. 190; *Davenport v. Richard*, 3 L. T. Rep. N. S. 503.

20. *Consolidated Fastener Co. v. American Fastener Co.*, 94 Fed. 523; *Nilsson v. Jefferson*, 78 Fed. 366; *Mitchell v. Barclay*, 17 Fed. Cas. No. 9,659; *Potter v. Muller*, 19 Fed. Cas. No. 11,334, 2 Fish. Pat. Cas. 465; *Sargent v. Seagrave*, 21 Fed. Cas. No. 12,365, 2 Curt. 553.

For facts held to show acquiescence see *McDowell v. Kurtz*, 77 Fed. 206, 23 C. C. A. 119; *Thomson Electric Welding Co. v. Two Rivers Mfg. Co.*, 63 Fed. 120; *White v. Hunter*, 47 Fed. 819.

For facts held not to show acquiescence see *Palmer v. John E. Brown Mfg. Co.*, 84 Fed. 454 [reversed on other grounds in 92 Fed. 925, 35 C. C. A. 86]; *Palmer Pneumatic Tire Co. v. Newton Rubber Works Co.*, 73 Fed. 218; *Corbin Cabinet Lock Co. v. Yale, etc., Mfg. Co.*, 58 Fed. 563; *Upton v. Wayland*, 36 Fed. 691; *Guidet v. Palmer*, 11 Fed. Cas. No. 5,859, 10 Blatchf. 217, 6 Fish. Pat. Cas. 82.

21. Operation and effect of previous adjudications in general see *infra*, XIII, E.

22. *Cochrane v. Deener*, 94 U. S. 780, 24 L. ed. 139; *Lambert Snyder Vibrator Co. v. Marvel Vibrator Co.*, 138 Fed. 82; *Wilson v. Consolidated Stove-Service Co.*, 88 Fed. 286, 31 C. C. A. 533; *Cary Mfg. Co. v. De Haven*, 58 Fed. 786; *Motte v. Bennett*, 17 Fed. Cas. No. 9,884, 2 Fish. Pat. Cas. 642; *Potter v. Muller*, 19 Fed. Cas. No. 11,334, 2 Fish. Pat. Cas. 465; *Shelly v. Brannan*, 21 Fed. Cas. No. 12,751, 2 Biss. 315, 4 Fish. Pat. Cas. 198; *Clark v. Fergusson*, 1 Giffard 184, 5 Jur. N. S. 1155, 65 Eng. Reprint 878; *Young v. Fernie*, 9 L. T. Rep. N. S. 590, 3 New Rep. 270, 12 Wkly. Rep. 221.

23. *Miller v. McElroy*, 2 Pa. L. J. 305; *Wise v. Grand Ave. R. Co.*, 33 Fed. 277; *Booth v. Garely*, 3 Fed. Cas. No. 1,646, 1 Blatchf. 247, Fish. Pat. Rep. 154; *Brooks v. Bicknell*, 4 Fed. Cas. No. 1,940, Fish. Pat. Rep. 72, 4 McLean 70; *Bryan v. Stevens*, 4 Fed. Cas. No. 2,066a; *Cooper v. Mattheys*, 6 Fed. Cas. No. 3,200, 5 Pa. L. J. 38; *Muscan Hair Mfg. Co. v. American Hair Mfg. Co.*, 17 Fed. Cas. No. 9,970, 4 Blatchf. 174, 1 Fish. Pat. Cas. 320; *Ogle v. Ege*, 18 Fed. Cas. No. 10,462, 1 Robb Pat. Cas. 516, 4 Wash. 584.

24. *Cary Mfg. Co. v. De Haven*, 58 Fed.



prior adjudication in view of acquiescence by the public,<sup>25</sup> and sometimes a preliminary injunction may issue when the validity of the patent is clear, even though it has not been sustained by a prior adjudication or public acquiescence.<sup>26</sup>

(B) *As a Ground For Refusing or Granting Injunctions.* A preliminary injunction will be refused where a prior adjudication was against the patent,<sup>27</sup> or where it has been adjudged by a circuit court of appeals of another circuit, after full consideration and upon substantially the same record that defendant's device does not infringe.<sup>28</sup> Where the patent has been sustained either at law or in equity, such injunction will ordinarily be granted,<sup>29</sup> unless new evidence is pre-

786; *Blount v. Societe Anonyme, etc.*, 53 Fed. 98, 9 C. C. A. 526.

25. *National Typographic Co. v. New York Typograph Co.*, 46 Fed. 114; *White v. Surdam*, 41 Fed. 790; *Buck v. Cobb*, 4 Fed. Cas. No. 2,079, *Brunn. Col. Cas.* 550; *Foster v. Moore*, 9 Fed. Cas. No. 4,978, 1 *Curt.* 279; *Goodyear v. Central R. Co.*, 10 Fed. Cas. No. 5,563, 1 *Fish. Pat. Cas.* 626, 2 *Wall. Jr.* 356; *Grover, etc., Sewing-Mach. Co. v. Williams*, 11 Fed. Cas. No. 5,847, 2 *Fish. Pat. Cas.* 133; *Gutta Percha, etc., Mfg. Co. v. Goodyear Rubber Co.*, 11 Fed. Cas. No. 5,879, 2 *Ban. & A.* 212, 3 *Sawy.* 542; *Hockholzer v. Eager*, 12 Fed. Cas. No. 6,556, 2 *Sawy.* 361; *Mitchell v. Barclay*, 17 Fed. Cas. No. 9,659; *Muscan Hair Mfg. Co. v. American Hair Mfg. Co.*, 17 Fed. Cas. No. 9,970, 4 *Blatchf.* 174, 1 *Fish. Pat. Cas.* 320; *Washburn v. Gould*, 29 Fed. Cas. No. 17,214, 2 *Robb Pat. Cas.* 206, 3 *Story* 122; *Weston v. White*, 29 Fed. Cas. No. 17,459, 2 *Ban. & A.* 364, 13 *Blatchf.* 447; *Dudgeon v. Thomson*, 3 *App. Cas.* 34 [*affirming* 30 *L. T. Rep. N. S.* 244, 22 *Wkly. Rep.* 464].

26. *Wyckoff v. Wagner Typewriter Co.*, 88 Fed. 515; *Foster v. Crossin*, 23 Fed. 400; *Gardner v. Broadbent*, 2 *Jur. N. S.* 1041, 4 *Wkly. Rep.* 767; *Renard v. Levinstein*, 10 *L. T. Rep. N. S.* 94 [*affirmed* in 10 *L. T. Rep. N. S.* 177]. But see *Plympton v. Malcolmson*, *L. R.* 20 *Eq.* 37, 44 *L. J. Ch.* 257, 23 *Wkly. Rep.* 404.

27. *American Graphophone Co. v. National Gramophone Co.*, 92 Fed. 364, 34 *C. C. A.* 412; *Edison Electric Light Co. v. Citizens' Electric Light, etc., Co.*, 64 Fed. 491; *Hicks v. Beardsley*, 32 Fed. 281; *Keyes v. Pueblo Smelting, etc., Co.*, 31 Fed. 560; *Concord v. Norton*, 16 Fed. 477; *Onderdonk v. Fanning*, 18 Fed. Cas. No. 10,510a, 5 *Ban. & A.* 562; *Price's Patent Candle Co. v. Bauwen's Patent Candle Co.*, 6 *Wkly. Rep.* 318.

28. *Calculagraph Co. v. Automatic Time Stamp Co.*, 149 Fed. 436.

29. *Scott v. Laas*, 150 Fed. 764, 80 *C. C. A.* 500; *Elite Pottery Co. v. Dececo Co.*, 150 Fed. 581, 80 *C. C. A.* 567; *Timolat v. Philadelphia Pneumatic Tool Co.*, 123 Fed. 899; *Westinghouse Electric, etc., Co. v. Royal Weaving Co.*, 115 Fed. 733; *Diehl Mfg. Co. v. Dayton Fan, etc., Co.*, 109 Fed. 566; *Brill v. Peckham Motor Truck Co.*, 105 Fed. 626; *American Sulphite Pulp Co. v. Burgess Sulphite Fibre Co.*, 103 Fed. 975; *Consolidated Fastener Co. v. Hays*, 100 Fed. 984, 41 *C. C. A.* 142; *Welsbach Light Co. v. Rex Incandescent Light Co.*, 94 Fed. 1006; *Duff Mfg. Co. v. Norton*,

92 Fed. 921; *New York Filter Mfg. Co. v. Loomis-Manning Filter Co.*, 91 Fed. 421; *Allington, etc., Mfg. Co. v. Globe Co.*, 89 Fed. 865; *Westinghouse Air-Brake Co. v. Great Northern R. Co.*, 86 Fed. 132; *Southern Pac. Co. v. Earl*, 82 Fed. 690, 27 *C. C. A.* 185; *Adams v. Tannage Patent Co.*, 81 Fed. 178, 26 *C. C. A.* 326; *Carroll v. Goldschmidt*, 80 Fed. 520; *Thomson-Houston Electric Co. v. H. W. Johns Mfg. Co.*, 78 Fed. 364; *Thomson-Houston Electric Co. v. Union R. Co.*, 78 Fed. 363; *Thomson-Houston Electric Co. v. Johnson Co.*, 78 Fed. 361; *Woodard v. Ellword Gas Stove, etc., Co.*, 68 Fed. 717; *Norton v. Eagle Automatic Can Co.*, 57 Fed. 929; *American Bell Tel. Co. v. Cushman*, 57 Fed. 842; *S. S. White Dental Mfg. Co. v. Johnson*, 56 Fed. 262; *Consolidated Electric Storage Co. v. Accumulator Co.*, 55 Fed. 485, 5 *C. C. A.* 202; *Carter v. Wollschlaeger*, 53 Fed. 573; *Putnam v. Keystone Bottle Stopper Co.*, 38 Fed. 234; *Schneider v. Missouri Glass Co.*, 36 Fed. 582; *American Bell Tel. Co. v. National Improved Tel. Co.*, 27 Fed. 663; *Cary v. Domestic Spring-Bed Co.*, 27 Fed. 299; *Cary v. Lovell Mfg. Co.*, 24 Fed. 141; *Mallory Mfg. Co. v. Hickok*, 20 Fed. 116; *Coburn v. Brainard*, 16 Fed. 412, 5 *McCrary* 215; *Coburn v. Clark*, 15 Fed. 804, 5 *McCrary* 99; *Kirby Bung Mfg. Co. v. White*, 1 Fed. 604, 1 *McCrary* 155; *Woven-Wire Mattress Co. v. Wire-Web Bed Co.*, 1 Fed. 222; *American Middlings Purifier Co. v. Christian*, 1 Fed. Cas. No. 307, 3 *Ban. & A.* 42, 4 *Dill* 448; *American Nicholson Pavement Co. v. Elizabeth*, 1 Fed. Cas. No. 312, 4 *Fish. Pat. Cas.* 189; *American Wood-Paper Co. v. Fibre Disintegrating Co.*, 1 Fed. Cas. No. 320, 6 *Blatchf.* 27, 3 *Fish. Pat. Cas.* 362 [*affirmed* in 23 *Wall.* 566, 23 *L. ed.* 31]; *Clum v. Brewer*, 5 Fed. Cas. No. 2,909, 2 *Curt.* 506; *Conover v. Mers*, 6 Fed. Cas. No. 3,123, 3 *Fish. Pat. Cas.* 386; *Cook v. Ernest*, 6 Fed. Cas. No. 3,155, 5 *Fish. Pat. Cas.* 396, 1 *Woods* 195, 2 *Off. Gaz.* 89; *Gibson v. Betts*, 10 Fed. Cas. No. 5,390, 1 *Blatchf.* 163, *Fish. Pat. Rep.* 91; *Goodyear v. Berry*, 10 Fed. Cas. No. 5,556, 2 *Bond* 189, 3 *Fish. Pat. Cas.* 439; *Goodyear v. Honsinger*, 10 Fed. Cas. No. 5,572, 2 *Biss.* 1, 3 *Fish. Pat. Cas.* 147; *Green v. French*, 10 Fed. Cas. No. 5,757, 4 *Ban. & A.* 169, 16 *Off. Gaz.* 215 [*following* *Gibson v. Van Dresar*, 10 Fed. Cas. No. 5,402, 1 *Blatchf.* 532, *Fish. Pat. Rep.* 369]; *Hitchcock v. Shoninger Melodeon Co.*, 12 Fed. Cas. No. 6,537; *Orr v. Badger*, 18 Fed. Cas. No. 10,587, *Brunn. Col. Cas.* 536; *Pennsylvania Salt Mfg. Co. v. Myers*, 19 Fed. Cas. No. 10,955, 1 *Wkly.*



sented such as would have changed the prior decision.<sup>30</sup> Such prior adjudication, however, unless made by the United States supreme court or the circuit court of

Notes Cas. (Pa.) 377; *Poppenhusen v. New York Gutta Percha Comb Co.*, 19 Fed. Cas. No. 11,281, 4 Blatchf. 184, 2 Fish. Pat. Cas. 74; *Potter v. Muller*, 19 Fed. Cas. No. 11,334, 2 Fish. Pat. Cas. 465; *Robertson v. Hill*, 20 Fed. Cas. No. 11,925, 6 Fish. Pat. Cas. 465, 4 Off. Gaz. 132; *Rumford Chemical Works v. Hecker*, 20 Fed. Cas. No. 12,133, 2 Ban. & A. 351, 10 Off. Gaz. 289; *Rumford Chemical Works v. Hecker*, 20 Fed. Cas. No. 12,134, 2 Ban. & A. 386, 11 Off. Gaz. 330; *Sickels v. Tileston*, 22 Fed. Cas. No. 12,837, 4 Blatchf. 109; *Tilghman v. Mitchell*, 23 Fed. Cas. No. 14,042, 9 Blatchf. 18, 4 Fish. Pat. Cas. 615 [reversed on other grounds in 19 Wall. 287, 22 L. ed. 125]; *Van Hook v. Wood*, 28 Fed. Cas. No. 16,855; *Bovill v. Goodier*, L. R. 2 Eq. 195, 12 Jur. N. S. 404, 35 L. J. Ch. 432; *Newall v. Wilson*, 2 De G. M. & G. 282, 51 Eng. Ch. 220, 42 Eng. Reprint 880.

Although the parties are different, the prior adjudication has great weight. *A. B. Dick Co. v. Pomeroy Duplicator Co.*, 117 Fed. 154; *American Paper Pail, etc., Co. v. National Folding Box, etc., Co.*, 51 Fed. 229, 2 C. C. A. 165; *Burr v. Prentiss*, 4 Fed. Cas. No. 2,194; *Potter v. Fuller*, 19 Fed. Cas. No. 11,327, 2 Fish. Pat. Cas. 251; *Potter v. Whitney*, 19 Fed. Cas. No. 11,341, 3 Fish. Pat. Cas. 77, 1 Lowell 87.

Where appeal or writ of error pending, adjudication is not binding. *Bowers Dredging Co. v. New York Dredging Co.*, 77 Fed. 980; *Day v. Hartshorn*, 7 Fed. Cas. No. 3,683, 3 Fish. Pat. Cas. 32; *Bridson v. McAlpine*, 8 Beav. 229, 50 Eng. Reprint 90.

Where decision is reversed injunction granted on prior adjudication will be dissolved. *Brill v. Peckham Mfg. Co.*, 135 Fed. 784, 68 C. C. A. 486; *Prieth v. Campbell Printing-Press, etc., Co.*, 80 Fed. 539, 25 C. C. A. 624.

**Interlocutory motion.**—Ruling even on interlocutory motion may be followed. *Maitland v. Graham*, 96 Fed. 247; *Duff Mfg. Co. v. Norton*, 92 Fed. 921; *Horn, etc., Mfg. Co. v. Pelzer*, 91 Fed. 665, 34 C. C. A. 45.

**Decision in interference in patent office** is not a controlling adjudication (*Reed Mfg. Co. v. Smith, etc., Co.*, 107 Fed. 719, 46 C. C. A. 601; *Wilson v. Consolidated Store-Service Co.*, 88 Fed. 286, 31 C. C. A. 533 [reversing 83 Fed. 201]; *Empire State Nail Co. v. American Solid Leather Button Co.*, 61 Fed. 650; *Dickerson v. De la Vergne Refrigerating Mach. Co.*, 35 Fed. 143; *Potter v. Stevens*, 19 Fed. Cas. No. 11,338, 2 Fish. Pat. Cas. 163), but may be sufficient between parties (*Consolidated Bunting Apparatus Co. v. Peter Schoenhofen Brewing Co.*, 28 Fed. 428; *Celluloid Mfg. Co. v. Chrolithian Collar, etc., Co.*, 24 Fed. 275; *Smith v. Halkyard*, 16 Fed. 414).

Whether judgment on original patent shall be followed on reissue depends on circumstances. *American Middlings Purifier Co. v. Atlantic Milling Co.*, 1 Fed. Cas. No. 305, 3

Ban. & A. 168, 4 Dill. 100; *Poppenhusen v. Falke*, 19 Fed. Cas. No. 11,279, 4 Blatchf. 493, 2 Fish. Pat. Cas. 181; *Wells v. Jacques*, 29 Fed. Cas. No. 17,399, 5 Fish. Pat. Cas. 136.

**30.** *Brill v. Peckham Mfg. Co.*, 129 Fed. 139; *George Frost Co. v. Crandall Wedge Co.*, 123 Fed. 104 [affirmed in 125 Fed. 942, 60 C. C. A. 180]; *Westinghouse Electric, etc., Co. v. Royal Weaving Co.*, 115 Fed. 733; *American Sulphite Pulp Co. v. Burgess Sulphite Fibre Co.*, 103 Fed. 975; *Welsbach Light Co. v. Rex Incandescent Light Co.*, 94 Fed. 1006; *Duff Mfg. Co. v. Kalamazoo R. Velocipede, etc., Co.*, 94 Fed. 154; *Tripp Giant Leveler Co. v. Bresnahan*, 92 Fed. 391; *Doig v. Morgan Mach. Co.*, 91 Fed. 1001, 33 C. C. A. 683; *New York Filter Mfg. Co. v. Jackson*, 91 Fed. 422; *Doig v. Morgan Mach. Co.*, 89 Fed. 489; *Consolidated Car Heating Co. v. Gold Car Heating Co.*, 87 Fed. 996; *Mast v. Stover Mfg. Co.*, 85 Fed. 782; *Bowers v. Pacific Coast Dredging, etc., Co.*, 81 Fed. 569; *Bowers Dredging Co. v. New York Dredging Co.*, 80 Fed. 119; *Tannage Patent Co. v. Adams*, 77 Fed. 191; *Earl v. Southern Pac. Co.*, 75 Fed. 609; *Tannage Patent Co. v. Donallan*, 75 Fed. 287; *Bresnahan v. Tripp Giant Leveler Co.*, 72 Fed. 920, 19 C. C. A. 237; *Allington, etc., Mfg. Co. v. Lynch*, 71 Fed. 409; *Singer Mfg. Co. v. New Home Sewing-Mach. Co.*, 70 Fed. 985; *Philadelphia Trust, etc., Co. v. Edison Electric Light Co.*, 65 Fed. 551, 13 C. C. A. 40; *Electric Mfg. Co. v. Edison Electric Light Co.*, 61 Fed. 834, 10 C. C. A. 106; *Norton v. Eagle Automatic Can Co.*, 61 Fed. 293; *Norton v. Eagle Automatic Can Co.*, 57 Fed. 929; *Edison Electric Light Co. v. Electric Mfg. Co.*, 57 Fed. 616; *Accumulator Co. v. Consolidated Electric Storage Co.*, 53 Fed. 796 [affirmed in 55 Fed. 485, 5 C. C. A. 202]; *National Folding-Box, etc., Co. v. American Paper Pail, etc., Co.*, 48 Fed. 913; *Ladd v. Cameron*, 25 Fed. 37; *Bailey Wringing Mach. Co. v. Adams*, 2 Fed. Cas. No. 752, 3 Ban. & A. 96, 5 Reporter 102; *Blaisdell v. Dows*, 3 Fed. Cas. No. 1,489, 4 Ban. & A. 499; *Jones v. Merrill*, 13 Fed. Cas. No. 7,481, 8 Off. Gaz. 401; *Parker v. Brant*, 14 Fed. Cas. No. 10,727, 1 Fish. Pat. Cas. 58.

That injunction may be granted upon prior adjudication notwithstanding new evidence see *Armat Moving Picture Co. v. Edison Mfg. Co.*, 121 Fed. 559 [reversed on other grounds in 125 Fed. 939, 60 C. C. A. 380]; *Consolidated Fastener Co. v. Hays*, 100 Fed. 984; *New York Filter Mfg. Co. v. Niagara Falls Waterworks Co.*, 80 Fed. 924, 26 C. C. A. 252; *Campbell Printing-Press Co. v. Prieth*, 77 Fed. 976; *Tannage Patent Co. v. Donallan*, 75 Fed. 287; *Sawyer Spindle Co. v. Taylor*, 56 Fed. 110; *Macbeth v. Braddock Glass Co.*, 54 Fed. 173 [affirmed in 64 Fed. 118, 12 C. C. A. 701]; *Carter v. Wollschlaeger*, 53 Fed. 573; *Brush Electric Co. v. Accumulator Co.*, 50 Fed. 833; *Seibert Cylinder Oil-Cup Co. v. Michigan Lubricator*



appeals<sup>81</sup> is not controlling upon the judgment of the court but merely persuasive.<sup>82</sup> The prior adjudication will not be followed where the points involved were not fairly in issue and decided,<sup>83</sup> or where there was collusion,<sup>84</sup> and an adjudication without contest is not sufficient upon which to base a preliminary injunction.<sup>85</sup> There is some conflict of authority as to whether an injunction will be granted where there are conflicting prior adjudications.<sup>86</sup>

(c) *Effect on Question of Infringement.* Prior adjudication as to the validity of a patent leaves open the question of infringement.<sup>87</sup>

(v) *TERMS AND CONDITIONS.* The terms and conditions to be imposed in disposing of a motion for an injunction rest in the sound discretion of the court and depend upon the special circumstances of the case.<sup>88</sup>

Co., 34 Fed. 33; *Birdsall v. Hagerstown Agricultural Implement Mfg. Co.*, 3 Fed. Cas. No. 1,433, 1 Ban. & A. 426, 6 Off. Gaz. 604. The new evidence is to be accepted with caution and must be clear and convincing to warrant what is substantially a reversal of a prior adjudication. *Consolidated Fastener Co. v. Hays*, 100 Fed. 984.

31. Adjudication of United States supreme court or circuit court of appeals is conclusive. *Westinghouse Air Brake Co. v. Christiansen Engineering Co.*, 113 Fed. 594; *American Sulphite Pulp Co. v. Burgess Co.*, 103 Fed. 975; *Bowers Dredging Co. v. New York Dredging Co.*, 80 Fed. 119; *American Bell Tel. Co. v. McKeesport Tel. Co.*, 57 Fed. 661; *American Middlings Purifier Co. v. Christian*, 1 Fed. Cas. No. 307, 3 Ban. & A. 42, 4 Dill. 448; *Richardson v. Lockwood*, 20 Fed. Cas. No. 11,786, 4 Cliff. 128.

32. *Diamond Match Co. v. Union Match Co.*, 129 Fed. 602; *Western Electric Co. v. Keystone Tel. Co.*, 115 Fed. 809; *Brunswick-Balke-Collender Co. v. Koehler*, 115 Fed. 648; *Welsbach Light Co. v. Cosmopolitan Incandescent Light Co.*, 104 Fed. 83, 43 C. C. A. 418; *Western Electric Co. v. Anthracite Tel. Co.*, 100 Fed. 301; *Horn, etc., Mfg. Co. v. Pelzer*, 91 Fed. 665, 34 C. C. A. 45; *Ross v. Chicago*, 91 Fed. 265; *Stover Mfg. Co. v. Mast*, 89 Fed. 333, 32 C. C. A. 231; *Société Anonyme, etc., v. Allen*, 84 Fed. 812; *Bowers v. San Francisco Bridge Co.*, 69 Fed. 640; *Edison Electric Light Co. v. Columbia Incandescent Lamp Co.*, 56 Fed. 496; *Stahl v. Williams*, 52 Fed. 648; *Jacobson v. Alpi*, 46 Fed. 767; *Lockwood v. Faber*, 27 Fed. 63; *Cornell v. Littlejohn*, 6 Fed. Cas. No. 3,238, 2 Ban. & A. 324, 9 Off. Gaz. 837, 922; *U. S., etc., Felting Co. v. Asbestos Felting Co.*, 28 Fed. Cas. No. 16,787, 10 Off. Gaz. 828.

33. *Southern Pac. R. Co. v. Earl*, 82 Fed. 690, 27 C. C. A. 185; *American Graphophone Co. v. Leeds*, 77 Fed. 193; *National Hat-Pouncing Mach. Co. v. Hedden*, 29 Fed. 147; *Page v. Holmes Burglar Alarm Tel. Co.*, 2 Fed. 330, 18 Blatchf. 118; *Grover v. Williams*, 11 Fed. Cas. No. 5,847, 2 Fish. Pat. Cas. 133; *Parker v. Sears*, 18 Fed. Cas. No. 10,748, 1 Fish. Pat. Cas. 93, 4 Pa. L. J. 443; *Wells v. Gill*, 29 Fed. Cas. No. 17,394, 6 Fish. Pat. Cas. 80, 2 Off. Gaz. 590.

34. *Western Electric Co. v. Anthracite Tel. Co.*, 113 Fed. 834.

More failure to appeal does not show collusion. *Doig v. Morgan Mach. Co.*, 89 Fed.

489 [affirmed in 91 Fed. 1001, 33 C. C. A. 683].

Where the merits were considered by the court, a collusive decree set aside may still have weight. *A. B. Dick Co. v. Wichelman*, 74 Fed. 799.

35. *National Enameling Co. v. New England Enameling Co.*, 123 Fed. 436; *American Coat Pad Co. v. Phonix Pad Co.*, 113 Fed. 629, 51 C. C. A. 339; *American Electrical Novelty Co. v. Newgold*, 99 Fed. 567; *Wilson v. Consolidated Store-Service Co.*, 88 Fed. 286, 31 C. C. A. 533; *Société Anonyme, etc. v. Allen*, 84 Fed. 812; *Bowers Dredging Co. v. New York Dredging Co.*, 77 Fed. 980; *Fenton Metallic Mfg. Co. v. Chase*, 73 Fed. 831; *Covert v. Travers*, 70 Fed. 788; *De Ver Warner v. Bassett*, 7 Fed. 468, 19 Blatchf. 145; *Hayes v. Leton*, 5 Fed. 521; *Mannie v. Everett*, 16 Fed. Cas. No. 9,039; *Orr v. Littlefield*, 18 Fed. Cas. No. 10,590, 2 Robb Pat. Cas. 323, 1 Woodb. & M. 13 (holding that judgment without contest has weight where there is no collusion); *Potter v. Fuller*, 19 Fed. Cas. No. 11,327, 2 Fish. Pat. Cas. 251; *Spring v. Domestic Sewing-Mach. Co.*, 22 Fed. Cas. No. 13,258, 4 Ban. & A. 427, 16 Off. Gaz. 721, 2 N. J. L. J. 274.

36. Refused where conflicting prior adjudications. *Eldred v. Breitwieser*, 132 Fed. 251; *Wilgus v. Van Sickle*, 99 Fed. 443; *Allen v. Sprague*, 1 Fed. Cas. No. 238, 1 Blatchf. 567, Fish. Pat. Rep. 388. In case of conflict the decision in the same circuit controls. *Pullman's Palace-Car Co. v. Wagner Palace-Car Co.*, 44 Fed. 764. Later decision controls. *Pelzer v. Geise*, 87 Fed. 869. In case of conflict the best considered will be followed. *Pelzer v. Newhall*, 93 Fed. 684; *Philadelphia Trust, etc., Co. v. Edison Electric Light Co.*, 65 Fed. 551, 13 C. C. A. 40; *Van Hook v. Wood*, 28 Fed. Cas. No. 16,855.

37. *Westinghouse Electric, etc., Co. v. American Transformer Co.*, 121 Fed. 560 [affirmed in 130 Fed. 550]; *Whippany Mfg. Co. v. United Indurated Fibre Co.*, 87 Fed. 215, 30 C. C. A. 615 [reversing 83 Fed. 485]; *Sawyer Spindle Co. v. Turner*, 55 Fed. 979; *Carey v. Miller*, 34 Fed. 392; *Odorless Excavating Co. v. Lanman*, 12 Fed. 788, 4 Woods 129. But see *Duff Mfg. Co. v. Norton*, 92 Fed. 921.

38. *Palmer v. Mills*, 57 Fed. 221; *Westinghouse Air-Brake Co. v. Carpenter*, 32 Fed. 545; *Sessions v. Romadka*, 21 Fed. 124; *Ely v. Monson, etc., Mfg. Co.*, 8 Fed. Cas. No.



(vi) *INDEMNITY BOND*. In place of an injunction defendant may be required to give bond conditioned for the payment of all damages awarded.<sup>39</sup> Likewise where an injunction is granted the complainant may be required to give bond to indemnify defendant.<sup>40</sup> Whether such bond shall be required of complainant depends upon circumstances.<sup>41</sup>

(vii) *APPLICATION AND PROCEEDINGS THEREON*. Motion for preliminary injunction must be made, supported by the affidavits of the complainant and others to all facts not shown in the bill of complaint necessary to establish his right.<sup>42</sup>

4,431, 4 Fish. Pat. Cas. 64; *Hodge v. Hudson River R. Co.*, 12 Fed. Cas. No. 6,560, 6 Blatchf. 165; *Rogers v. Abbot*, 20 Fed. Cas. No. 12,004, 1 Robb Pat. Cas. 465, 4 Wash. 514; *Serrell v. Collins*, 21 Fed. Cas. No. 12,671, 4 Blatchf. 61; *Smith v. Sharp's Rifle Mfg. Co.*, 22 Fed. Cas. No. 13,106, 3 Blatchf. 545; *Sykes v. Manhattan Elevator, etc., Co.*, 23 Fed. Cas. No. 13,710, 6 Blatchf. 496; *Tilghman v. Mitchell*, 23 Fed. Cas. No. 14,042, 9 Blatchf. 18, 4 Fish. Pat. Cas. 615 [reversed on other grounds in 19 Wall. 287, 22 L. ed. 125].

Injunction refused but defendant ordered to give security and keep an account see *Marvel Co. v. Pearl*, 114 Fed. 946; *Macbeth v. Lippencott Glass Co.*, 54 Fed. 167; *Eagle Mfg. Co. v. Chamberlain Plow Co.*, 36 Fed. 905; *American Middlings Purifier Co. v. Atlantic Milling Co.*, 1 Fed. Cas. No. 305, 3 Ban. & A. 168, 4 Dill. 100; *Blake v. Greenwood Cemetery*, 3 Fed. Cas. No. 1,497, 3 Ban. & A. 112, 14 Blatchf. 342, 13 Off. Gaz. 1046; *Blake v. Robertson*, 3 Fed. Cas. No. 1,500, 11 Blatchf. 237, 6 Fish. Pat. Cas. 509; *Stainthorp v. Humiston*, 22 Fed. Cas. No. 13,280, 2 Fish. Pat. Cas. 311.

For cases in which modification of the injunction was refused see *Consolidated Roller-Mill Co. v. Coombs*, 39 Fed. 803; *Munson v. New York*, 19 Fed. 313.

39. *Karfiol v. Rother*, 151 Fed. 777; *National Enameling Co. v. New England Enameling Co.*, 123 Fed. 436; *Marvel Co. v. Pearl*, 114 Fed. 946; *Seiler v. Fuller, etc., Mfg. Co.*, 102 Fed. 344, 42 C. C. A. 386; *National Cash-Register Co. v. Navy Cash-Register Co.*, 99 Fed. 565; *Duplex Printing-Press Co. v. Campbell Printing-Press, etc., Co.*, 69 Fed. 250, 16 C. C. A. 220; *Edison Electric Light Co. v. Columbia Incandescent Lamp Co.*, 56 Fed. 496; *Eastern Paper-Bag Co. v. Nixon*, 35 Fed. 752; *Hoe v. Knap*, 27 Fed. 204; *New York Belting, etc., Co. v. Magowan*, 23 Fed. 596; *Greenwood v. Bracher*, 1 Fed. 856; *Gilbert, etc., Mfg. Co. v. Bussing*, 10 Fed. Cas. No. 5,416, 1 Ban. & A. 621, 12 Blatchf. 426, 8 Off. Gaz. 144; *Goodyear v. Hills*, 10 Fed. Cas. No. 5,571a, 3 Fish. Pat. Cas. 134; *Howe v. Morton*, 12 Fed. Cas. No. 6,769, Fish. Pat. Rep. 586; *Irwin v. McRoberts*, 13 Fed. Cas. No. 7,085, 4 Ban. & A. 411, 16 Off. Gaz. 853; *Morris v. Shelbourne*, 17 Fed. Cas. No. 9,836, 8 Blatchf. 266, 4 Fish. Pat. Cas. 377.

Computation of amount of bond.—In fixing the amount of a bond required of defendant in a suit for infringement of patents as a condition to the refusing of a preliminary injunction, the amount of the profits made by him from the alleged infringement affords

the only approximate basis for computation. *Karfiol v. Rother*, 151 Fed. 779.

Security required only where showing is such as would justify injunction see *American Middlings Purifier Co. v. Atlantic Milling Co.*, 1 Fed. Cas. No. 305, 3 Ban. & A. 168, 4 Dill. 100.

Where doubt, bond required in place of injunction.—*Consolidated Rubber Tire Co. v. Finley Rubber Tire Co.*, 106 Fed. 175.

Bond not accepted in a clear case in place of injunction see *Electric Storage Battery Co. v. Buffalo Electric Carriage Co.*, 117 Fed. 314; *Campbell Printing-Press Co. v. Prieth*, 77 Fed. 976; *Carter v. Wollschlaeger*, 53 Fed. 573; *Westinghouse Air-Brake Co. v. Carpenter*, 32 Fed. 545; *McWilliams Mfg. Co. v. Blundell*, 11 Fed. 419; *Conover v. Mers*, 6 Fed. Cas. No. 3,123, 3 Fish. Pat. Cas. 386; *Ely v. Monson, etc., Mfg. Co.*, 8 Fed. Cas. No. 4,431, 4 Fish. Pat. Cas. 64; *Morse v. O'Reilly*, 17 Fed. Cas. No. 9,859; *Tracy v. Torrey*, 24 Fed. Cas. No. 14,127, 2 Blatchf. 275. But see *Westinghouse Air-Brake Co. v. Burton Stock-Car Co.*, 77 Fed. 301, 23 C. C. A. 174, holding that bond may be accepted in place of injunction even in a clear case where great injury to defendant.

40. *Consolidated Electric Storage Co. v. Accumulator Co.*, 55 Fed. 485, 5 C. C. A. 202 [affirming 53 Fed. 796]; *Shelly v. Brannan*, 21 Fed. Cas. No. 12,751, 2 Biss. 315, 4 Fish. Pat. Cas. 198.

Complainant is liable for injury due to injunction where final judgment against him. *National Phonograph Co. v. American Graphophone Co.*, 136 Fed. 231; *Tobey Furniture Co. v. Colby*, 35 Fed. 592.

41. *Pasteur Chamberland Filter Co. v. Funk*, 52 Fed. 146; *Van Hook v. Wood*, 28 Fed. Cas. No. 16,855.

42. *Palmer Pneumatic Tire Co. v. Newton Rubber Works*, 73 Fed. 218; *American Diamond Rock Boring Co. v. Sullivan Mach. Co.*, 1 Fed. Cas. No. 298, 2 Ban. & A. 552, 14 Blatchf. 119; *Beane v. Orr*, 2 Fed. Cas. No. 1,176, 2 Ban. & A. 176, 9 Off. Gaz. 255; *Gutta Percha, etc., Mfg. Co. v. Goodyear Rubber Co.*, 11 Fed. Cas. No. 5,879, 2 Ban. & A. 212, 3 Sawy. 542; *Stevens v. Felt*, 23 Fed. Cas. No. 13,397; *Sullivan v. Redfield*, 23 Fed. Cas. No. 13,597, 1 Paine 441, 1 Robb Pat. Cas. 477; *Young v. Lippman*, 30 Fed. Cas. No. 18,160, 9 Blatchf. 277, 5 Fish. Pat. Cas. 230, 2 Off. Gaz. 249, 342.

Production of documents.—Documents referred to should be produced. *Siemens-Lungren Co. v. Hatch*, 47 Fed. 64; *National Typographic Co. v. New York Typograph Co.*, 46 Fed. 114.



Defendant may file counter affidavits,<sup>43</sup> and in some jurisdictions the complainant may file rebutting affidavits.<sup>44</sup>

(VIII) *CONSIDERATION AND JUDGMENT ON MOTION.* On motion for preliminary injunction the court will not undertake to determine disputed and difficult questions of law or fact,<sup>45</sup> nor pass upon the credibility of witnesses.<sup>46</sup> It will, however, consider all pertinent facts which are clearly shown,<sup>47</sup> and will make such order as the equities of the case demand.<sup>48</sup>

(IX) *MODIFYING OR DISSOLVING.* The dissolution or modification of an injunction is a matter resting in the sound discretion of the court.<sup>49</sup>

Affidavit of third parties see *Lombard v. Stillwell*, 15 Fed. Cas. No. 8,472.

The court may take judicial notice of matters of common knowledge see *Adams, etc., Mfg. Co. v. St. Louis Wire-Goods Co.*, 1 Fed. Cas. No. 72, 3 Ban. & A. 77, 12 Off. Gaz. 940.

English practice application must make out a case and include the allegation that the complainant believes himself to be the first inventor. *Whitton v. Jennings*, 1 Dr. & Sm. 110, 6 Jur. N. S. 164, 1 L. T. Rep. N. S. 395, 62 Eng. Reprint 320; *Hill v. Thompson*, *Holt N. P.* 636, 3 E. C. L. 249, 3 Meriv. 622, 17 Rev. Rep. 156, 36 Eng. Reprint 239, 2 Moore C. P. 424, 8 Taunt. 375, 20 Rev. Rep. 488, 4 E. C. L. 190; *Mayer v. Spence*, 1 Johns. & H. 87, 6 Jur. N. S. 672, 8 Wkly. Rep. 559, 70 Eng. Reprint 673; *Gardner v. Broadbent*, 2 Jur. N. S. 1041, 4 Wkly. Rep. 767; *Sturz v. De la Rue*, 7 L. J. Ch. O. S. 47, 5 Russ. 322, 29 Rev. Rep. 24, 5 Eng. Ch. 322, 38 Eng. Reprint 1048.

43. *Brill v. Peckham Motor Truck, etc.*, Co., 189 U. S. 57, 23 S. Ct. 562, 47 L. ed. 706; *Robinson v. Randolph*, 20 Fed. Cas. No. 11,962, 4 Ban. & A. 163; *Wickershaff v. Jones*, 29 Fed. Cas. No. 17,609; *Young v. Lippman*, 30 Fed. Cas. No. 18,160, 9 Blatchf. 277, 5 Fish. Pat. Cas. 230, 2 Off. Gaz. 249, 342.

Answer as an affidavit on motion see *Good-year v. Mullee*, 10 Fed. Cas. No. 5,579, 3 Fish. Pat. Cas. 420; *Parker v. Sears*, 18 Fed. Cas. No. 10,748, 1 Fish. Pat. Cas. 93.

Answer insufficient as disclaimer of intent to use or sell machines embodying features of the patent see *Deere, etc., Co. v. Dowagiac Mfg. Co.*, 153 Fed. 177, 82 C. C. A. 351.

Admissions by answer see *Deere, etc., Co. v. Dowagiac Mfg. Co.*, 153 Fed. 177, 82 C. C. A. 351.

Estoppel by averments in answer see *Morse Fountain-Pen Co. v. Esterbrook Steel-Pen Mfg. Co.*, 17 Fed. Cas. No. 9,862, 3 Fish. Pat. Cas. 515.

44. *Brill v. Peckham Motor Truck, etc.*, Co., 189 U. S. 57, 23 S. Ct. 562, 47 L. ed. 706; *Norton v. Eagle Automatic Can Co.*, 57 Fed. 929; *Goodyear v. Mullee*, 10 Fed. Cas. No. 5,579, 3 Fish. Pat. Cas. 420; *Union Paper-Bag Mach. Co. v. Binney*, 24 Fed. Cas. No. 14,387, 5 Fish. Pat. Cas. 166; *Gibbs v. Cole*, *Dick*, 64, 21 Eng. Reprint 192, 3 P. Wms. 255, 24 Eng. Reprint 1051.

45. *Seal v. Beach*, 113 Fed. 831; *Consolidated Fastener Co. v. Columbian Fastener Co.*, 73 Fed. 828; *American Nicholson Pavement Co. v. Elizabeth*, 1 Fed. Cas. No. 312,

4 Fish. Pat. Cas. 189; *Bailey Wringing Mach. Co. v. Adams*, 2 Fed. Cas. No. 752, 3 Ban. & A. 96, 5 Reporter 102; *Crowell v. Harlow*, 6 Fed. Cas. No. 3,444, 3 Ban. & A. 478, 18 Off. Gaz. 466; *Parker v. Sears*, 18 Fed. Cas. No. 10,748, 1 Fish. Pat. Cas. 93; *Potter v. Whitney*, 19 Fed. Cas. No. 11,341, 3 Fish. Pat. Cas. 77, 1 Lowell 87; *Sickels v. Youngs*, 22 Fed. Cas. No. 12,838, 3 Blatchf. 293.

Evidence insufficient to warrant granting of injunction see *Mathews Gravity Carrier Co. v. Lister*, 154 Fed. 490; *Marconi Wireless Tel. Co. v. American De Forest Wireless Tel. Co.*, 154 Fed. 74; *Hall Signal Co. v. General R. Signal Co.*, 153 Fed. 907, 82 C. C. A. 653.

46. *Sessions v. Gould*, 48 Fed. 855 [affirmed in 63 Fed. 1001, 11 C. C. A. 546]; *Cooper v. Mattheys*, 6 Fed. Cas. No. 3,200, 5 Pa. L. J. 38.

47. *Westinghouse Electric, etc., Co. v. Stanley Electric Mfg. Co.*, 117 Fed. 309; *Irwin v. Dane*, 13 Fed. Cas. No. 7,081, 2 Biss. 442, 4 Fish. Pat. Cas. 359; *Morse Fountain-Pen Co. v. Esterbrook Steel-Pen Mfg. Co.*, 17 Fed. Cas. No. 9,862, 3 Fish. Pat. Cas. 515; *Sickels v. Youngs*, 22 Fed. Cas. No. 12,838, 3 Blatchf. 293; *Union Paper-Bag Mach. Co. v. Binney*, 24 Fed. Cas. No. 14,387, 5 Fish. Pat. Cas. 166.

Verbal admissions by defendant see *Jones v. Merrill*, 13 Fed. Cas. No. 7,481, 8 Off. Gaz. 401; *Morse Fountain-Pen Co. v. Esterbrook Steel-Pen Mfg. Co.*, 17 Fed. Cas. No. 9,862, 3 Fish. Pat. Cas. 515.

Where case depends on written instruments court decides. *Clum v. Brewer*, 5 Fed. Cas. No. 2,909, 2 Curt. 506.

Patent not in record not considered see *Drainage Constr. Co. v. Englewood Sewer Co.*, 67 Fed. 141.

Parties cannot so frame issues as to prevent decision as to patentability or as to scope of claims. *Millard v. Chase*, 108 Fed. 399, 47 C. C. A. 429.

48. *Antisdel v. Chicago Hotel Cabinet Co.*, 89 Fed. 308, 32 C. C. A. 216; *American Midlings Purifier Co. v. Vail*, 1 Fed. Cas. No. 308, 4 Ban. & A. 1, 15 Blatchf. 315; *Atlantic Giant-Powder Co. v. Goodyear*, 2 Fed. Cas. No. 623, 3 Ban. & A. 161, 13 Off. Gaz. 45; *Burr v. Smith*, 4 Fed. Cas. No. 2,196; *Parkhurst v. Kinsman*, 18 Fed. Cas. No. 10,760, 2 Blatchf. 78, Fish. Pat. Rep. 180; *Woodworth v. Edwards*, 30 Fed. Cas. No. 18,014, 2 Robb Pat. Cas. 603, 3 Woodb. & M. 524.

49. *Barnard v. Gibson*, 7 How. (U. S.) 650, 12 L. ed. 857; *Brown v. Deere*, 6 Fed. 487, 2



**c. Permanent Injunction.** The right to a permanent injunction ordinarily exists where judgment is in favor of the complainant,<sup>50</sup> but there may be special circumstances which will prevent its issuance.<sup>51</sup>

**d. Violation and Punishment—(1) WRIT OR MANDATE VIOLATED.** The writ of injunction cannot be the foundation for an attachment for contempt against

McCrary 425; Orr *v.* Badger, 18 Fed. Cas. No. 10,587, Brunn. Col. Cas. 536; Woodworth *v.* Rogers, 30 Fed. Cas. No. 18,018, 2 Robb Pat. Cas. 625, 3 Woodb. & M. 135.

That injunction will not be dissolved on coming in of answer merely denying equity of the bill see Orr *v.* Littlefield, 18 Fed. Cas. No. 10,590, 2 Robb Pat. Cas. No. 323, 1 Woodb. & M. 13; Orr *v.* Merrill, 18 Fed. Cas. No. 10,591, 2 Robb Pat. Cas. 331, 1 Woodb. & M. 376.

Must overcome equity and evidence see Sparkman *v.* Higgins, 22 Fed. Cas. No. 13,208, 1 Blatchf. 205, Fish. Pat. Rep. 110; Woodworth *v.* Rogers, 30 Fed. Cas. No. 18,018, 2 Robb Pat. Cas. 625, 3 Woodb. & M. 135.

Motion to dissolve heard upon the same evidence or that which should have been produced see National School Furniture Co. *v.* Paton, 18 Fed. Cas. No. 10,050, 4 Ban. & A. 432, 16 Blatchf. 563; Woodworth *v.* Rogers, 30 Fed. Cas. No. 18,018, 2 Robb Pat. Cas. 625, 3 Woodb. & M. 135.

Evidence taken too late on the merits cannot be presented on motion to dissolve. Union Paper-Bag Mach. Co. *v.* Newell, 24 Fed. Cas. No. 14,389, 1 Ban. & A. 113, 11 Blatchf. 549, 5 Off. Gaz. 459.

Cases in which motion to dissolve denied see Holmes Electric Protective Co. *v.* Metropolitan Burglar Alarm Co., 31 Fed. 562; Bassett *v.* Malone, 11 Fed. 801; Richardson *v.* Croft, 11 Fed. 800; Perry *v.* Littlefield, 2 Fed. 464; Consolidated Fruit-Jar Co. *v.* Whitney, 6 Fed. Cas. No. 3,132, 1 Ban. & A. 356, 10 Phila. (Pa.) 268; Hussey *v.* Whitely, 12 Fed. Cas. No. 6,950, 1 Bond 407, 2 Fish. Pat. Cas. 120; Potter *v.* Mack, 19 Fed. Cas. No. 11,331, 3 Fish. Pat. Cas. 428; Thompson *v.* Barry, 23 Fed. Cas. No. 13,942, 2 Wkly. Notes Cas. (Pa.) 100; Woodworth *v.* Hall, 30 Fed. Cas. No. 18,017, 2 Robb Pat. Cas. 517, 1 Woodb. & M. 389; Woodworth *v.* Rogers, 30 Fed. Cas. No. 18,018, 2 Robb Pat. Cas. 625, 3 Woodb. & M. 135.

Cases in which motion to dissolve granted see Cary *v.* Domestic Spring-Bed Co., 26 Fed. 38; Goodyear *v.* Bourn, 10 Fed. Cas. No. 5,561, 3 Blatchf. 266; Wilson *v.* Barnum, 30 Fed. Cas. No. 17,787, 2 Fish. Pat. Cas. 635, 2 Robb Pat. Cas. 749, 1 Wall. Jr. 347; Woodworth *v.* Edwards, 30 Fed. Cas. No. 18,014, 2 Robb Pat. Cas. 610, 3 Woodb. & M. 120.

50. Horton *v.* New York Cent., etc., R. Co., 63 Fed. 897; Roemer *v.* Neumann, 26 Fed. 332; Avery *v.* Wilson, 20 Fed. 856; Potter *v.* Mack, 19 Fed. Cas. No. 11,331, 3 Fish. Pat. Cas. 428; Rumford Chemical Works *v.* Hecker, 20 Fed. Cas. No. 12,134, 2 Ban. & A. 386, 11 Off. Gaz. 330; Nunn *v.* D'Albuquerque, 34 Beav. 595, 55 Eng. Reprint 765.

Although damages granted were only nominal, injunction may be granted. Du Bois *v.* Kirk, 158 U. S. 58, 15 S. Ct. 729, 39 L. ed. 895 [affirming 33 Fed. 252].

Not refused because defendant solvent see Bement *v.* National Harrow Co., 186 U. S. 70, 22 S. Ct. 747, 46 L. ed. 1058; Grant *v.* Raymond, 6 Pet. (U. S.) 218, 8 L. ed. 376; General Electric Co. *v.* Wise, 119 Fed. 922.

Not refused because defendant quits infringing see Western Electric Co. *v.* Capital Tel., etc., Co., 86 Fed. 769; Matthews, etc., Mfg. Co. *v.* National Brass, etc., Works, 71 Fed. 518; White *v.* Walbridge, 46 Fed. 526; Kane *v.* Huggins Cracker, etc., Co., 44 Fed. 287; Facer *v.* Midvale Steel-Works, 38 Fed. 231; Bullock Printing-Press Co. *v.* Jones, 4 Fed. Cas. No. 2,132, 3 Ban. & A. 195, 13 Off. Gaz. 124.

Granted although great damage to defendant see Edison Electric Light Co. *v.* United Electric Light, etc., Co., 58 Fed. 572, 7 C. C. A. 375 [affirming 57 Fed. 642].

Granted although patent about to expire see American Bell Tel. Co. *v.* Western Tel. Constr. Co., 58 Fed. 410; American Bell Tel. Co. *v.* Brown, Tel., etc., Co., 58 Fed. 409.

Granted without verdict of jury see Buchanan *v.* Howland, 4 Fed. Cas. No. 2,074, 5 Blatchf. 151, 2 Fish. Pat. Cas. 341; Good-year *v.* Day, 10 Fed. Cas. No. 5,569, 2 Wall. Jr. 283.

Against whom operative.—Permanent injunction goes against all connected with the infringing. National Mechanical Directory Co. *v.* Polk, 121 Fed. 742, 58 C. C. A. 24.

That permanent injunction means for the life of the patent see De Florez *v.* Reynolds, 8 Fed. 434, 17 Blatchf. 436.

Goods made before expiration of patent.—Injunction continues after expiration of patent as to goods made before. American Diamond Rock-Boring Co. *v.* Rutland Marble Co., 2 Fed. 356, 18 Blatchf. 146. *Contra*, Westinghouse *v.* Carpenter, 43 Fed. 894.

Cases in which injunction granted see National Folding-Box, etc., Co. *v.* Elsas, 65 Fed. 1001; American Bell Tel. Co. *v.* Globe Tel. Co., 31 Fed. 729, 24 Blatchf. 522; Odell *v.* Stout, 22 Fed. 159; Weeks *v.* Buffalo Scale Co., 11 Fed. 901; Merriam *v.* Smith, 11 Fed. 588; Pentlarge *v.* Beesten, 1 Fed. 862, 18 Blatchf. 38; Potter *v.* Whitney, 19 Fed. Cas. No. 11,341, 3 Fish. Pat. Cas. 77, 1 Lowell 87.

51. Marden *v.* Campbell Printing-Press, etc., Co., 79 Fed. 653, 25 C. C. A. 142; Many *v.* Sizer, 16 Fed. Cas. No. 9,057, 1 Fish. Pat. Cas. 31.

Permanent injunction refused where not necessary and allowance injurious to public. —Campbell Printing-Press, etc., Co. *v.* Manhattan R. Co., 49 Fed. 930; Ballard *v.* Pittsburg, 12 Fed. 783; Bliss *v.* Brooklyn, 3



any person, except perhaps a defendant served with the bill of complaint, where it refers merely to the bill for a description of the thing enjoined.<sup>52</sup>

(ii) *KNOWLEDGE OR NOTICE.* According to the modern practice, actual service of an order of injunction upon the person sought to be restrained from infringing a patent is not requisite to lay the foundation of a proceeding against him for contempt,<sup>53</sup> actual notice of such order of injunction being deemed sufficient.<sup>54</sup>

(iii) *WHO LIABLE.* Defendants as individuals are in contempt if they organize a company and continue infringement,<sup>55</sup> and it is the duty of a defendant enjoined from making or selling a patented article to take such steps as will prevent violation of the injunction by employees, and a fine will be imposed for contempt where the injunction is violated by employees.<sup>56</sup> One who knowingly assists another in violating an injunction is guilty of contempt.<sup>57</sup> An officer of defendant corporation who continues infringement individually after injunction is guilty of contempt.<sup>58</sup> A person pending suit is not bound to obey an injunction not directed to him.<sup>59</sup>

(iv) *ACTS OR CONDUCT CONSTITUTING VIOLATION.* Although the command of an injunction against the infringement of a patent must be explicitly obeyed, yet it is the spirit and not the letter of the injunction which must be obeyed;<sup>60</sup> hence, no subterfuge amounting to a substantial violation of the injunction will be allowed to succeed merely because not contrary to the letter of the prohibitory clause.<sup>61</sup> Advertising for sale articles which have been adjudged infringements

Fed. Cas. No. 1,544, 8 Blatchf. 533, 4 Fish. Pat. Cas. 596.

52. Whipple v. Hutchinson, 29 Fed. Cas. No. 17,517, 4 Blatchf. 190.

53. Christensen Engineering Co. v. Westinghouse Air-Brake Co., 135 Fed. 774, 68 C. C. A. 476.

54. Christensen Engineering Co. v. Westinghouse Air-Brake Co., 135 Fed. 774, 68 C. C. A. 476. See also Dowagiac Mfg. Co. v. Minnesota Moline Plow Co., 124 Fed. 736 [affirmed in 129 Fed. 1005, 64 C. C. A. 122].

*Injunction ordered but not issued.*—The rule is that where an injunction against the infringement of a patent has been ordered, a party who, having knowledge of that order, deliberately violates the injunction ordered, although not yet issued, is guilty of contempt of court. Dowagiac Mfg. Co. v. Minnesota Moline Plow Co., 124 Fed. 736 [affirmed in 129 Fed. 1005, 64 C. C. A. 122], holding, however, that, in order to convict a person of contempt under such circumstances, it must be shown clearly that he had knowledge of the order of the injunction in such a way that it can be held that he understood it, and with that knowledge committed wilful violation of the order.

55. Diamond Drill, etc., Co. v. Kelley, 130 Fed. 893; Iowa Barb Steel-Wire Co. v. Southern Barbed-Wire Co., 30 Fed. 123.

56. Westinghouse Air Brake Co. v. Christensen Engineering Co., 121 Fed. 562; Mundy v. Lidgerwood Mfg. Co. 34 Fed. 541; Phillips v. Detroit, 19 Fed. Cas. No. 11,101, 3 Ban. & A. 150, 2 Flipp. 92, 16 Off. Gaz. 627; Potter v. Muller, 19 Fed. Cas. No. 11,333, 1 Bond 601, 2 Fish. Pat. Cas. 631.

57. Hamilton v. Diamond Drill, etc., Co., 137 Fed. 417, 69 C. C. A. 532; Diamond Drill, etc., Co. v. Kelley, 132 Fed. 978, 130 Fed. 893; Welsbach Light Co. v. Daylight Incandescent Gaslight Co., 97 Fed. 950; Goodyear

v. Mullee, 10 Fed. Cas. No. 5,577, 5 Blatchf. 429, 3 Fish. Pat. Cas. 209.

*Illustrations.*—One who with knowledge of an injunction enjoining certain persons from infringement takes over their business and continues it in collusion with them is guilty of contempt. Hamilton v. Diamond Drill, etc., Co., 137 Fed. 417, 69 C. C. A. 532; Diamond Drill, etc., Co. v. Kelley, 132 Fed. 978, 130 Fed. 893. Assisting another infringer in a suit contesting the validity of the patent is contempt. Bate Refrigerating Co. v. Gillett, 30 Fed. 683.

58. Janney v. Pancoast International Ventilator Co., 124 Fed. 972; Stahl v. Ertel, 62 Fed. 920; Poppenhusen v. Falke, 19 Fed. Cas. No. 11,279, 4 Blatchf. 493, 2 Fish. Pat. Cas. 181; Wetherill v. New Jersey Zinc Co., 29 Fed. Cas. No. 17,463, 1 Ban. & A. 105, 5 Off. Gaz. 460.

*A person acting only officially is not liable.* Phillips v. Detroit, 19 Fed. Cas. No. 11,101, 3 Ban. & A. 150, 2 Flipp. 92, 16 Off. Gaz. 627.

59. Bate Refrigerating Co. v. Gillett, 30 Fed. 685.

60. Bate Refrigerating Co. v. Gillett, 30 Fed. 683.

61. Bate Refrigerating Co. v. Gillett, 30 Fed. 683; Burr v. Kimbark, 2 Fed. 428; Colgate v. Gold, etc., Tel. Co., 6 Fed. Cas. No. 2,992, 4 Ban. & A. 559, 17 Off. Gaz. 193; Craig v. Fisher, 6 Fed. Cas. No. 3,332, 2 Sawy. 345; Hamilton v. Simons, 11 Fed. Cas. No. 5,991, 5 Biss. 77; Phillips v. Detroit, 19 Fed. Cas. No. 11,101, 3 Ban. & A. 150, 2 Flipp. 92, 16 Off. Gaz. 627; Potter v. Muller, 19 Fed. Cas. No. 11,333, 1 Bond 601, 2 Fish. Pat. Cas. 631. And see Victor Talking Mach. Co. v. Leeds, etc., Co., 150 Fed. 147.

*Illustrations.*—Where the principle involved in a patent is the point in issue in a suit to restrain its infringement, defendant



of complainant's patent, and the sale of which has been enjoined, does not in itself constitute a breach of the injunction;<sup>62</sup> but advertising the articles enjoined, in defiance of the precise terms of the injunction, is strong evidence of the violation of the injunction, and requires positive proof on the part of defendant to the contrary.<sup>63</sup> An injunction against the sale of an infringing article is violated by the sale of such article outside of the territorial jurisdiction of the court granting the injunction, whether the article was sent within such jurisdiction or not.<sup>64</sup>

(v) *DEFENSES*. The fact that the writ was erroneously granted furnishes no excuse for its violation,<sup>65</sup> the remedy in such case being by appeal or writ of error.<sup>66</sup> Temptation due to financial straits is no excuse for violation of an injunction,<sup>67</sup> nor is the advice of counsel,<sup>68</sup> nor good faith or absence of intention to infringe,<sup>69</sup> nor a misnomer in the injunction.<sup>70</sup> So the fact that the infringing machine is made according to a junior patent is no excuse.<sup>71</sup> That the injunction was granted upon a patent which has since been materially altered by disclaimer constitutes a defense to the proceeding.<sup>72</sup> And an injunction against the infringement of a patent for an invention consisting of the combination of known appliances is not violated by using the combination after the expiration of the patent.<sup>73</sup>

(vi) *PROCEEDINGS TO PUNISH*—(A) *Notice*. Generally the rule obtains that, before a party who has violated an injunction against infringing a patent can be punished for contempt, it must appear that he has been served with notice of the proceedings therefor.<sup>74</sup>

commits a breach of a preliminary injunction and is punishable for contempt where, for the purpose of evading the injunction, he continues to manufacture articles involving the same principle, with but slight modifications of structure. *Burr v. Kimbark*, 29 Fed. 428. Where a party who has been enjoined from infringing a patent by manufacturing or selling the infringing article continues to sell as the agent of another, he is guilty of contempt, and is liable to attachment. *Potter v. Muller*, 19 Fed. Cas. No. 11,333, 1 Bond 601, 2 Fish. Pat. Cas. 631.

62. *Dowagiac Mfg. Co. v. Minnesota Moline Plow Co.*, 124 Fed. 736. See also *Allis v. Stowell*, 19 Off. Gaz. 727.

63. *Stahl v. Ertel*, 62 Fed. 920.

64. *Macaulay v. White Sewing Mach. Co.*, 9 Fed. 698.

Sending infringing article to foreign country or selling it there.—A sale in Canada, to be there used, of articles patented by letters patent of the United States, Canada being a territory in which the patentee had no exclusive right, cannot be regarded as in contempt of an injunction not in future to make or sell in violation of the patent. *Gould v. Sessions*, 67 Fed. 163, 14 C. C. A. 366. And the making and selling of a single element of a patented combination, with the purpose and expectation that such element should be sent to a foreign country, and be there used in combination with other elements, or in the practice of a method covered by the patent, is not contributory infringement, inasmuch as there was no intent that the elements should be put to an infringing use, the protection of the patent not extending beyond the limits of the United States. *Bullock Electric, etc., Co. v. Westinghouse, etc., Co.*, 129 Fed. 105, 63 C. C. A. 607.

65. *Roemer v. Newman*, 19 Fed. 98; *Craig v. Fisher*, 6 Fed. Cas. No. 3,332, 2 Sawy.

345; *Phillips v. Detroit*, 19 Fed. Cas. No. 11,101, 3 Ban. & A. 150, 2 Flipp. 92, 16 Off. Gaz. 627; *Valentine v. Reynolds*, 28 Fed. Cas. No. 16,813; *Whipple v. Hutchinson*, 29 Fed. Cas. No. 17,517, 4 Blatchf. 190.

66. *Craig v. Fisher*, 6 Fed. Cas. No. 3,332, 2 Sawy. 345.

67. *A. B. Dick Co. v. Henry*, 88 Fed. 80.

68. *Calculagraph Co. v. Wilson*, 136 Fed. 196; *Paxton v. Brinton*, 126 Fed. 542; *Bowers v. Pacific Coast Dredging, etc., Co.*, 99 Fed. 745; *Bate Refrigerating Co. v. Gillett*, 30 Fed. 683; *Burr v. Kimbark*, 29 Fed. 428. *Contra*, *Goss Printing Press Co. v. Scott*, 134 Fed. 880; *Hamilton v. Simons*, 11 Fed. Cas. No. 5,991, 5 Biss. 77.

Judgment of court.—Defendant should get the judgment of the court whether changes made avoid infringement. *Bowers v. Pacific Coast Dredging, etc., Co.*, 99 Fed. 745; *Hamilton v. Simons*, 11 Fed. Cas. No. 5,991, 5 Biss. 77.

69. *Bate Refrigerating Co. v. Gillett*, 30 Fed. 683. And see *Robinson v. S. & B. Lederer Co.*, 146 Fed. 993.

Trivial violation.—One will not be punished for the violation of an injunction restraining the use of articles infringing a patent when he has made an honest effort to remove the offending articles from the premises where they were used, although, by oversight, a few articles remain. *Edison Electric Light Co. v. Goet*, 65 Fed. 612.

70. *Dickerson v. Armstrong*, 94 Fed. 864.

71. *Norton v. Eagle Automatic Can Co.*, 59 Fed. 137. And see *Valentine v. Reynolds*, 28 Fed. Cas. No. 16,813.

72. *Dudgeon v. Thomson*, 3 App. Cas. 34.

73. *Johnson v. Brooklyn, etc., R. Co.*, 37 Fed. 147, 2 L. R. A. 489.

74. *Christensen Engineering Co. v. Westinghouse Air-Brake Co.*, 135 Fed. 774, 68



(B) *Evidence.* The rules of evidence governing in proceedings to punish the violation of injunctions in general apply to proceedings to punish the violation of injunctions in patent cases.<sup>75</sup>

(c) *Hearing and Determination.* On the hearing of the motion the question as to whether the machine constructed is the same as the old one enjoined is one of fact to be determined on the evidence.<sup>76</sup> Where a court issues an injunction to prevent the infringement of a patent solely upon the authority of a decision in another circuit, in a suit between the same parties, it will, on the hearing of a motion for an attachment for contempt in violating the injunction, follow the construction which was placed upon the patent in such other circuit.<sup>77</sup> If the violation of an injunction against the infringing of a patent, either as to its character or the fact of its commission, is doubtful upon the proofs, the court will remit the party to his right to file a supplemental bill in the original suit,<sup>78</sup> or to institute a new and plenary action.<sup>79</sup> However, where the violation of an injunction is wilful, the summary method of correction is imperative, and will not be arrested by the fact that the proofs of violation are conflicting, or that the things used by defendant are in some respects different from those interdicted.<sup>80</sup> A

C. C. A. 476, holding, however, that where notice of the commencement of contempt proceedings was properly given to defendant's attorney, and, under order of court, notice of the application for attachment and a copy of the affidavits to be issued thereon, were sent to defendant by registered mail and returned marked "Refused," defendant not having controverted the charge of contempt, an objection that the notice of the proceeding was not properly served is not well taken.

75. See INJUNCTIONS, 22 Cyc. 1023.

**Presumptions.**—Machines designated by the same name and made by the same company as the machines containing infringing devices, the manufacture and sale of which were enjoined, will be presumed to be the same, in the absence of any denial, in proceedings to punish a violation of the injunction. *Stahl v. Ertel*, 62 Fed. 920. Defendant, four months before the service of an injunction on him, executed a bond to plaintiff, acknowledging the validity of his patent and his right to all that was granted by it. It was held that the bond was no evidence of a breach of the injunction further than the recital that defendant had infringed the patent might have a tendency to establish such breach, and that the inference of presumption arising from it might be overcome by credible and positive testimony, proving no infringement. *Byam v. Eddy*, 4 Fed. Cas. No. 2,263, 2 Blatchf. 521, 24 Vt. 666.

**Burden of proof.**—The burden of proof establishing the violation of the injunction rests with complainant. *Accumulator Co. v. Consolidated Electric Storage Co.*, 53 Fed. 793.

**Admissibility.**—On a motion for attachment for contempt for violating an injunction issued to restrain the infringement of a patent, after a construction has been given to a patent by the court, no testimony is admissible to vary such construction. *Burdett v. Estey*, 4 Fed. Cas. No. 2,146, 4 Ban. & A. 141, 16 Blatchf. 105. Affidavits to show

that the patentee was not the first and original inventor of the thing patented are immaterial and irrelevant. *Whipple v. Hutchinson*, 29 Fed. Cas. No. 17,517, 4 Blatchf. 190. It is a matter of discretion whether the court will receive expert testimony on the question of infringement, or will examine the alleged infringing articles for itself. *Burdett v. Estey*, *supra*.

**Weight and sufficiency.**—The evidence of a breach of an injunction must be clear to authorize punishment therefor. *Woodruff v. North Bloomfield Gravel Min. Co.*, 45 Fed. 129; *Smith v. Halkyard*, 19 Fed. 602; *Birdsell v. Hagerstown Agricultural Implement Mfg. Co.*, 3 Fed. Cas. No. 1,436, 2 Ban. & A. 519, 1 Hughes 59, 11 Off. Gaz. 420.

76. *Birdsell v. Hagerstown Agricultural Implement Mfg. Co.*, 3 Fed. Cas. No. 1,436, 2 Ban. & A. 519, 1 Hughes 59, 11 Off. Gaz. 420.

77. *Accumulator Co. v. Consolidated Electric Storage Co.*, 53 Fed. 793.

78. *Enterprise Mfg. Co. v. Sargent*, 48 Fed. 453; *Allis v. Stowell*, 15 Fed. 242.

79. *U. S. Playing-Card Co. v. Spalding*, 93 Fed. 822; *Enterprise Mfg. Co. v. Sargent*, 48 Fed. 453; *Truax v. Detweiler*, 46 Fed. 117; *Pennsylvania Diamond-Drill Co. v. Simpson*, 39 Fed. 284; *Temple Pump Co. v. Goss Pump, etc., Co.*, 31 Fed. 292; *Wirt v. Brown*, 30 Fed. 187; *Allis v. Stowell*, 15 Fed. 242; *Bate Refrigerating Co. v. Eastman*, 11 Fed. 902; *Putnam v. Hollender*, 11 Fed. 75; *Liddle v. Cory*, 15 Fed. Cas. No. 8,338, 7 Blatchf. 1. A consent decree against defendant for damages and a perpetual injunction is not such a general decree in favor of complainant as will allow him to obtain an attachment for violation of the injunction upon motion, but if he desires to enjoin the alleged infringement it must be done by a bill in the usual way. *Howard v. Mast, etc., Co.*, 33 Fed. 867; *Highby v. Columbia Rubber Co.*, 18 Fed. 601.

80. *Wetherill v. New Jersey Zinc Co.*, 29 Fed. Cas. No. 17,463, 1 Ban. & A. 105, 5 Off. Gaz. 460.



motion for an attachment may be denied without prejudice to the rights of the same question of infringement on the accounting under the interlocutory decree.<sup>81</sup>

(vii) *PUNISHMENT*—(A) *Matters Considered in Mitigation*. The fact that the injunction was erroneously issued may be considered in mitigation of punishment,<sup>82</sup> as may the fact that the acts in violation were without intention to disobey the injunction.<sup>83</sup>

(B) *Amount of Fine*. The amount of the fine assessed for the violation of the injunction is within the sound discretion of the court.<sup>84</sup> As contempt in the violation of injunctions in a patent case is a criminal offense, the fine should bear a just proportion to the magnitude of the offense, and ought not in general to exceed such amount as would ordinarily be imposed as a fine when paid over to the government.<sup>85</sup> A light fine will be imposed where the violation was probably unintentional.<sup>86</sup>

(c) *Distribution of Fine*. The court may direct payment to the complainant of a part or all of the fine imposed, as a compensation for his time and outlay in prosecuting the application;<sup>87</sup> but the court will not compensate complainant for any profits or damages resulting from the infringement involved in the violation of the injunction.<sup>88</sup>

(viii) *COSTS*. Where the injunction has been violated, and defendant is protected from the consequences only by a defect in the service of the writ, no costs will be allowed to him on denial of a motion for an attachment for such violation.<sup>89</sup>

12. DAMAGES AND PROFITS<sup>90</sup>—a. *Damages in Actions at Law*—(i) *RIGHT TO RECOVER AND FORM OF ACTION*. Damages for the infringement of a patent may be recovered by an action at law,<sup>91</sup> the proper action being trespass on the case.<sup>92</sup>

(ii) *AMOUNT RECOVERABLE*—(A) *In General*. Plaintiff is entitled to a verdict only for the actual damages sustained by him because of and during the time of the infringement for which the suit was brought,<sup>93</sup> and not to exemplary

81. *Burdett v. Estey*, 4 Fed. Cas. No. 2,146, 4 Ban. & A. 141, 16 Blatchf. 105.

82. *Westinghouse Air-Brake Co. v. Christensen Engineering Co.*, 128 Fed. 749.

83. *In re De Forest Wireless Tel. Co.*, 154 Fed. 81; *Norton v. Eagle Automatic Can Co.*, 59 Fed. 137; *Morris v. Domestic Sewing-Mach. Co.*, 38 Fed. 482; *Bate Refrigerating Co. v. Gillett*, 30 Fed. 683; *Iowa Barb Steel-Wire Co. v. Southern Barbed-Wire Co.*, 30 Fed. 615; *Carstaedt v. U. S. Corset Co.*, 5 Fed. Cas. No. 2,468, 2 Ban. & A. 331, 13 Blatchf. 371, 10 Off. Gaz. 3; *Phillips v. Detroit*, 19 Fed. Cas. No. 11,101, 3 Ban. & A. 150, 2 Flipp. 92, 16 Off. Gaz. 627. See also *Goodyear v. Mullee*, 10 Fed. Cas. No. 5,577, 5 Blatchf. 429, 3 Fish. Pat. Cas. 209.

84. *Morris v. Domestic Sewing-Mach. Co.*, 38 Fed. 482; *Iowa Barb Steel-Wire Co. v. Southern Barbed-Wire Co.*, 30 Fed. 615; *Carstaedt v. U. S. Corset Co.*, 5 Fed. Cas. No. 2,468, 2 Ban. & A. 331, 13 Blatchf. 371, 10 Off. Gaz. 3.

85. *Searls v. Worden*, 13 Fed. 716.

86. *Frank v. Bernard*, 146 Fed. 137.

87. *Christensen Engineering Co. v. Westinghouse Air-Brake Co.*, 135 Fed. 774, 68 C. C. A. 476; *Cary Mfg. Co. v. Acme Flexible Clasp Co.*, 108 Fed. 873, 48 C. C. A. 118; *Macaulay v. White Sewing Mach. Co.*, 9 Fed. 698.

88. *Dowagiac Mfg. Co. v. Minnesota Moline Plow Co.*, 124 Fed. 735, 61 C. C. A. 57

[affirmed in 129 Fed. 1005, 64 C. C. A. 122]; *Macaulay v. White Sewing Mach. Co.*, 9 Fed. 698. But see *Searls v. Worden*, 13 Fed. 716.

89. *Whipple v. Hutchinson*, 29 Fed. Cas. No. 17,517, 4 Blatchf. 190.

90. Damages generally see DAMAGES.

91. U. S. Rev. St. (1878) § 4919 [U. S. Comp. St. (1901) p. 3394]; *Birdsall v. Coolidge*, 93 U. S. 64, 23 L. ed. 802; *Harper, etc., Co. v. Wilgus*, 56 Fed. 587, 6 C. C. A. 45; *Bragg v. Stockton*, 27 Fed. 509; *Livingston v. Jones*, 15 Fed. Cas. No. 8,414, 2 Fish. Pat. Cas. 207, 3 Wall. Jr. 330 [reversed on other grounds in 1 Wall. 155, 17 L. ed. 662].

92. U. S. Rev. St. (1878) § 4919 [U. S. Comp. St. (1901) p. 3394]; *Byam v. Bullard*, 4 Fed. Cas. No. 2,262, 1 Curt. 100; *Stein v. Goddard*, 22 Fed. Cas. No. 13,353, McAllister 82.

93. *Birdsall v. Coolidge*, 93 U. S. 64, 23 L. ed. 802; *Lee v. Pillsbury*, 49 Fed. 747; *National Car-Brake Shoe Co. v. Terre Haute Car, etc., Co.*, 19 Fed. 514; *Allen v. Blunt*, 1 Fed. Cas. No. 217, 2 Robb Pat. Cas. 530, 2 Woodb. & M. 121; *Carter v. Baker*, 5 Fed. Cas. No. 2,472, 4 Fish. Pat. Cas. 404, 1 Sawy. 512; *Hayden v. Suffolk Mfg. Co.*, 11 Fed. Cas. No. 6,261, 4 Fish. Pat. Cas. 86 [affirmed in 3 Wall. 315, 18 L. ed. 761]; *Ransom v. New York*, 20 Fed. Cas. No. 11,573, 1 Fish. Pat. Cas. 252; *Smith v. Higgins*, 22 Fed. Cas. No. 13,057.

No damages for use before patent are al-



damages.<sup>94</sup> Damages are to be measured by the actual loss to plaintiff,<sup>95</sup> which must be shown.<sup>96</sup> It may be shown by any means which will best establish the loss.<sup>97</sup>

lowable. *Brodie v. Ophir Silver Min. Co.*, 4 Fed. Cas. No. 1,919, 4 Fish. Pat. Cas. 137, 5 Sawy. 808.

On reissue no damages before date of reissue are allowable. *Agawam Woolen Co. v. Jordan*, 7 Wall. (U. S.) 583, 19 L. ed. 177.

Damages limited to direct effect and the use of the particular invention patented see *Carter v. Baker*, 5 Fed. Cas. No. 2,472, 4 Fish. Pat. Cas. 404, 1 Sawy. 512.

94. *Buck v. Hermance*, 4 Fed. Cas. No. 2,082, 1 Blatchf. 398, Fish. Pat. Rep. 251; *Hall v. Wiles*, 11 Fed. Cas. No. 5,954, 2 Blatchf. 194, Fish. Pat. Rep. 433; *McCormick v. Seymour*, 15 Fed. Cas. No. 8,727, 3 Blatchf. 209; *Pitts v. Hall*, 19 Fed. Cas. No. 11,192, 2 Blatchf. 229, Fish. Pat. Rep. 441; *Washburn v. Gould*, 29 Fed. Cas. No. 17,214, 2 Robb Pat. Cas. 206, 3 Story 122; *Whittemore v. Cutter*, 29 Fed. Cas. No. 17,601, 1 Gall. 478, 1 Robb Pat. Cas. 40. *Contra*, *Parker v. Corbin*, 18 Fed. Cas. No. 10,731, 4 McLean 462, 2 Robb Pat. Cas. 736.

95. *Birdsall v. Coolidge*, 93 U. S. 64, 23 L. ed. 802; *Cassidy v. Hunt*, 75 Fed. 1012; *Lee v. Pillsbury*, 49 Fed. 747; *Earle v. Sawyer*, 8 Fed. Cas. No. 4,247, 4 Mason 1, 1 Robb Pat. Cas. 490; *Goodyear v. Bishop*, 10 Fed. Cas. No. 5,559, 2 Fish. Pat. Cas. 154; *La Baw v. Hawkins*, 14 Fed. Cas. No. 7,961, 2 Ban. & A. 561; *McComb v. Brodie*, 15 Fed. Cas. No. 8,708, 5 Fish. Pat. Cas. 384, 1 Woods 153, 2 Off. Gaz. 117; *Whittemore v. Cutter*, 29 Fed. Cas. No. 17,601, 1 Gall. 478, 1 Robb Pat. Cas. 40; *United Horseshoe, etc., Co. v. Stewart*, 13 App. Cas. 401, 59 L. T. Rep. N. S. 561.

Profits which plaintiff may have made but for the infringement are the damages recoverable. *McCormick v. Seymour*, 15 Fed. Cas. No. 8,726, 2 Blatchf. 240 [reversed in part in 16 How. 480, 14 L. ed. 1024], 15 Fed. Cas. No. 8,727, 3 Blatchf. 209 [affirmed in 19 How. 96, 15 L. ed. 557]; *Rice v. Heald*, 20 Fed. Cas. No. 11,752 [reversed on other grounds in 104 U. S. 737, 26 L. ed. 910]. Damages include not only the loss upon the patented device but the loss of other profits which would have accompanied it. *Haves v. Washburne*, 11 Fed. Cas. No. 6,242, 5 Off. Gaz. 491.

Where plaintiff did not mark his articles "patented" nominal damages only are recoverable. *McComb v. Brodie*, 15 Fed. Cas. No. 8,708, 5 Fish. Pat. Cas. 384, 1 Woods 153, 2 Off. Gaz. 117.

Where employee innocently infringes damages are nominal. *Bryce v. Dorr*, 4 Fed. Cas. No. 2,070, 3 McLean 582, 2 Robb Pat. Cas. 302.

Making invention without using it gives only nominal damages. *Whittemore v. Cutter*, 29 Fed. Cas. No. 17,601, 1 Gall. 478, 1 Robb Pat. Cas. 40.

Where there is no established license-fee and no use of the invention save by defendant there is no loss to plaintiff and only

nominal damages can be awarded. *Seattle v. McNamara*, 81 Fed. 863, 26 C. C. A. 652.

Where there is no damage or loss suit will not lie. *Byam v. Bullard*, 4 Fed. Cas. No. 2,262, 1 Curt. 100.

Part of machine covered by patent.—The estimation of damages must be confined to the particular part of the machine covered by the patent upon which suit is brought. *McCreary v. Pennsylvania Canal Co.*, 141 U. S. 459, 12 S. Ct. 40, 35 L. ed. 817; *Fischer v. Hayes*, 22 Fed. 529; *Burdell v. Denig*, 4 Fed. Cas. No. 2,142, 2 Fish. Pat. Cas. 588; *Carter v. Baker*, 5 Fed. Cas. No. 2,472, 4 Fish. Pat. Cas. 404, 1 Sawy. 512; *Wayne v. Holmes*, 29 Fed. Cas. No. 17,303, 1 Bond 27, 2 Fish. Pat. Cas. 20.

Entire damage may be assessed where the entire value is due to the patented feature. *Hunt Bros Fruit-Packing Co. v. Cassidy*, 64 Fed. 585, 12 C. C. A. 316; *Fifield v. Whittemore*, 33 Fed. 835.

Injury to business by unfair competition not included in damages. *Stephens v. Felt*, 22 Fed. Cas. No. 13,368a; *United Horse Shoe, etc., Co. v. Stewart*, 13 App. Cas. 401, 59 L. T. Rep. N. S. 561. But see *American-Braided Wire Co. v. Thomson*, 44 Ch. D. 274, 59 L. J. Ch. 425, 62 L. T. Rep. N. S. 616 [reversing 38 Wkly. Rep. 329].

Damages for separate patents sued on need not be apportioned. *Timken v. Olin*, 41 Fed. 169.

96. *Robertson v. Blake*, 94 U. S. 728, 24 L. ed. 245; *Philp v. Nock*, 17 Wall. (U. S.) 460, 21 L. ed. 679; *Singer Mfg. Co. v. Cramer*, 109 Fed. 652, 48 C. C. A. 588; *Lee v. Pillsbury*, 49 Fed. 747. See also *infra*, XIII, C, 14, b.

Where the amount of actual loss is not shown, nominal damages only can be awarded. *Coupe v. Royer*, 155 U. S. 565, 15 S. Ct. 199, 39 L. ed. 263; *New York v. Ransom*, 23 How. (U. S.) 487, 16 L. ed. 515; *Boston v. Allen*, 91 Fed. 248, 33 C. C. A. 485; *Houston, etc., R. Co. v. Stern*, 74 Fed. 636, 20 C. C. A. 568; *Hunt Bros. Fruit-Packing Co. v. Cassidy*, 53 Fed. 257, 3 C. C. A. 525; *Lee v. Pillsbury*, 49 Fed. 747; *Royer v. Schultz Belting Co.*, 45 Fed. 51 [affirmed in 154 U. S. 515, 14 S. Ct. 1152, 38 L. ed. 1075]; *National Car-Brake Shoe Co. v. Terre Haute Car, etc., Co.*, 19 Fed. 514; *Proctor v. Brill*, 4 Fed. 415; *Burdell v. Denig*, 4 Fed. Cas. No. 2,142, 2 Fish. Pat. Cas. 588; *Poppenhusen v. New York Gutta Percha Comb Co.*, 19 Fed. Cas. No. 11,283, 2 Fish. Pat. Cas. 62; *Rollhaus v. McPherson*, 20 Fed. Cas. No. 12,026; *Smith v. Higgins*, 22 Fed. Cas. No. 13,058.

97. *Suffolk Mfg. Co. v. Hayden*, 3 Wall. (U. S.) 315, 18 L. ed. 76; *Singer Mfg. Co. v. Cramer*, 109 Fed. 652, 48 C. C. A. 588; *Hunt Bros. Fruit Packing Co. v. Cassidy*, 64 Fed. 585, 12 C. C. A. 316; *Lee v. Pillsbury*, 49 Fed. 747; *Goodyear v. Bishop*, 10 Fed. Cas. No. 5,559, 2 Fish. Pat. Cas. 154; *Berdon Fire-Arms Mfg. Co. v. U. S.*, 26 Ct. Cl. 48



License-fees charged others may be used as guides.<sup>98</sup> Where there is no other means of estimating damages the profits derived by the infringer may be considered,<sup>99</sup>

[affirmed in 156 U. S. 552, 15 S. Ct. 420, 39 L. ed. 530]; *McKeever v. U. S.*, 14 Ct. Cl. 396.

Where patentee does not license others but manufacturers, it is to be presumed that he would have made all infringing sales. *Rose v. Hirsh*, 94 Fed. 177, 36 C. C. A. 132. It will not be presumed, however, that plaintiff would have sold the same number as infringer at a higher price. *Jennings v. Rogers Silver Plate Co.*, 118 Fed. 339.

Evidence of settlement with others not competent nor is royalty paid by defendant to others. *International Tooth Crown Co. v. Hank's Dental Assoc.*, 111 Fed. 916; *Ewart Mfg. Co. v. Baldwin Cycle-Chain Co.*, 91 Fed. 262; *Westcott v. Rude*, 19 Fed. 830; *National Car-Brake Shoe Co. v. Terre Haute Car, etc.*, Co., 19 Fed. 514.

Prior judgment upon different evidence does not fix value. *Blake v. Greenwood Cemetery*, 16 Fed. 676, 21 Blatchf. 222.

98. Established license-fees may be taken as the measure of damages.—*Clark v. Wooster*, 119 U. S. 322, 7 S. Ct. 217, 30 L. ed. 392; *Washington, etc., Steam Packet Co. v. Sickles*, 19 Wall. (U. S.) 611, 22 L. ed. 203; *Philp v. Nock*, 17 Wall. (U. S.) 460, 21 L. ed. 679; *Seymour v. McCormick*, 16 How. (U. S.) 480, 14 L. ed. 1024; *Hogg v. Emerson*, 11 How. (U. S.) 587, 13 L. ed. 824; *Leeds, etc., Co. v. Victor Talking Mach. Co.*, 154 Fed. 58, 83 C. C. A. 170; *Cassidy v. Hunt*, 75 Fed. 1012; *Houston, etc., R. Co. v. Stern*, 74 Fed. 636, 20 C. C. A. 568; *Timken v. Olin*, 41 Fed. 169; *McDonald v. Whitney*, 39 Fed. 466; *Cary v. Lovell Mfg. Co.*, 37 Fed. 654; *May v. Fond du Lac County*, 27 Fed. 691; *Graham v. Geneva Lake Crawford Mfg. Co.*, 24 Fed. 642; *Wooster v. Simonson*, 20 Fed. 316; *National Car-Brake Shoe Co. v. Terre Haute Car, etc., Co.*, 19 Fed. 514; *Emerson v. Simm*, 8 Fed. Cas. No. 4,443, 6 Fish. Pat. Cas. 281, 3 Off. Gaz. 293; *Goodyear v. Bishop*, 10 Fed. Cas. No. 5,559, 2 Fish. Pat. Cas. 154; *Livingston v. Jones*, 15 Fed. Cas. No. 8,414, 2 Fish. Pat. Cas. 207, 3 Wall. Jr. 330 [reversed on other grounds in 1 Wall. 155, 17 L. ed. 662]; *McCormick v. Seymour*, 15 Fed. Cas. No. 8,727, 3 Blatchf. 209; *Sanders v. Logan*, 21 Fed. Cas. No. 12,295, 2 Fish. Pat. Cas. 167, 8 Pittsb. Leg. J. (Pa.) 361; *Star Salt Caster Co. v. Crossman*, 22 Fed. Cas. No. 13,320, 4 Ban. & A. 566; *Penn v. Jack*, L. R. 5 Eq. 81, 37 L. J. Ch. 136, 17 L. T. Rep. N. S. 407, 16 Wkly. Rep. 243; *United Tel. Co. v. Walker*, 56 L. T. Rep. N. S. 508. But a license-fee is not an arbitrary guide and need not be followed unless circumstances warrant it. *Birdsall v. Coolidge*, 93 U. S. 64, 23 L. ed. 802; *Keller v. Stolzenbaugh*, 43 Fed. 378; *Colgate v. Western Electric Co.*, 28 Fed. 146; *Wooster v. Thornton*, 26 Fed. 274 [affirmed in 136 U. S. 651, 10 S. Ct. 1074, 34 L. ed. 550]; *Campbell v. Barclay*, 4 Fed. Cas. No. 2,353, 5 Biss. 179; *Sickels v. Borden*, 23 Fed. Cas. No. 13,832, 3 Blatchf. 535.

To serve as a guide the license-fees must be established and uniform and made under such circumstances as to indicate the real value. *Rude v. Westcott*, 130 U. S. 152, 9 S. Ct. 463, 32 L. ed. 888; *International Tooth Crown Co. v. Hank's Dental Assoc.*, 111 Fed. 916; *Royer v. Shultz Belting Co.*, 45 Fed. 51 [affirmed in 154 U. S. 515, 14 S. Ct. 1152, 38 L. ed. 1075]; *Hammacher v. Wilson*, 32 Fed. 796; *Bates v. St. Johnsbury, etc., R. Co.*, 32 Fed. 628; *Graham v. Geneva Lake Crawford Mfg. Co.*, 24 Fed. 642; *Westcott v. Rude*, 19 Fed. 830; *National Car-Brake Shoe Co. v. Terre Haute Car, etc., Co.*, 19 Fed. 514; *Bussey v. Excelsior Co.*, 1 Fed. 640, 1 McCrary 161 [reversed on other grounds in 110 U. S. 131, 4 S. Ct. 38, 28 L. ed. 95]; *Judson v. Bradford*, 14 Fed. Cas. No. 7,564, 3 Ban. & A. 539, 16 Off. Gaz. 171.

Fee may be regarded as fixed, although exceptions sometimes made. *Asmus v. Freeman*, 34 Fed. 902.

Where it includes other inventions, the license-fee is no guide. *Vulcanite Pavement Co. v. American Artificial Stone Pavement Co.*, 36 Fed. 378; *Willimantic Linen Co. v. Clark Thread Co.*, 27 Fed. 865; *Porter Needle Co. v. National Needle Co.*, 23 Fed. 829; *Wooster v. Simonson*, 16 Fed. 680.

Unless plaintiff would have made the sales, the rule as to license-fees is not applied. *La Baw v. Hawkins*, 14 Fed. Cas. No. 7,961, 2 Ban. & A. 561.

99. *Cassidy v. Hunt*, 75 Fed. 1012; *Brickill v. Baltimore*, 60 Fed. 98, 8 C. C. A. 500; *Royer v. Coupe*, 29 Fed. 358; *Bell v. Phillips*, 3 Fed. Cas. No. 1,262; *Campbell v. Barclay*, 4 Fed. Cas. No. 2,353, 5 Biss. 179; *Case v. Brown*, 5 Fed. Cas. No. 2,488, 1 Biss. 382, 2 Fish. Pat. Cas. 268; *Conover v. Rapp*, 6 Fed. Cas. No. 3,124, 4 Fish. Pat. Cas. 57; *Grant v. —*, 10 Fed. Cas. No. 5,701; *Page v. Ferry*, 18 Fed. Cas. No. 10,662, 1 Fish. Pat. Cas. 298; *Parker v. Banker*, 18 Fed. Cas. No. 10,725, 6 McLean 631; *Parker v. Perkins*, 18 Fed. Cas. No. 10,745; *Pitts v. Hall*, 19 Fed. Cas. No. 11,192, 2 Blatchf. 229, 2 Fish. Pat. Rep. 441; *Wilbur v. Beecher*, 29 Fed. Cas. No. 17,634, 2 Blatchf. 132, 2 Fish. Pat. Rep. 401; *Wintermute v. Redington*, 30 Fed. Cas. No. 17,896, 1 Fish. Pat. Cas. 239.

Equitable test as to profits may be used where no other measure of damages is available. *Burdell v. Denig*, 92 U. S. 716, 23 L. ed. 764.

Settlements with other infringers do not constitute guides and evidence thereof is inadmissible. *Cornely v. Markwald*, 131 U. S. 159, 9 S. Ct. 744, 33 L. ed. 117 [affirming 32 Fed. 292, 23 Blatchf. 163]; *Keyes v. Pueblo, etc., Co.*, 43 Fed. 478 [affirmed in 154 U. S. 507, 513, 14 S. Ct. 1148, 38 L. ed. 1083]; *United Nickel Co. v. Central Pac. R. Co.*, 36 Fed. 186; *National Car-Brake Shoe Co. v. Terre Haute Car, etc., Co.*, 19 Fed. 514; *Matthews v. Spangenberg*, 14 Fed. 350.



but it is not the controlling consideration. The test is what plaintiff lost and not what defendant gained.<sup>1</sup>

(b) *Counsel Fees and Expenses.* Counsel fees and expenses of the litigation cannot be included in the damages.<sup>2</sup>

(c) *Interest.* Interest upon the amount due plaintiff may be included in the verdict.<sup>3</sup>

(d) *Double and Treble Damages.* The verdict at law must be for the actual damages but the court may in its discretion enter judgment thereon for any sum above the verdict not exceeding three times the amount of the verdict.<sup>4</sup> Damages may be increased to recompense plaintiff, where the circumstances of the infringement are aggravated and the litigation expensive.<sup>5</sup>

(iii) *DESIGNS.* Damages for the infringement of design patents may be recovered in the same manner as other patents,<sup>6</sup> except that where the infringement was wilful after notice, a minimum amount of two hundred and fifty dollars may be collected for each offense.<sup>7</sup>

1. *Royer v. Shultz Belting Co.*, 45 Fed. 51 [affirmed in 154 U. S. 515, 14 S. Ct. 1151, 38 L. ed. 1075]; *Cowing v. Rumsey*, 6 Fed. Cas. No. 3,296, 8 Blatchf. 36, 4 Fish. Pat. Cas. 275; *McComb v. Brodie*, 15 Fed. Cas. No. 8,708, 5 Fish. Pat. Cas. 384, 1 Woods 153, 2 Off. Gaz. 117.

Lack of actual profits made by defendant is no defense where there is real loss to plaintiff. *Campbell v. Barclay*, 4 Fed. Cas. No. 2,353, 5 Biss. 179; *Carter v. Baker*, 5 Fed. Cas. No. 2,472, 4 Fish. Pat. Cas. 404, 1 Sawy. 512; *Goodyear Dental Vulcanite Co. v. Van Antwerp*, 10 Fed. Cas. No. 5,600, 2 Ban. & A. 252, 9 Off. Gaz. 497; *Pitts v. Hall*, 19 Fed. Cas. No. 11,192, 2 Blatchf. 229, 1 Fish. Pat. Rep. 441.

2. *Philp v. Nock*, 17 Wall. (U. S.) 460, 21 L. ed. 679; *Teese v. Huntingdon*, 23 How. (U. S.) 2, 16 L. ed. 479; *Blanchard's Gun-Stock Turning Factory v. Warner*, 3 Fed. Cas. No. 1,521, 1 Blatchf. 258, 1 Fish. Pat. Rep. 184; *Parker v. Hulme*, 18 Fed. Cas. No. 10,740, 1 Fish. Pat. Cas. 44; *Stimpson v. Railroads*, 23 Fed. Cas. No. 13,456, 2 Robb Pat. Cas. 595, 1 Wall. Jr. 164; *Whittemore v. Cutter*, 29 Fed. Cas. No. 17,600, 1 Gall. 429, 1 Robb Pat. Cas. 28. *Contra*, *Allen v. Blunt*, 1 Fed. Cas. No. 217, 2 Robb Pat. Cas. 530, 2 Woodb. & M. 121; *Boston Mfg. Co. v. Fiske*, 3 Fed. Cas. No. 1,681, 2 Mason 119, 1 Robb Pat. Cas. 320; *Knight v. Gavit*, 14 Fed. Cas. No. 7,894; *Pierson v. Eagle Screw Co.*, 19 Fed. Cas. No. 11,156, 2 Robb Pat. Cas. 268, 3 Story 402.

3. It is generally held that interest from time suit brought may be included. *May v. Fond du Lac*, 27 Fed. 691 [reversed on other grounds in 137 U. S. 395, 11 S. Ct. 98, 34 L. ed. 714]; *McCormick v. Seymour*, 15 Fed. Cas. No. 8,726, 2 Blatchf. 240; *Pitts v. Hall*, 19 Fed. Cas. No. 11,192, 2 Blatchf. 229, 1 Fish. Pat. Rep. 441; *Sickels v. Borden*, 22 Fed. Cas. No. 12,832, 3 Blatchf. 535; *Tatham v. Le Roy*, 23 Fed. Cas. No. 13,760, 2 Blatchf. 474.

Where a fixed royalty is taken as the measure interest is allowed from the date when such royalties would have been due. *McNeely v. Williamses*, 96 Fed. 978, 37 C. C.

A. 641; *Locomotive Safety Truck Co. v. Pennsylvania R. Co.*, 2 Fed. 677 [reversed on other grounds in 110 U. S. 490, 4 S. Ct. 220, 28 L. ed. 222].

4. U. S. Rev. St. (1878) § 4919 [U. S. Comp. St. (1901) p. 3394]; *Birdsall v. Coolidge*, 93 U. S. 64, 23 L. ed. 802; *National Folding-Box, etc., Co. v. Elsas*, 81 Fed. 197; *Welling v. La Bau*, 35 Fed. 302; *Bell v. U. S. Stamping Co.*, 32 Fed. 549; *Carew v. Boston Elastic Fabric Co.*, 5 Fed. Cas. No. 2,397, 3 Cliff. 356, 5 Fish. Pat. Cas. 90, 1 Off. Gaz. 91; *Gray v. James*, 10 Fed. Cas. No. 5,718, Pet. C. C. 394, 1 Robb Pat. Cas. 120; *Guyon v. Serrell*, 11 Fed. Cas. No. 5,881, 1 Blatchf. 244, 1 Fish. Pat. Rep. 151; *Whittemore v. Cutter*, 29 Fed. Cas. No. 17,601, 1 Gall. 478, 1 Robb Pat. Cas. 40.

5. *National Folding Box, etc., Co. v. Robertson*, 125 Fed. 524; *Morss v. Union Form Co.*, 39 Fed. 468; *Lyon v. Donaldson*, 34 Fed. 789; *Allen v. Blunt*, 1 Fed. Cas. No. 217, 2 Robb Pat. Cas. 530, 2 Woodb. & M. 121; *Bell v. McCullough*, 3 Fed. Cas. No. 1,256, 1 Bond 194, 1 Fish. Pat. Cas. 380; *Brodie v. Ophir Silver Min. Co.*, 4 Fed. Cas. No. 1,919, 4 Fish. Pat. Cas. 137, 5 Sawy. 608; *Guyon v. Serrell*, 11 Fed. Cas. No. 5,881, 1 Blatchf. 244, Fish. Pat. Rep. 151; *Peek v. Frame*, 19 Fed. Cas. No. 10,903, 9 Blatchf. 194, 5 Fish. Pat. Cas. 113; *Russell v. Place*, 21 Fed. Cas. No. 12,161, 9 Blatchf. 173, 5 Fish. Pat. Cas. 134 [affirmed in 94 U. S. 606, 24 L. ed. 214].

Without bad faith of defendant or special circumstances, damages will not be increased. *Welling v. La Bau*, 35 Fed. 302; *Carlock v. Tappan*, 5 Fed. Cas. No. 2,412; *Schwarzel v. Holensshade*, 21 Fed. Cas. No. 12,506, 2 Bond 29, 3 Fish. Pat. Cas. 116.

6. U. S. Rev. St. (1878) § 4933 [U. S. Comp. St. (1901) p. 3399], and § 2, Act Feb. 4, 1887, 24 U. S. St. at L. 387 [U. S. Comp. St. (1901) p. 3398].

7. 24 U. S. St. at L. 387 [U. S. Comp. St. (1901) p. 3398]; *Frank v. Geiger*, 121 Fed. 126; *Gimbel v. Hogg*, 97 Fed. 791, 38 C. C. A. 419; *Fuller v. Field*, 82 Fed. 813, 27 C. C. A. 165; *Lowell Mfg. Co. v. Whittall*, 71 Fed. 515; *Monroe v. Anderson*, 58 Fed.



(iv) *EFFECT OF RECOVERY.* The recovery of damages for past infringement does not give the infringer the right to continue the infringement thereafter,<sup>8</sup> but the recovery of full damages in satisfaction for the use of the particular machines may operate to release them from the monopoly.<sup>9</sup>

b. *Profits and Damages in Suits in Equity*—(i) *IN GENERAL.* In equity the complainant may recover the amount of the gains and profits that defendant has made from the use of the invention,<sup>10</sup> and in addition may have the damages sustained by him assessed.<sup>11</sup>

398, 7 C. C. A. 272; *Untermeyer v. Freund*, 50 Fed. 77 [affirmed in 58 Fed. 205, 7 C. C. A. 183]; *Ripley v. Elson Glass Co.*, 49 Fed. 927.

The statute is not unconstitutional but valid. *Untermeyer v. Freund*, 58 Fed. 205, 7 C. C. A. 183.

Although there were no profits two hundred and fifty dollars may be collected. *Pirkl v. Smith*, 42 Fed. 410 [affirmed in 154 U. S. 517, 14 S. Ct. 1153, 38 L. ed. 1082].

For facts showing sufficient notice see *Anderson v. Saint*, 46 Fed. 760.

8. *Birdsell v. Shaliol*, 112 U. S. 485, 5 S. Ct. 244, 28 L. ed. 768; *Root v. Lake Shore, etc.*, R. Co., 105 U. S. 189, 26 L. ed. 975; *Suffolk Mfg. Co. v. Hayden*, 3 Wall. (U. S.) 315, 18 L. ed. 76; *Electric Gas-Lighting Co. v. Wollensak*, 70 Fed. 790; *Spaulding v. Page*, 22 Fed. Cas. No. 13,219, 4 Fish. Pat. Cas. 641, 1 Sawy. 702; *Friarson v. Loe*, 9 Ch. D. 48, 27 Wkly. Rep. 183; *Needham v. Oxley*, 8 L. T. Rep. N. S. 604, 2 New Rep. 388, 11 Wkly. Rep. 852.

Recovery from vendor does not release the vendee from liability. *Westinghouse Electric, etc., Co. v. New York Mut. L. Ins. Co.*, 129 Fed. 213; *Van Epps v. International Paper Co.*, 124 Fed. 542; *Tuttle v. Matthews*, 28 Fed. 98; *Blake v. Greenwood Cemetery* 16 Fed. 676, 21 Blatchf. 222.

9. *Electric Gas-Lighting Co. v. Wollensak*, 70 Fed. 790; *Fisher v. Consolidated Amador Mine*, 25 Fed. 201; *Steam Stone-Cutter Co. v. Sheldons*, 21 Fed. 875; *Allis v. Stowell*, 16 Fed. 783; *Steam Stone-Cutter Co. v. Sheldons*, 15 Fed. 608, 21 Blatchf. 260; *Booth v. Seevers*, 3 Fed. Cas. No. 1,648a, 19 Off. Gaz. 1140; *Gilbert, etc., Mfg. Co. v. Bussing*, 10 Fed. Cas. No. 5,416, 1 Ban. & A. 621, 12 Blatchf. 426, 8 Off. Gaz. 144; *Perrigo v. Spaulding*, 19 Fed. Cas. No. 10,994, 2 Ban. & A. 348, 13 Blatchf. 389, 12 Off. Gaz. 352; *Spaulding v. Page*, 22 Fed. Cas. No. 13,219, 4 Fish. Pat. Cas. 641, 1 Sawy. 702; *Steam Stonecutter Co. v. Windsor Mfg. Co.*, 22 Fed. Cas. No. 13,335, 4 Ban. & A. 445, 17 Blatchf. 24.

Where license-fee is adopted as measure of damages, article is released from monopoly. *Stutz v. Armstrong*, 25 Fed. 147; *Sickels v. Borden*, 22 Fed. Cas. No. 12,832, 3 Blatchf. 535; *Spaulding v. Page*, 22 Fed. Cas. No. 13,219, 4 Fish. Pat. Cas. 641, 1 Sawy. 702. *Contra*, *Emerson v. Simm*, 8 Fed. Cas. No. 4,443, 6 Fish. Pat. Cas. 281, 3 Off. Gaz. 293.

10. May recover the actual profits made by the infringer. *Sessions v. Romadka*, 145 U. S. 29, 12 S. Ct. 799, 36 L. ed. 609; *Burdell v.*

*Denig*, 92 U. S. 716, 23 L. ed. 764; *Littlefield v. Perry*, 21 Wall. (U. S.) 205, 22 L. ed. 577; *Dean v. Mason*, 20 How. (U. S.) 198, 15 L. ed. 876; *Livingston v. Woodworth*, 15 How. (U. S.) 546, 14 L. ed. 809; *Campbell v. New York*, 81 Fed. 182; *Kirk v. Du Bois*, 46 Fed. 486 [affirmed in 158 U. S. 58, 15 S. Ct. 729, 39 L. ed. 895]; *Morss v. Union Form Co.*, 39 Fed. 468; *Munson v. New York*, 16 Fed. 560, 21 Blatchf. 342; *Burdett v. Estey*, 3 Fed. 566, 19 Blatchf. 1; *Campbell v. James*, 2 Fed. 338, 18 Blatchf. 92; *Carter v. Baker*, 5 Fed. Cas. No. 2,472, 4 Fish. Pat. Cas. 404, 1 Sawy. 512; *Coleman v. Liesor*, 6 Fed. Cas. No. 2,984; *La Baw v. Hawkins*, 14 Fed. Cas. No. 7,961, 2 Ban. & A. 561; *Sickels v. Borden*, 22 Fed. Cas. No. 12,832, 3 Blatchf. 535; *Tilghman v. Werks*, 23 Fed. Cas. No. 14,046, 1 Bond 511, 2 Fish. Pat. Cas. 229; *Vaughan v. East Tennessee, etc.*, R. Co., 23 Fed. Cas. No. 16,898, 2 Ban. & A. 537, 1 Flipp. 621, 11 Off. Gaz. 789; *Wetherill v. New Jersey Zinc Co.*, 30 Fed. Cas. No. 18,464, 1 Ban. & A. 485.

The fact that the profits are due principally to business judgment and skill of defendant does not affect the rule. *Lawther v. Hamilton*, 64 Fed. 221.

The fact that defendant could have made equal profits on similar unpatented articles does not limit the recovery. *Warren v. Keep*, 155 U. S. 265, 15 S. Ct. 83, 39 L. ed. 144; *Am Ende v. Seabury*, 43 Fed. 672; *Simpson v. Davis*, 22 Fed. 444, 22 Blatchf. 113; *Burdett v. Estey*, 3 Fed. 566, 19 Blatchf. 1.

Although the patentee has himself made no use of his patent, he is entitled to profits. *Crosby Steam Gage, etc., Co. v. Consolidated Safety Valve Co.*, 141 U. S. 441, 12 S. Ct. 49, 35 L. ed. 809.

Profits occurring after complainant sells his patent pending suit cannot be recovered. *Goss Printing Press Co. v. Scott*, 134 Fed. 880.

*Manufacturer's profits.*—A trader is not liable for manufacturer's profits. *Kissinger-Ison Co. v. Bradford Belting Co.*, 123 Fed. 91, 59 C. C. A. 221.

That user may be sued for profits after collecting damages from manufacturer see *U. S. Printing Co. v. American Playing-Card Co.*, 70 Fed. 50.

11. *Damages in addition to profits recoverable* see *U. S. Rev. St.* (1878) § 4921; *Williams v. Rome, etc.*, R. Co., 2 Fed. 702, 18 Blatchf. 181; *Carew v. Boston Elastic Fabric Co.*, 5 Fed. Cas. No. 2,397, 3 Cliff. 356, 5 Fish. Pat. Cas. 90, 1 Off. Gaz. 91.

*Profits and damages distinct.*—On an ac-



(II) *ESTIMATION OF PROFITS AND DAMAGES.* It must be clearly shown what saving or advantage defendant has actually derived from the infringement,<sup>12</sup> and the burden is on the complainant to show this. Where plaintiff fails to show the amount of profits due to the use of his invention, nominal damages only will be allowed.<sup>13</sup> Defendant is not responsible for all profits of the business but only such

counting for infringement of a patent under U. S. Rev. St. (1878) § 4921, defendant's profits and complainant's damages are distinct from and independent of each other and are governed by different principles, and one cannot be said to be the measure of the other, nor the allowance of one to preclude recovery of the other. *Beach v. Hatch*, 153 Fed. 763. It is proper for the master to report as to each separately. *Mast v. Superior Drill Co.*, 154 Fed. 45, 83 C. C. A. 157.

Where profits are insufficient to recompense plaintiff damages will be allowed. *Birdsall v. Coolidge*, 93 U. S. 64, 23 L. ed. 802; *U. S. Mitis Co. v. Carnegie Steel Co.*, 89 Fed. 206 [affirmed in 90 Fed. 829, 33 C. C. A. 387]; *Willimantic Thread Co. v. Clark Thread Co.*, 27 Fed. 865; *Andrews v. Creggan*, 7 Fed. 477, 19 Blatchf. 113; *Burdett v. Estey*, 3 Fed. 566, 19 Blatchf. 1; *Brady v. Atlantic Works*, 3 Fed. Cas. No. 1,795, 3 Ban. & A. 577, 15 Off. Gaz. 965; *Carew v. Boston Elastic Fabric Co.*, 5 Fed. Cas. No. 2,397, 3 Cliff. 356, 5 Fish. Pat. Cas. 90, 1 Off. Gaz. 91; *Magic Ruffle Co. v. Elm City Co.*, 16 Fed. Cas. No. 8,950, 2 Ban. & A. 152, 13 Blatchf. 109, 11 Off. Gaz. 501. Where profits are sufficient to recompense plaintiff no damages are allowed. *Ham-macher v. Wilson*, 32 Fed. 796; *Ford v. Kurtz*, 12 Fed. 789, 11 Biss. 324.

That damages in addition to profits were first allowed by the act of 1870 see *Elizabeth v. American Nicholson Pavement Co.*, 97 U. S. 126, 24 L. ed. 1000; *Willimantic Thread Co. v. Clark Thread Co.*, 27 Fed. 865; *Williams v. Leonard*, 29 Fed. Cas. No. 17,726, 13 Blatchf. 282, 43 Conn. 569.

**English practice.**—Equity cannot award both damages and profits but the complainant must elect. *De Vitre v. Betts*, L. R. 6 H. L. 319, 42 L. J. Ch. 841, 21 Wkly. Rep. 705; *Neilson v. Betts*, L. R. 5 H. L. 1, 40 L. J. Ch. 317, 19 Wkly. Rep. 1121; *Holland v. Fox*, 2 C. L. R. 1576, 3 E. & B. 977, 1 Jur. N. S. 13, 23 L. J. Q. B. 357, 2 Wkly. Rep. 558, 77 E. C. L. 977; *Needham v. Oxley*, 8 L. T. Rep. N. S. 604, 2 New Rep. 388, 11 Wkly. Rep. 852. May recover profits from manufacturer and damages from infringer. *Penn v. Bibby*, L. R. 3 Eq. 308, 36 L. J. Ch. 277, 15 Wkly. Rep. 192.

**Canadian practice.**—Plaintiff cannot have damages and profits from the same infringer but may have profits from manufacturer and damages from user. *Toronto Auer Light Co. v. Colling*, 31 Ont. 18.

12. Only actual profits are recoverable, not what it was possible for defendant to make. *Cincinnati Siemens-Lungren Gas Illuminating Co. v. Western Siemens-Lungren Co.*, 152 U. S. 200, 14 St. Ct. 523, 38 L. ed. 411; *Burdell v. Denig*, 92 U. S. 716, 23 L. ed. 764; *Dean v. Mason*, 20 How. (U. S.) 198, 15

L. ed. 876; *Westinghouse v. New York Air Brake Co.*, 140 Fed. 545, 72 C. C. A. 61; *Robbins v. Illinois Watch Co.*, 78 Fed. 124; *Munson v. New York*, 16 Fed. 560, 21 Blatchf. 342; *Burdett v. Estey*, 3 Fed. 566, 19 Blatchf. 1.

**License-fees.**—Plaintiff is entitled to actual profits without regard to his fixed license-fees. *Tilghman v. Proctor*, 125 U. S. 136, 8 S. Ct. 894, 31 L. ed. 664; *Elizabeth v. American Nicholson Pavement Co.*, 97 U. S. 126, 24 L. ed. 1000; *Wales v. Waterbury Mfg. Co.*, 87 Fed. 920; *Fisk v. Mahler*, 54 Fed. 528; *Knox v. Great Western Quicksilver Min. Co.*, 14 Fed. Cas. No. 7,907, 4 Ban. & A. 25, 7 Reporter 325, 6 Sawy. 430, 14 Off. Gaz. 897; *Wooster v. Taylor*, 30 Fed. Cas. No. 18,041, 3 Ban. & A. 241, 14 Blatchf. 403. In case of doubt license-fees followed. *Emigh v. Baltimore, etc., R. Co.*, 6 Fed. 283, 4 Hughes 271.

That profits must be direct and not indirect see *Diamond Drill, etc., Co. v. Kelley*, 131 Fed. 89; *Winchester Repeating Arms Co. v. American Buckle, etc., Co.*, 62 Fed. 278; *Piper v. Brown*, 19 Fed. Cas. No. 11,181, 6 Fish. Pat. Cas. 240, Holmes 196, 3 Off. Gaz. 97; *Wetherill v. New Jersey Zinc Co.*, 29 Fed. Cas. No. 17,464, 1 Ban. & A. 485.

Profits derived from advertisers in the infringing hotel register may be recovered. *Hawes v. Gage*, 11 Fed. Cas. No. 6,237, 5 Off. Gaz. 494.

Profits of other manufacturers or cost to them are not relevant but actual profits of defendant must be shown. *Keystone Mfg. Co. v. Adams*, 151 U. S. 139, 14 S. Ct. 295, 38 L. ed. 103 [reversing 41 Fed. 595]; *Robbins v. Illinois Watch Co.*, 81 Fed. 957, 27 C. C. A. 21; *Child v. Boston, etc., Iron Works*, 5 Fed. Cas. No. 2,674; *Troy Iron, etc., Factory v. Corning*, 24 Fed. Cas. No. 14,196, 6 Blatchf. 328, 3 Fish. Pat. Cas. 497.

**Proof of complainant's profits admitted under special circumstances** see *Rose v. Hirsh*, 94 Fed. 177, 36 C. C. A. 132, 51 L. R. A. 801.

Only profits actually made by defendant are recoverable. *Elwood v. Christy*, 18 C. B. N. S. 494, 34 L. J. C. P. 130, 13 Wkly. Rep. 498, 114 E. C. L. 494; *Walton v. Lavater*, 8 C. B. N. S. 162, 6 Jur. N. S. 1251, 29 L. J. C. P. 275, 3 L. T. Rep. N. S. 272, 98 E. C. L. 162. Defendant must disclose cost before and after using invention. *Siddell v. Vickers*, 61 L. T. Rep. N. S. 233. Price of infringing articles may be recovered. *Holland v. Fox*, 23 L. J. Q. B. 211, 1 L. & M. 221, 2 Wkly. Rep. 166.

13. *Rude v. Westcott*, 130 U. S. 152, 9 S. Ct. 463, 32 L. ed. 888; *Dobson v. Hartford Carpet Co.*, 114 U. S. 439, 5 S. Ct. 945, 29 L. ed. 177; *Black v. Thorne*, 111 U. S. 122, 4 S. Ct. 326, 28 L. ed. 372; *Canda v. Michi-*



as are due to the patented improvement,<sup>14</sup> and the burden is on the complainant to separate and apportion the profits by reliable and tangible proofs.<sup>15</sup> The profits

gan Malleable Iron Co., 152 Fed. 178, 81 C. C. A. 420; Kansas City Hay Press Co. v. Devol, 127 Fed. 363; Paxton v. Brinton, 126 Fed. 541; Hohorst v. Hamburg-American Packet Co., 91 Fed. 655, 34 C. C. A. 39 [*affirming* 84 Fed. 354]; Rose v. Hirsh, 91 Fed. 149; Hohorst v. Hamburg-American Packet Co., 84 Fed. 354; Keep v. Fuller, 42 Fed. 896; Fischer v. Hayes, 39 Fed. 613; Everest v. Buffalo Lubricating Oil Co., 31 Fed. 742; Roemer v. Simon, 31 Fed. 41, 24 Blatchf. 396; Tuttle v. Gaylord, 28 Fed. 97; Moffitt v. Cavanagh, 27 Fed. 511; Blake v. Greenwood Cemetery, 16 Fed. 676, 21 Blatchf. 222; Calkins v. Bertrand, 8 Fed. 755, 10 Biss. 445; Kirby v. Armstrong, 5 Fed. 801, 10 Biss. 135; Fisk v. West Bradley, etc., Mfg. Co., 9 Fed. Cas. No. 4,830a, 19 Off. Gaz. 545; Garretson v. Clark, 10 Fed. Cas. No. 5,249, 17 Blatchf. 256 [*affirmed* in 111 U. S. 120, 4 S. Ct. 291, 28 L. ed. 371]; Gould's Mfg. Co. v. Cowing, 10 Fed. Cas. No. 5,643, 3 Ban. & A. 75, 14 Blatchf. 315, 12 Off. Gaz. 942 [*reversed* on other grounds in 105 U. S. 253, 26 L. ed. 987]; Schillinger v. Gunther, 21 Fed. Cas. No. 12,457, 3 Ban. & A. 491, 15 Blatchf. 303, 14 Off. Gaz. 713.

In case of wilful infringement all doubts as to amount of profits are resolved against the infringer. Regina Music Box Co. v. Otto, 114 Fed. 505.

14. Cincinnati Siemens-Lungren Gas Illuminating Co. v. Western Siemens-Lungren Co., 152 U. S. 200, 14 S. Ct. 523, 38 L. ed. 411; Illinois Cent. R. Co. v. Turrill, 94 U. S. 695, 24 L. ed. 238; Mowry v. Whitney, 14 Wall. (U. S.) 620, 20 L. ed. 860; Celluloid Mfg. Co. v. Cellonite Mfg. Co., 40 Fed. 476; McMurray v. Emerson, 36 Fed. 901; Locomotive Safety Truck Co. v. Pennsylvania R. Co., 2 Fed. 677; Knox v. Great Western Quicksilver Min. Co., 14 Fed. Cas. No. 7,907, 4 Ban. & A. 25, 7 Reporter 325, 6 Sawy. 430, 14 Off. Gaz. 897; Serrell v. Collins, 21 Fed. Cas. No. 12,672, 1 Fish. Pat. Cas. 289; Wetherill v. New Jersey Zinc Co., 29 Fed. Cas. No. 17,464, 1 Ban. & A. 485.

Where the patented improvement is only a part of the machine, entire profits on the machine are not recoverable. Westinghouse v. New York Air Brake Co., 140 Fed. 545, 72 C. C. A. 61; Lattimore v. Hardsocg Mfg. Co., 121 Fed. 986, 58 C. C. A. 287; Westinghouse v. New York Air Brake Co., 115 Fed. 645; Brickill v. New York, 112 Fed. 65, 50 C. C. A. 1; Fay v. Allen, 30 Fed. 446; Reed v. Lawrence, 29 Fed. 915; Calkins v. Bertrand, 8 Fed. 755, 10 Biss. 445; Brady v. Atlantic Works, 3 Fed. Cas. No. 1,795, 3 Ban. & A. 577, 15 Off. Gaz. 965; Garretson v. Clark, 10 Fed. Cas. No. 5,248, 3 Ban. & A. 352, 15 Blatchf. 70, 14 Off. Gaz. 485 [*affirmed* in 111 U. S. 120, 4 S. Ct. 291, 28 L. ed. 371]; Graham v. Mason, 10 Fed. Cas. No. 5,672, 5 Fish. Pat. Cas. 290, Holmes 88, 1 Off. Gaz. 609; Ingels v. Mast, 13 Fed. Cas. No. 7,034, 2 Ban. & A. 24, 1 Flipp. 424, 7 Off. Gaz. 836;

Webster v. New Brunswick Carpet Co., 29 Fed. Cas. No. 17,338, 2 Ban. & A. 67, 9 Off. Gaz. 203; Wetherill v. New Jersey Zinc Co., 29 Fed. Cas. No. 17,464, 1 Ban. & A. 485. And see Canda v. Michigan Malleable Iron Co., 152 Fed. 178, 81 C. C. A. 420.

Where sales of articles are due solely to the patented improvement, the entire profits may be recovered. Warren v. Keep, 155 U. S. 265, 15 S. Ct. 83, 39 L. ed. 144; Crosby Steam Gage, etc., Co. v. Consolidated Safety Valve Co., 141 U. S. 441, 12 S. Ct. 49, 35 L. ed. 809 [*affirming* 44 Fed. 66]; Hurlbut v. Schillinger, 130 U. S. 456, 9 S. Ct. 584, 32 L. ed. 1011; Elizabeth v. American Nicholson Pavement Co., 97 U. S. 126, 24 L. ed. 1000; Force v. Sawyer-Boss Mfg. Co., 131 Fed. 884; Westinghouse v. New York Air Brake Co., 131 Fed. 607 [*reversed* on other grounds in 140 Fed. 545, 72 C. C. A. 61]; Penfield v. Potts, 126 Fed. 475, 61 C. C. A. 371; Piaget Novelty Co. v. Headley, 123 Fed. 897; Coddington v. Propfe, 112 Fed. 1016; Wales v. Waterbury Mfg. Co., 101 Fed. 126, 41 C. C. A. 250; Heaton Button-Fastener Co. v. Macdonald, 57 Fed. 648; Hoke Engraving Plate Co. v. Schraubstadter, 53 Fed. 817; Tatum v. Gregory, 51 Fed. 446; Putnam v. Lomax, 9 Fed. 448, 10 Biss. 546; Carter v. Baker, 5 Fed. Cas. No. 2,472, 4 Fish. Pat. Cas. 404, 1 Sawy. 512; Livingston v. Jones, 15 Fed. Cas. No. 8,414, 2 Fish. Pat. Cas. 207, 3 Wall. Jr. 330 [*reversed* on other grounds in 1 Wall. 155, 17 L. ed. 662]; Ruggles v. Eddy, 20 Fed. Cas. No. 12,116, 2 Ban. & A. 627, 12 Off. Gaz. 716; Whitney v. Mowry, 29 Fed. Cas. No. 17,594, 4 Fish. Pat. Cas. 207 [*reversed* on other grounds in 14 Wall. 620, 20 L. ed. 860].

Where it is shown that profits are due to the patented invention the burden is on defendant to show that part is due to other things. Elizabeth v. American Nicholson Pavement Co., 97 U. S. 126, 24 L. ed. 1000; Campbell v. New York, 81 Fed. 182; Tuttle v. Claflin, 76 Fed. 227, 22 C. C. A. 138; Morss v. Union Form Co., 39 Fed. 468; Fitch v. Bragg, 16 Fed. 243, 21 Blatchf. 302; American Nicholson Pavement Co. v. Elizabeth, 1 Fed. Cas. No. 309, 1 Ban. & A. 439, 6 Off. Gaz. 764 [*modified* in 97 U. S. 126, 24 L. ed. 1000]; Carter v. Baker, 5 Fed. Cas. No. 2,472, 4 Fish. Pat. Cas. 404, 1 Sawy. 512.

15. Complainant must show how much of the profits is due to the patented part of the infringing machine. Garretson v. Clark, 111 U. S. 120, 4 S. Ct. 291, 28 L. ed. 371; Robertson v. Blake, 94 U. S. 728, 24 L. ed. 245; Westinghouse v. New York Air Brake Co., 140 Fed. 545, 72 C. C. A. 61; Brinton v. Paxton, 134 Fed. 78, 67 C. C. A. 204; Kansas City Hay Press Co. v. Devol, 127 Fed. 363; Crane Co. v. Baker, 125 Fed. 1, 60 C. C. A. 138 [*reversed* on other grounds in 138 Fed. 60, 70 C. C. A. 486]; Elgin Wind Power, etc., Co. v. Nichols, 105 Fed. 780, 45 C. C. A. 49; Robbins v. Illinois Watch Co., 81 Fed.



which resulted from the infringement consist of the saving or advantage in the use of the patented improvement as compared with other old substitutes.<sup>16</sup> In determining profits all legitimate expenses of manufacture and sale are to be deducted from the selling price,<sup>17</sup> but not taxes, insurance, and interest upon

957, 27 C. C. A. 21 [*affirming* 78 Fed. 124]; *Williames v. McNeely*, 77 Fed. 894; *Tuttle v. Clafin*, 62 Fed. 453 [*reversed* on other grounds in 76 Fed. 227, 22 C. C. A. 138]; *Heaton Button-Fastener Co. v. Macdonald*, 57 Fed. 648; *Mosher v. Joyce*, 45 Fed. 205 [*affirmed* in 51 Fed. 441, 2 C. C. A. 322]; *Roemer v. Simon*, 31 Fed. 41, 24 Blatchf. 396; *Fay v. Allen*, 30 Fed. 446; *Willimantic Thread Co. v. Clark Thread Co.*, 27 Fed. 865; *Bostock v. Goodrich*, 25 Fed. 819; *Kirby v. Armstrong*, 5 Fed. 801, 10 Biss. 135; *Black v. Munson*, 3 Fed. Cas. No. 1,463, 2 Ban. & A. 623, 14 Blatchf. 265 [*affirmed* in 111 U. S. 122, 4 S. Ct. 326, 28 L. ed. 372]; *Gould's Mfg. Co. v. Cowing*, 10 Fed. Cas. No. 5,642, 1 Ban. & A. 375, 12 Blatchf. 243, 8 Off. Gaz. 277; *Ingersoll v. Musgrove*, 13 Fed. Cas. No. 7,040, 3 Ban. & A. 304, 14 Blatchf. 541, 13 Off. Gaz. 966; *Star Salt Caster Co. v. Crossman*, 22 Fed. Cas. No. 13,320, 4 Ban. & A. 566.

16. *New York Bank Note Co. v. Hamilton Bank Note Engraving, etc., Co.*, 28 N. Y. App. Div. 411, 50 N. Y. Suppl. 1093 [*reversed* on other grounds in 180 N. Y. 280, 73 N. E. 48]; *McCreary v. Pennsylvania Canal Co.*, 141 U. S. 459, 12 S. Ct. 40, 35 L. ed. 817 [*affirming* 5 Fed. 367]; *Dotem v. Boston*, 138 Fed. 406, 70 C. C. A. 308; *Rose v. Hirsh*, 91 Fed. 149; *Webster Loom Co. v. Higgins*, 43 Fed. 673; *Coupe v. Weatherhead*, 37 Fed. 16; *Vulcanite Paving Co. v. American Artificial Stone Pavement Co.*, 36 Fed. 378; *Tomkinson v. Willets Mfg. Co.*, 34 Fed. 536; *Shannon v. Bruner*, 33 Fed. 871; *Turrill v. Illinois Cent. R. Co.*, 20 Fed. 912; *Maier v. Brown*, 17 Fed. 736; *Faulks v. Kamp*, 10 Fed. 675; *Knox v. Great Western Quicksilver Min. Co.*, 14 Fed. Cas. No. 7,907, 4 Ban. & A. 25, 7 Reporter 325, 6 Sawy. 430, 14 Off. Gaz. 897; *Mulford v. Pearce*, 17 Fed. Cas. No. 9,908, 2 Ban. & A. 542, 14 Blatchf. 141, 11 Off. Gaz. 741 [*reversed* on other grounds in 102 U. S. 112, 26 L. ed. 93]; *Sargent v. Yale Lock Mfg. Co.*, 21 Fed. Cas. No. 12,367, 4 Ban. & A. 579, 17 Blatchf. 249, 17 Off. Gaz. 106; *Tilghman v. Mitchell*, 23 Fed. Cas. No. 14,041, 9 Blatchf. 1, 4 Fish. Pat. Cas. 599; *Turrill v. Illinois Cent. R. Co.*, 24 Fed. Cas. No. 14,272, 5 Biss. 344 [*reversed* in part in 94 U. S. 695, 24 L. ed. 238].

An improvement upon the patented machine by the infringer does not relieve him from liability but profits may be apportioned. *Tuttle v. Clafin*, 76 Fed. 227, 22 C. C. A. 138; *Carter v. Baker*, 5 Fed. Cas. No. 2,472, 4 Fish. Pat. Cas. 404, 1 Sawy. 512; *Steam Stonecutter Co. v. Windsor Mfg. Co.*, 22 Fed. Cas. No. 13,335, 4 Ban. & A. 445, 17 Blatchf. 24. *Compare* *Graham v. Mason*, 10 Fed. Cas. No. 5,672, 5 Fish. Pat. Cas. 290, Holmes 88, 1 Off. Gaz. 609.

17. Actual cost of making and selling

articles should be deducted in determining profits, and this includes wages, rent, advertising, etc. *Goulds Mfg. Co. v. Cowing*, 105 U. S. 253, 26 L. ed. 987; *Piaget Novelty Co. v. Headley*, 123 Fed. 897; *Zane v. Peck*, 13 Fed. 475; *American Saw Co. v. Emerson*, 8 Fed. 806; *La Baw v. Hawkins*, 14 Fed. Cas. No. 7,961, 2 Ban. & A. 561; *Steam Stonecutter Co. v. Windsor Mfg. Co.*, 22 Fed. Cas. No. 13,335, 4 Ban. & A. 445, 17 Blatchf. 24; *Troy Iron, etc., Factory v. Corning*, 24 Fed. Cas. No. 14,196, 3 Fish. Pat. Cas. 497, 6 Blatchf. 328.

Commissions to agents are deducted but must be shown by defendant. *Kissinger-Ison Co. v. Bradford Belting Co.*, 123 Fed. 91, 59 C. C. A. 221.

**Apportionment of running expenses.**—Running expenses will be apportioned between infringing article and other business. *Kinner v. Shepard*, 118 Fed. 48; *Hitchcock v. Tremaine*, 12 Fed. Cas. No. 6,539, 5 Fish. Pat. Cas. 310, 9 Blatchf. 385 [*affirmed* in 23 Wall. 518, 23 L. ed. 97].

Allowance made and deducted for use of shop and tools see *Steam Stonecutter Co. v. Windsor Mfg. Co.*, 22 Fed. Cas. No. 13,335, 4 Ban. & A. 445, 17 Blatchf. 24; *Troy Iron, etc., Factory v. Corning*, 24 Fed. Cas. No. 14,196, 3 Fish. Pat. Cas. 497, 6 Blatchf. 328.

**Loss on entire business or upon particular articles** will not be deducted from profits of infringing article. *Force v. Sawyer-Boss Mfg. Co.*, 131 Fed. 884; *Conover v. Mers*, 6 Fed. Cas. No. 3,122, 6 Fish. Pat. Cas. 506, 11 Blatchf. 197; *Graham v. Mason*, 10 Fed. Cas. No. 5,672, 5 Fish. Pat. Cas. 290, Holmes 88, 1 Off. Gaz. 609; *Steam Stonecutter Co. v. Windsor Mfg. Co.*, 22 Fed. Cas. No. 13,335, 4 Ban. & A. 445, 17 Blatchf. 24.

**Manufacturers' profits.**—No deduction is made for ordinary "manufacturers' profits." *Providence Rubber Co. v. Goodyear*, 9 Wall. (U. S.) 788, 19 L. ed. 566; *National Folding-Box, etc., Co. v. Elsas*, 86 Fed. 917, 30 C. C. A. 487. *Contra*, *Hammacher v. Wilson*, 32 Fed. 796.

**Cost of experiments** will be deducted. *Crosby Steam Gage, etc., Co. v. Consolidated Safety Valve Co.*, 141 U. S. 441, 12 S. Ct. 49, 35 L. ed. 809 [*affirming* 44 Fed. 66].

**Infringement of other patents.**—Where a part of a machine made and sold by defendant is found to infringe complainant's patent, the court will not undertake to determine, in reduction of damages, the collateral question whether or not such part also infringes another patent, the validity and scope of which are not directly put in issue. *Brinton v. Paxton*, 134 Fed. 78, 67 C. C. A. 204.

**Royalty under other patents** will be deducted. *La Baw v. Hawkins*, 14 Fed. Cas. No. 7,961, 2 Ban. & A. 561.



money invested in the manufacturing plant,<sup>18</sup> nor compensation for personal services.<sup>19</sup> So it has been held that only losses occurring concurrently with the making of profits and directly resulting from the particular transactions on which the profits are allowed may be considered in diminution of profits.<sup>20</sup> It has been held that interest on profits should not be allowed except under special circumstances.<sup>21</sup> It is very generally held that if allowed, interest commences to run from the date of the master's report.<sup>22</sup> Damages are estimated as in actions at law,<sup>23</sup>

18. *Seabury v. Am Ende*, 152 U. S. 561, 14 S. Ct. 683, 38 L. ed. 553 [affirming 43 Fed. 672]; *Providence Rubber Co. v. Goodyear*, 9 Wall. (U. S.) 788, 19 L. ed. 566; *Piaget Novelty Co. v. Headley*, 123 Fed. 897; *National Folding-Box, etc., Co. v. Dayton Paper-Novelty Co.*, 95 Fed. 991; *Steam Stonecutter Co. v. Windsor Mfg. Co.*, 22 Fed. Cas. No. 13,335, 4 Ban. & A. 445, 17 Blatchf. 24.

Only where interest is actually paid will it be allowed. *Herring v. Gage*, 12 Fed. Cas. No. 6,422, 3 Ban. & A. 396, 15 Blatchf. 124.

19. Nothing is to be deducted from profits for the personal services or salary of defendant or of officers of the company. *Seabury v. Am Ende*, 152 U. S. 561, 14 S. Ct. 683, 38 L. ed. 553 [affirming 43 Fed. 672]; *Elizabeth v. American Nicholson Pavement Co.*, 97 U. S. 126, 24 L. ed. 1000; *Kansas City Hay Press Co. v. Devol*, 127 Fed. 363; *Piper v. Brown*, 19 Fed. Cas. No. 11,181, 6 Fish. Pat. Cas. 240, *Holmes* 196, 3 Off. Gaz. 97; *Williams v. Leonard*, 29 Fed. Cas. No. 17,726, 9 Blatchf. 476, 5 Fish. Pat. Cas. 381. *Contra*, *National Folding-Box, etc., Co. v. Dayton Paper-Novelty Co.*, 95 Fed. 991; *Steam Stonecutter Co. v. Windsor Mfg. Co.*, 22 Fed. Cas. No. 13,335, 4 Ban. & A. 445, 17 Blatchf. 24.

20. *Canda v. Michigan Malleable Iron Co.*, 152 Fed. 178, 81 C. C. A. 420.

21. *Parks v. Booth*, 102 U. S. 96, 26 L. ed. 54; *Littlefield v. Perry*, 21 Wall. (U. S.) 205, 22 L. ed. 577; *Graham v. Plano Mfg. Co.*, 35 Fed. 597; *Brady v. Atlantic Works*, 3 Fed. Cas. No. 1,795, 3 Ban. & A. 577, 15 Off. Gaz. 965; *Holbrook v. Small*, 12 Fed. Cas. No. 6,596, 3 Ban. & A. 625, 17 Off. Gaz. 55.

22. *Crosby Steam Gage, etc., Co. v. Consolidated Safety Valve Co.*, 141 U. S. 441, 12 S. Ct. 49, 35 L. ed. 809 [affirming 44 Fed. 66]; *Tilghman v. Proctor*, 125 U. S. 136, 8 S. Ct. 894, 31 L. ed. 664; *Illinois Cent. R. Co. v. Turrill*, 110 U. S. 301, 4 S. Ct. 5, 28 L. ed. 154; *Westinghouse v. New York Air Brake Co.*, 133 Fed. 936; *Campbell v. New York*, 105 Fed. 631; *National Folding-Box, etc., Co. v. Dayton Paper-Novelty Co.*, 97 Fed. 331; *Turrill v. Illinois Cent. R. Co.*, 20 Fed. 912. *Compare* *American Nicholson Pavement Co. v. Elizabeth*, 1 Fed. Cas. No. 309, 1 Ban. & A. 439, 6 Off. Gaz. 764 (interest allowed from final decree); *Steam Stonecutter Co. v. Windsor Mfg. Co.*, 22 Fed. Cas. No. 13,335, 4 Ban. & A. 445, 17 Blatchf. 24, 22 Fed. Cas. No. 13,336, 5 Ban. & A. 335, 18 Blatchf. 47 (interest allowed from interlocutory decree); *Webster v. New Brunswick Carpet Co.*, 29 Fed. Cas. No. 17,338, 2 Ban. & A. 67, 9 Off. Gaz. 203 (interest allowed from final decree).

Filing bill.—Interest is not allowed from

the filing of the bill. *National Folding-Box, etc., Co. v. Elsas*, 81 Fed. 197.

23. The loss to plaintiff by the infringement constitutes the damages to be recovered. See *supra*, XIII, C, 12, a, (II).

Profits which plaintiff would have made on infringing sales are recoverable. *Westinghouse v. New York Air Brake Co.*, 131 Fed. 607 [reversed on other grounds in 140 Fed. 545]; *Creamer v. Bowers*, 35 Fed. 206; *Wellington v. La Bau*, 34 Fed. 40; *Blake v. Greenwood Cemetery*, 16 Fed. 676, 21 Blatchf. 222; *Zane v. Peck*, 13 Fed. 475.

Showing sales except for infringement.—

To recover as damages any part of the profits he would have made on the infringing sales, plaintiff must show that he would have made the sales except for the infringer. *Dobson v. Dorman*, 118 U. S. 10, 6 S. Ct. 946, 30 L. ed. 63; *Jennings v. Rogers Silver-Plate Co.*, 105 Fed. 967; *Tatum v. Gregory*, 51 Fed. 446; *Covert v. Sargent*, 38 Fed. 237 [reversed on other grounds in 152 U. S. 516, 14 S. Ct. 676, 38 L. ed. 536]; *Bell v. U. S. Stamping Co.*, 32 Fed. 549; *Cornely v. Marckwald*, 32 Fed. 292, 23 Blatchf. 163 [affirmed in 131 U. S. 159, 9 S. Ct. 744, 33 L. ed. 117]; *McSherry Mfg. Co. v. Dowagiac Mfg. Co.*, 160 Fed. 948; *Hall v. Stern*, 20 Fed. 788; *Buerk v. Imhaeuser* 4 Fed. Cas. No. 2,107, 2 Ban. & A. 452, 14 Blatchf. 19, 10 Off. Gaz. 907; *Ingersoll v. Musgrove*, 13 Fed. Cas. No. 7,040, 3 Ban. & A. 304, 14 Blatchf. 541, 13 Off. Gaz. 966; *St. Louis Stamping Co. v. Quimby*, 21 Fed. Cas. No. 12,240a, 5 Ban. & A. 275, 18 Off. Gaz. 571.

Counsel fees are not recoverable. *Bancroft v. Acton*, 2 Fed. Cas. No. 833, 7 Blatchf. 505.

Damages after suit may be recovered, although none were proved before. *Canton Steel Roofing Co. v. Kanneberg*, 51 Fed. 599.

Entire profits on infringing article are recoverable, providing the evidence is sufficient to prove that the marketable value of the article is due solely to the patented feature. *Westinghouse v. New York Air Brake Co.*, 140 Fed. 545, 72 C. C. A. 61.

Reduction in price due to the infringement is an item to be considered in estimating damages (*Yale Lock Mfg. Co. v. Sargent*, 117 U. S. 536, 6 S. Ct. 934, 29 L. ed. 954 [affirming 21 Fed. Cas. No. 12,366, 4 Ban. & A. 574, 17 Blatchf. 244, 17 Off. Gaz. 105]; *Kinner v. Shepard*, 107 Fed. 952; *Am Ende v. Seabury*, 43 Fed. 672; *Hobbie v. Smith*, 27 Fed. 656; *Fitch v. Bragg*, 16 Fed. 243, 21 Blatchf. 302); but must be clearly shown to be due to the infringement (*Boesch v. Graff*, 133 U. S. 697, 10 S. Ct. 378, 33 L. ed. 787 [reversing 33 Fed. 279, 13 Sawy. 17]; *Cornely v. Marck-*



and it has been held that the court may allow complainant double or treble damages.<sup>24</sup>

13. PLEADINGS<sup>25</sup> — a. In Actions at Law — (i) *IN GENERAL*. The pleadings in actions at law must conform to the rules of the courts of the state where brought,<sup>26</sup> except as modified by statute,<sup>27</sup> providing the general issue may be pleaded, and that on giving notice certain special matters of defense may be proved.<sup>28</sup> Oyer of the patent cannot be demanded.<sup>29</sup>

(ii) *DECLARATION OR COMPLAINT*. The declaration must embody all that is essential to enable plaintiff to give evidence of his right and of its violation by defendant and afford defendant the opportunity to interpose every defense allowed him by law,<sup>30</sup> but critical and over-nice objections to matters of form will not be sustained.<sup>31</sup>

(iii) *PLEA OR ANSWER* — (A) *In General*. By virtue of express statutory provision,<sup>32</sup> in any action for infringement, defendant may plead the general issue, and having given thirty days' notice in writing may prove any one or more of several special defenses therein enumerated.<sup>33</sup> He may show without notice the

wald, 131 U. S. 159, 9 S. Ct. 744, 33 L. ed. 117).

24. Equity may allow increased or exemplary damages in an aggravated case. *Fox v. Knickerbocker Engraving Co.*, 158 Fed. 422; *National Folding-Box, etc., Co. v. Elsas*, 86 Fed. 917, 30 C. C. A. 487 [*affirming* 81 Fed. 197]; *Stutz v. Armstrong*, 25 Fed. 147; *Graham v. Geneva Lake Crawford Mfg. Co.*, 24 Fed. 642; *Goodyear Dental Vulcanite Co. v. Van Antwerp*, 10 Fed. Cas. No. 5,600, 2 Ban. & A. 252, 9 Off. Gaz. 497; *Parker v. Corbin*, 18 Fed. Cas. No. 10,731, 4 McLean 462, 2 Robb Pat. Cas. 736. See also *supra*, XIII, C, 12, a, (ii), (D).

Under the act of 1836, equity could not award exemplary damages. *Livingston v. Jones*, 15 Fed. Cas. No. 8,414, 2 Fish. Pat. Cas. 207, 3 Wall. Jr. 330; *Motte v. Bennett*, 17 Fed. Cas. No. 9,884, 2 Fish. Pat. Cas. 642; *Sanders v. Logan*, 21 Fed. Cas. No. 12,295, 2 Fish. Pat. Cas. 167, 2 Pittsb. (Pa.) 241.

Profits cannot be increased in equity but only damages such as might have been allowed at law. *Covert v. Sargent*, 42 Fed. 298; *Campbell v. James*, 5 Fed. 806; *Holbrook v. Small*, 12 Fed. Cas. No. 6,596, 3 Ban. & A. 625, 17 Off. Gaz. 55.

25. See, generally, PLEADING.

26. U. S. Rev. St. (1878) § 914 [U. S. Comp. St. (1901) p. 684]; *Celluloid Mfg. Co. v. American Zylonite Co.*, 34 Fed. 744; *Cottier v. Stimson*, 18 Fed. 689, 9 Sawy. 435.

27. U. S. Rev. St. (1878) § 4920.

28. *Myers v. Sternheim*, 97 Fed. 625, 38 C. C. A. 345; *Celluloid Mfg. Co. v. American Zylonite Co.*, 34 Fed. 744. See also *Myers v. Cunningham*, 14 Fed. 346. See *infra*, XIII, C, 13, a, (iii), (B).

29. *Singer v. Wilson*, 22 Fed. Cas. No. 12,901; *Smith v. Ely*, 22 Fed. Cas. No. 13,043, Fish. Pat. Rep. 339, 5 McLean 76. *Contra*, *Cutting v. Myers*, 6 Fed. Cas. No. 3,520, 1 Robb Pat. Cas. 94, 4 Wash. 220.

Reference to patent makes it part of complaint. *Graham v. Earl*, 82 Fed. 737; *Wilder v. McCormick*, 29 Fed. Cas. No. 17,650, 2 Blatchf. 31, Fish. Pat. Rep. 128.

30. *Gray v. James*, 10 Fed. Cas. No. 5,719,

1 Robb Pat. Cas. 140, Pet. C. C. 476; *Wilder v. McCormick*, 29 Fed. Cas. No. 17,650, 1 Blatchf. 597, Fish. Pat. Rep. 128. See *infra*, XIII, C, 13, b, (i).

The preliminary steps leading to grant of patent need not be specifically alleged. *Cutting v. Myers*, 6 Fed. Cas. No. 3,520, 1 Robb Pat. Cas. 159, 4 Wash. 220; *Van Hook v. Wood*, 28 Fed. Cas. No. 16,854; *Wilder v. McCormick*, 29 Fed. Cas. No. 17,650, 2 Blatchf. 31, Fish. Pat. Rep. 128.

Facts as to damage and not evidence must be alleged, so that there may be an issue. *Rude v. Wescott*, 130 U. S. 152, 9 S. Ct. 463, 32 L. ed. 888; *Ewart Mfg. Co. v. Baldwin Cycle-Chain Co.*, 91 Fed. 262.

Marking goods.—It must be alleged that plaintiff marked his goods under the patent with the word "patented." *Streat v. Finch*, 154 Fed. 378; *Sprague v. Bramhall-Deane Co.*, 133 Fed. 738.

Where the patent contains numerous claims, the ones relied on must be specified. *Russell v. Winchester Repeating Arms Co.*, 97 Fed. 634.

Infringement within six years need not be alleged. Defendant may show that the infringement was not within six years under the general issue. *Peters v. Hanger*, 134 Fed. 586, 67 C. C. A. 386.

The question of the validity of a patent on its face may be raised by demurrer in an action at law for its infringement. *Thomas v. St. Louis, etc., R. Co.*, 149 Fed. 753, 79 C. C. A. 89.

31. *May v. Mercer County*, 30 Fed. 246; *Gray v. James*, 10 Fed. Cas. No. 5,719, 1 Robb Pat. Cas. 140, Pet. C. C. 476; *Parker v. Haworth*, 18 Fed. Cas. No. 10,738, 4 McLean 370, 2 Robb Pat. Cas. 725; *Van Hook v. Wood*, 28 Fed. Cas. No. 16,854; *Wilder v. McCormick*, 29 Fed. Cas. No. 17,650, 1 Blatchf. 31, Fish. Pat. Rep. 128.

32. U. S. Rev. St. (1878) § 4920.

33. *Bates v. Coe*, 98 U. S. 31, 25 L. ed. 68; *Teese v. Huntington*, 23 How. (U. S.) 2, 16 L. ed. 479; *Henry v. U. S.*, 22 Ct. Cl. 75.

Want of patentability need not be specially pleaded. *Richards v. Chase Elevator Co.*, 158



prior state of the art,<sup>34</sup> or that the patent is void on its face.<sup>35</sup> As the statute mentioned is permissive merely it does not prevent special pleas under ordinary rules.<sup>36</sup> And, where defenses are specially pleaded which might be shown under the general issues, no notice is necessary.<sup>37</sup> However, if notice of special matter of defense is given, a plea covering the same matter cannot be filed.<sup>38</sup> The question of fraud can be raised only by distinct and special allegations in the plea or answer.<sup>39</sup>

(B) *Notice of Special Matter of Defense.* The special matters of defense covered by statute<sup>40</sup> cannot be proved unless notice is given in accordance with the terms of the statute,<sup>41</sup> or unless it is waived.<sup>42</sup> The notice must be definite and certain as to name, place, and subject-matter,<sup>43</sup> and must be given thirty

U. S. 299, 15 S. Ct. 831, 39 L. ed. 991; May v. Juneau County, 137 U. S. 408, 11 S. Ct. 102, 34 L. ed. 729; Hendy v. Golden State, etc., Iron Works, 127 U. S. 370, 8 S. Ct. 1275, 32 L. ed. 207; Zane v. Soffe, 110 U. S. 200, 3 S. Ct. 562, 28 L. ed. 119.

Any special matter showing that the patent is invalid may be proved. U. S. Rev. St. (1878) § 4920; Brown v. Piper, 91 U. S. 37, 33 L. ed. 200; Baldwin v. Kresl, 76 Fed. 823, 22 C. C. A. 593; Woodward v. Boston Lasting Mach. Co., 63 Fed. 609, 11 C. C. A. 353; Evans v. Eaton, 8 Fed. Cas. No. 4,559, 1 Robb Pat. Cas. 68, Pet. C. C. 322; Kneass v. Schuylkill Bank, 14 Fed. Cas. No. 7,875, 1 Robb Pat. Cas. 303, 4 Wash. C. C. 9.

*Statute of limitations.*—Under general issue may show infringement more than six years before suit. Peters v. Hanger, 134 Fed. 586, 67 C. C. A. 386 [reversing 127 Fed. 820, 62 C. C. A. 498].

That proofs are confined to matter in notice see Lyon v. Donaldson, 34 Fed. 789.

*Separate defenses.*—Where several patents sued on may give separate defense for each. Kelleher v. Darling, 14 Fed. Cas. No. 7,653, 3 Ban. & A. 438, 4 Cliff. 424, 14 Off. Gaz. 673.

For insufficient pleas see Agawam Woolen Co. v. Jordan, 7 Wall. (U. S.) 583, 19 L. ed. 177; Brickill v. Hartford, 57 Fed. 216; Kelleher v. Darling, 14 Fed. Cas. No. 7,653, 3 Ban. & A. 438, 4 Cliff. 424, 14 Off. Gaz. 673; Root v. Ball, 20 Fed. Cas. No. 12,035, 4 McLean 177, 2 Robb Pat. Cas. 513; Wheeler v. McCormick, 29 Fed. Cas. No. 17,498, 8 Blatchf. 267, 4 Fish. Pat. Cas. 433.

For pleas sustained as sufficient see National Mfg. Co. v. Meyers, 7 Fed. 355; Blake v. Stafford, 3 Fed. Cas. No. 1,504, 6 Blatchf. 195, 3 Fish. Pat. Cas. 294. Under the English practice monopoly cannot be set up as a defense to the general issue (Gillett v. Wilby, 9 C. & P. 334, 38 E. C. L. 201), nor fraudulent evasion of patent (Stead v. Anderson, 4 C. B. 806, 11 Jur. 877, 16 L. J. C. P. 250, 56 E. C. L. 806).

34. Vance v. Campbell, 1 Black (U. S.) 427, 17 L. ed. 168; Parsons v. Seelye, 100 Fed. 452, 40 C. C. A. 484; Overweight Counterbalance Elevator Co. v. Improved Order Red Men's Hall Assoc., 94 Fed. 155, 36 C. C. A. 125; Kennedy v. Solar Refining Co., 69 Fed. 715; Stevenson v. Magowan, 31 Fed. 824; La Baw v. Hawkins, 14 Fed. Cas. No. 7,960, 1 Ban. & A. 428, 6 Off. Gaz. 724.

35. Kneass v. Schuylkill Bank, 14 Fed. Cas. No. 7,875, 1 Robb Pat. Cas. 303, 4 Wash. 9.

36. Grant v. Raymond, 6 Pet. (U. S.) 218, 8 L. ed. 376.

37. Brickill v. Hartford, 57 Fed. 216; Cottier v. Stimson, 20 Fed. 906; Cottier v. Stimson, 18 Fed. 689, 9 Sawy. 435; Day v. New England Car-Spring Co., 7 Fed. Cas. No. 3,687, 3 Blatchf. 179; Root v. Ball, 20 Fed. Cas. No. 12,035, 4 McLean 177, 2 Robb Pat. Cas. 513.

38. Latta v. Shawk, 14 Fed. Cas. No. 8,116, 1 Bond 259, 1 Fish. Pat. Cas. 465; Read v. Miller, 20 Fed. Cas. No. 11,610, 2 Biss. 12, 3 Fish. Pat. Cas. 310.

39. Blake v. Stafford, 3 Fed. Cas. No. 1,504, 6 Blatchf. 195, 3 Fish. Pat. Cas. 294; Clark v. Scott, 5 Fed. Cas. No. 2,833, 9 Blatchf. 301, 5 Fish. Pat. Cas. 245, 2 Off. Gaz. 4; Doughty v. West, 7 Fed. Cas. No. 4,029, 2 Fish. Pat. Cas. 553; Gear v. Grosvenor, 10 Fed. Cas. No. 5,291, 6 Fish. Pat. Cas. 314, Holmes 215, 3 Off. Gaz. 380.

In England he may plead patent fraudulently obtained. Bedells v. Massey, 8 Jur. 808, 13 L. J. C. P. 173, 7 M. & G. 630, 8 Scott N. R. 337, 49 E. C. L. 630.

40. U. S. Rev. St. (1878) § 4920.

41. Philadelphia, etc., R. Co. v. Stimpson, 14 Pet. (U. S.) 448, 10 L. ed. 535; Grant v. Raymond, 6 Pet. (U. S.) 218, 8 L. ed. 376; Arrott v. Standard Sanitary Mfg. Co., 113 Fed. 389; Kieseles v. Haas, 32 Fed. 794; Bragg v. Stockton, 27 Fed. 509; Coleman v. Liesor, 6 Fed. Cas. No. 2,984; Dixon v. Moyer, 7 Fed. Cas. No. 3,931, 1 Robb Pat. Cas. 324, 4 Wash. 68; Roberts v. Buck, 20 Fed. Cas. No. 11,897, Holmes 224, 6 Fish. Pat. Cas. 325, 3 Off. Gaz. 268.

*Patents and publications not admitted without notice.* Earl v. Dexter, 8 Fed. Cas. No. 4,242, 1 Ban. & A. 400, Holmes 412, 6 Off. Gaz. 729; Odiorne v. Denney, 18 Fed. Cas. No. 10,431, 3 Ban. & A. 287, 13 Off. Gaz. 965, 1 N. J. L. J. 183.

42. Crouch v. Speer, 6 Fed. Cas. No. 3,438, 1 Ban. & A. 145, 6 Off. Gaz. 187; Roemer v. Simon, 20 Fed. Cas. No. 11,997, 1 Ban. & A. 138, 5 Off. Gaz. 555 [affirmed in 95 U. S. 214, 24 L. ed. 384].

43. Seymour v. Osborne, 11 Wall. (U. S.) 516, 20 L. ed. 33; Wise v. Allis, 9 Wall. (U. S.) 737, 19 L. ed. 784; Agawam Woolen Co. v. Jordan, 7 Wall. (U. S.) 583, 19 L. ed. 177; Teese v. Huntingdon, 23 How. (U. S.)



days before trial.<sup>44</sup> It may be given in the answer<sup>45</sup> and need not be under oath.<sup>43</sup>

**b. In Suits in Equity**<sup>47</sup>—(1) *BILL*. The bill or complaint should clearly identify the invention claimed in the patent,<sup>48</sup> should allege ownership thereof,<sup>49</sup>

2, 16 L. ed. 479; *Silby v. Foote*, 14 How. (U. S.) 218, 14 L. ed. 394; *Tatum v. Eby*, 60 Fed. Cas. 408; *Orr v. Merrill*, 18 Fed. Cas. No. 10,591, 2 Robb Pat. Cas. 331, 1 Woodb. & M. 376.

**Names and residences of prior users** must be given, but not necessarily the names of witnesses by whom allegation is to be established. *Woodbury Patent Planing Mach. Co. v. Keith*, 101 U. S. 479, 25 L. ed. 939; *Allis v. Buckstaff*, 13 Fed. 879; *Judson v. Cope*, 14 Fed. Cas. No. 7,565, 1 Bond 327, 1 Fish. Pat. Cas. 615; *Lock v. Pennsylvania R. Co.*, 15 Fed. Cas. No. 8,438; *Many v. Jagger*, 16 Fed. Cas. No. 9,055, 1 Blatchf. 372, Fish. Pat. Rep. 222; *Wilton v. Railroads*, 30 Fed. Cas. No. 17,857, 2 Robb Pat. Cas. 641, 1 Wall. Jr. 192.

**Use by others in addition to those mentioned in the notice** may be proved. *Evans v. Eaton*, 8 Fed. Cas. No. 4,559, Pet. C. C. 322, 1 Robb Pat. Cas. 68; *Evans v. Kremer*, 8 Fed. Cas. No. 4,565, Pet. C. C. 215, 1 Robb Pat. Cas. 66; *Treadwell v. Bladen*, 24 Fed. Cas. No. 14,154, 1 Robb Pat. Cas. 531, 4 Wash. 703.

**Time of use** need not be specified. *Phillips v. Page*, 24 How. (U. S.) 164, 16 L. ed. 639.

**Place of use** must be stated specifically and not merely the county or city. *Schenck v. Diamond Match Co.*, 77 Fed. 208, 23 C. C. A. 122 [affirming 71 Fed. 521]; *Hays v. Sulzor*, 11 Fed. Cas. No. 6,271, 1 Bond 279, 1 Fish. Pat. Cas. 532; *Latta v. Shawk*, 14 Fed. Cas. No. 8,116, 1 Bond 259, 1 Fish. Pat. Cas. 465.

**Defense**.—Each defense must be specified in notice. *Meyers v. Busby*, 32 Fed. 670, 13 Sawy. 33.

**Notices held sufficient** see *Anderson v. Miller*, 129 U. S. 70, 9 S. Ct. 224, 32 L. ed. 635; *Saunders v. Allen*, 60 Fed. 610, 9 C. C. A. 157; *American Hide, etc., Splitting, etc., Mach. Co. v. American Tool, etc., Co.*, 1 Fed. Cas. No. 302, 4 Fish. Pat. Cas. 284, Holmes 503; *Smith v. Frazer*, 22 Fed. Cas. No. 13,048, 5 Fish. Pat. Cas. 543, 2 Off. Gaz. 175, 3 Pittsb. (Pa.) 397.

44. *Brunswick v. Holzalb*, 4 Fed. Cas. No. 2,067; *Westlake v. Cartter*, 29 Fed. Cas. No. 17,451, 6 Fish. Pat. Cas. 519, 4 Off. Gaz. 636.

45. *Bates v. Coe*, 98 U. S. 31, 25 L. ed. 68; *Arrott v. Standard Sanitary Mfg. Co.*, 113 Fed. 389; *Smith v. Frazer*, 22 Fed. Cas. No. 13,048, 5 Fish. Pat. Cas. 543, 2 Off. Gaz. 175, 3 Pittsb. (Pa.) 397.

**Plea stricken out is not notice**. *Foote v. Silsby*, 9 Fed. Cas. No. 4,916, 1 Blatchf. 445, Fish. Pat. Rep. 268 [affirmed in 14 How. 218, 14 L. ed. 394].

46. *Campbell v. New York*, 45 Fed. 243.

47. **Form and requisites of bill** have been settled by numerous decisions and the practice can only be changed by an amendment of the equity rules, or of the rules of the cir-

cuit courts. *American Graphophone Co. v. National Phonograph Co.*, 127 Fed. 349.

48. *Wise v. Grand Ave. R. Co.*, 33 Fed. 277; *Noe v. Prentice*, 18 Fed. Cas. No. 10,284a; *Peterson v. Wooden*, 19 Fed. Cas. No. 11,038, 3 McLean 248, 2 Robb Pat. Cas. 116.

**Identification held insufficient**.—Title of invention and date and number of patent not sufficient identification. *Welsbach Light Co. v. Rex Incandescent Light Co.*, 87 Fed. 477; *Electrolibration Co. v. Jackson*, 52 Fed. 773; *Stirratt v. Excelsior Mfg. Co.*, 44 Fed. 142; *Post v. T. C. Richards Hardware Co.*, 25 Fed. 905.

**Identification held sufficient**.—General reference to the invention with profert of the patent is sufficient identification and places patent before the court. *Edison v. American Mutoscope, etc., Co.*, 127 Fed. 361; *Fowler v. New York*, 121 Fed. 747, 58 C. C. A. 113 [affirming 110 Fed. 749]; *Chinnock v. Paterson, etc., Tel. Co.*, 110 Fed. 199 [decree reversed on other grounds in 112 Fed. 531, 50 C. C. A. 384]; *Heaton-Peninsular Button-Fastener Co. v. Schlochtermeyer*, 72 Fed. 520, 18 C. C. A. 674 [affirming 69 Fed. 592]; *Germain v. Wilgus*, 67 Fed. 597, 14 C. C. A. 561; *Enterprise Mfg. Co. v. Snow*, 67 Fed. 235; *U. S. Credit System Co. v. American Credit Indemnity Co.*, 53 Fed. 818; *Dickerson v. Greene*, 53 Fed. 247; *International Terra-Cotta Lumber Co. v. Maurer*, 44 Fed. 618; *American Bell Tel. Co. v. Southern Tel. Co.*, 34 Fed. 803; *Bogart v. Hinds*, 25 Fed. 484; *McMillin v. St. Louis, etc., Valley Transp. Co.*, 18 Fed. 260, 5 McCrary 561; *Pitts v. Whitman*, 19 Fed. Cas. No. 11,196, 2 Robb Pat. Cas. 189, 2 Story 609. It is unnecessary to specify particular claims of the patent except under unusual circumstances. *Morton Trust Co. v. American Car, etc., Co.*, 129 Fed. 916, 64 C. C. A. 367; *Johnson v. Columbia Phonograph Co.*, 106 Fed. 319. But see *Eastwood v. Cutler-Hammer Mfg. Co.*, 148 Fed. 718. Reference to patent for full disclosure is sufficient. *Graham v. Earl*, 92 Fed. 155, 34 C. C. A. 267.

**Profert of patent** does not make it proof of the allegations contained therein as to the prior art. *Indurated Fibre Industries Co. v. Grace*, 52 Fed. 124.

49. **Must show ownership at time of suit** and not merely ownership at some time. *Bowers v. Bucyrus Co.*, 132 Fed. 39; *American Graphophone Co. v. National Phonograph Co.*, 127 Fed. 349; *Lettelier v. Mann*, 79 Fed. 81; *De Beaumont v. Williames*, 71 Fed. 812; *Krick v. Jansen*, 52 Fed. 823. Allegation of ownership need not be in set words. *Arrott v. Standard Mfg. Co.*, 113 Fed. 1014; *Ather-ton Mach. Co. v. Atwood-Morrison Co.*, 102 Fed. 949, 43 C. C. A. 72.

**The various assignments by which title was acquired** need not be alleged. *Edison Electric*



and should set forth those facts which are statutory prerequisites to the grant of a valid patent.<sup>50</sup> A positive averment of such prerequisites is necessary. Allegations on belief are insufficient.<sup>51</sup> The bill should allege infringement by defendant,<sup>52</sup>

*Light Co. v. Packard Electric Co.*, 61 Fed. 1002; *Clement Mfg. Co. v. Upson, etc., Co.*, 40 Fed. 471; *Brooks v. Jenkins*, 4 Fed. Cas. No. 1,953, *Fish. Pat. Rep.* 41, 3 *McLean* 432; *Meerse v. Allen*, 16 Fed. Cas. No. 9,393a; *Nourse v. Allen*, 18 Fed. Cas. No. 10,367, 4 *Blatchf.* 376, 3 *Fish. Pat. Cas.* 63.

**Recording of assignment** need not be alleged. *Perry v. Corning*, 19 Fed. Cas. No. 11,004, 7 *Blatchf.* 195.

**Where judgment of court is relied on to show title** such proceedings should be alleged. *Parker v. Brant*, 18 Fed. Cas. No. 10,727, 1 *Fish. Pat. Cas.* 58.

**Presumption as to ownership.**—Original patentee presumed to be the owner until the contrary appears. *Fischer v. Neil*, 6 Fed. 89.

**Insufficient allegation of ownership** see *Jaros Hygienic Underwear Co. v. Fleece Hygienic Underwear Co.*, 60 Fed. 622.

**Sufficient allegation of ownership shown** see *Æolian Co. v. Hallett, etc., Piano Co.*, 134 Fed. 872; *General Electric Co. v. Wagner Electric Mfg. Co.*, 123 Fed. 101 [*affirmed* in 130 Fed. 772, 66 C. C. A. 821]; *Arnold Monophase Electric Co. v. Wagner Electric Mfg. Co.*, 118 Fed. 653; *Goss Printing-Press Co. v. Scott*, 108 Fed. 253, 47 C. C. A. 302, 110 Fed. 402, 49 C. C. A. 97.

**Sufficient allegations as to territorial assignment** see *Washburn, etc., Mfg. Co. v. Haish*, 4 Fed. 900, 10 *Biss.* 65.

50. *Eastwood v. Cutler-Hammer Mfg. Co.*, 148 Fed. 718; *American Graphophone Co. v. National Phonograph Co.*, 127 Fed. 349; *Rubber Tire Wheel Co. v. Davie*, 100 Fed. 85; *Miller v. Smith*, 5 Fed. 359, design patents.

**An allegation that the invention was not in public use or on sale for two years before application is necessary.** *Hayes-Young Tie Plate Co. v. St. Louis Transit Co.*, 130 Fed. 900 [*affirmed* in 137 Fed. 80, 70 C. C. A. 1]; *Krick v. Jansen*, 52 Fed. 823; *Coop v. Dr. Savage Physical Development Inst.*, 47 Fed. 899; *Consolidated Brake-Shoe Co. v. Detroit Steel, etc., Co.*, 47 Fed. 894; *Nathan Mfg. Co. v. Craig*, 47 Fed. 522; *Blessing v. John Trageser Steam Copper Works*, 34 Fed. 753. *Contra*, *Noe v. Prentice*, 18 Fed. Cas. No. 10,284a. It is not sufficient to allege that it was not in public use or on sale with the inventor's consent. *Coop v. Dr. Savage Physical Development Inst.*, *supra*; *Blessing v. John Trageser Steam Copper Works*, *supra*.

**An allegation that the invention was not patented or described in a printed publication is necessary.** *Rubber Tire Wheel Co. v. Davie*, 100 Fed. 85; *Diamond Match Co. v. Ohio Match Co.*, 80 Fed. 117; *Goebel v. American R. Supply Co.*, 55 Fed. 825; *Overman Wheel Co. v. Elliott Hickory Cycle Co.*, 49 Fed. 859. An allegation as to foreign patent must be made under U. S. Rev. St. § 4887, as amended March 3, 1897, 29 U. S. St. at L. 692 [U. S. Comp. St. (1901) p. 3382]; *Ellis*

*ott, etc., Book-Typewriter Co. v. Fisher Typewriter Co.*, 109 Fed. 330.

**An allegation that the invention was not abandoned is unnecessary** since that is matter of defense. *Warren Featherbone Co. v. Warner Bros. Co.*, 92 Fed. 990.

**Proceedings in patent office.**—The filing of application for patent in due form is presumed from grant of patent and need not be alleged, any defect therein being matter of defense (*Bowers v. Bucyrus Co.*, 132 Fed. 39); nor is it necessary in a suit for infringement of a reissued patent to allege specifically the ground on which reissue was obtained (*Spaeth v. Barney*, 22 Fed. 828).

The fact that some patents in suit have expired does not render the bill bad. Where the inventions covered by several patents enter into and constitute one compact machine, it is necessary in suing for infringement to complain upon all the patents. *Russell v. Kern*, 58 Fed. 382 [*affirmed* in 64 Fed. 581].

**Separate affidavit as to inventorship is unnecessary.** *Consolidated Brake-Shoe Co. v. Detroit Steel, etc., Co.*, 47 Fed. 894.

**An allegation of prior adjudication sustaining patent is impertinent unless injunction is prayed.** *Haarmann v. Lueders*, 109 Fed. 327; *Wirt v. Hicks*, 46 Fed. 71. But prior litigation may be recited where injunction is sought. *American Bell Tel. Co. v. Southern Tel. Co.*, 34 Fed. 803; *Steam-Gauge, etc., Co. v. McRoberts*, 26 Fed. 765.

**Immaterial matters** alleged in the bill will be stricken out on motion. *Western Electric Co. v. Williams-Abbott Electric Co.*, 83 Fed. 842.

**Bills held sufficient.**—*Rubber Tire Wheel Co. v. Davie*, 100 Fed. 85; *American Cable R. Co. v. New York*, 42 Fed. 60; *Thompson v. Jewett*, 23 Fed. Cas. No. 13,961.

**English practice.**—Complainant must make oath that he believes himself to be the first inventor. *Hill v. Thompson*, *Holt N. P.* 636, 3 E. C. L. 249, 3 *Meriv.* 622, 17 *Rev. Rep.* 156, 36 *Eng. Reprint* 239, 2 *Moore C. P.* 424, 8 *Taunt.* 375, 20 *Rev. Rep.* 488, 4 E. C. L. 190. Enrolment within prescribed time must be alleged. *Bentley v. Goldthorp*, 1 C. B. 368, 2 D. & L. 795, 9 *Jur.* 470, 14 L. J. Ch. 115, 50 E. C. L. 368. Express averment of novelty is not necessary. *Amory v. Brown*, L. R. 8 Eq. 663, 38 L. J. Ch. 593, 20 L. T. *Rep. N. S.* 654, 17 *Wkly. Rep.* 849.

51. *Rubber Tire Wheel Co. v. Davie*, 100 Fed. 85.

52. **General allegation is sufficient.**—*In-durated Fibre Industries Co. v. Grace*, 52 Fed. 124; *American Bell Tel. Co. v. Southern Tel. Co.*, 34 Fed. 803; *Fischer v. Hayes*, 6 Fed. 76, 19 *Blatchf.* 26; *American Diamond Rock-Boring Co. v. Rutland Marble Co.*, 2 Fed. 355, 18 *Blatchf.* 147; *Haven v. Brown*, 11 Fed. Cas. No. 6,228, 6 *Fish. Pat. Cas.* 413; *Thatcher Heating Co. v. Carbon Stove Co.*,



and should include a prayer for an accounting together with a prayer for equitable relief such as discovery or an injunction.<sup>53</sup> The bill should be verified.<sup>54</sup>

(II) *PLEA OR ANSWER*—(A) *Plea*—(1) *IN GENERAL*. A plea in equity is a special answer urging some particular defense by which the issue is reduced to a single point. Any defense which brings forward new matter in opposition to the equity of the bill may be presented by plea.<sup>55</sup> A mere denial of the allegations of the bill without any averment of new matter cannot be made by plea.<sup>56</sup>

23 Fed. Cas. No. 13,864, 4 Ban. & A. 68, 7 Reporter 199, 15 Off. Gaz. 1051, 2 N. J. L. J. 25; Turrell v. Cammerrer, 24 Fed. Cas. No. 14,266, 3 Fish. Pat. Cas. 462.

Where the bill does not clearly show wrongful use of the patented invention by defendant it is bad. Knox Rock-Blasting Co. v. Rairdon Stone Co., 87 Fed. 969; American Solid Leather Button Co. v. Empire State Nail Co., 50 Fed. 929; Still v. Reading, 9 Fed. 40, 4 Woods 345; Miller v. Smith, 5 Fed. 359; Noe v. Prentice, 18 Fed. Cas. No. 10,284.

Amount of damages need not be alleged. American Graphophone Co. v. National Phonograph Co., 127 Fed. 349.

Infringement within six years need not be alleged. Peters v. Hanger, 134 Fed. 586, 67 C. C. A. 386 [reversing 127 Fed. 820, 62 C. C. A. 498].

Allegation upon information and belief sufficient. Murray Co. v. Continental Gin Co., 126 Fed. 533; Wyckoff v. Wagner Typewriter Co., 88 Fed. 515.

Allegations held sufficient see Adeo v. Peck, 42 Fed. 497 [following Adeo v. Peck, 39 Fed. 209]; Schneider v. Missouri Glass Co., 36 Fed. 582; Kaolatype Engraving Co. v. Hoke, 30 Fed. 444; McMillin v. St. Louis, etc., Transp. Co., 18 Fed. 260, 5 McCrary 561.

English practice.—Particulars should be given. Ledgard v. Bull, 11 App. Cas. 648; Batley v. Kynock, L. R. 19 Eq. 229, 44 L. J. Ch. 219, 31 L. T. Rep. N. S. 573, 23 Wkly. Rep. 209; Finnegan v. James, L. R. 19 Eq. 72, 44 L. J. Ch. 185, 23 Wkly. Rep. 373; Needham v. Oxley, 1 Hem. & M. 248, 9 Jur. N. S. 598, 8 L. T. Rep. N. S. 532, 2 New Rep. 267, 11 Wkly. Rep. 745, 71 Eng. Reprint 108; Wenham Co. v. Champion Gas Lamp Co., 63 L. T. Rep. N. S. 827. But see Talbot v. La Roche, 15 C. B. 310, 2 C. L. R. 836, 80 E. C. L. 310.

53. American Graphophone Co. v. National Phonograph Co., 127 Fed. 349.

Interrogations.—Interrogatories as to business not permitted until validity of patent and infringement shown. Lovell Mfg. Co. v. Automatic Wringer Co., 124 Fed. 971; Keller v. Strauss, 88 Fed. 517. Permitted where validity not in issue. Haarmann v. Lueders, 109 Fed. 327.

Production of books.—Complainant cannot compel production of all books of a big concern, but must specify those wanted. Fuller v. Field, 82 Fed. 813, 27 C. C. A. 165.

Damages by name need not be prayed. Emerson v. Simm, 8 Fed. Cas. No. 4,443, 6 Fish. Pat. Cas. 281, 3 Off. Gaz. 293.

Prayers held sufficient see Wyckoff v. Wagner Typewriter Co., 88 Fed. 515; Campbell v. James, 2 Fed. 338, 18 Blatchf. 92.

English practice.—Discovery may be had, although patent has not been sustained. Foxwell v. Webster, 9 Jur. N. S. 1189, 9 L. T. Rep. N. S. 363, 3 New Rep. 103, 12 Wkly. Rep. 94; Benno Jaffe, etc., Lanolin Fabrik v. Richardson, 62 L. J. Ch. 710, 68 L. T. Rep. N. S. 404, 3 Reports 515, 41 Wkly. Rep. 534; Swinborne v. Nelson, 22 L. J. Ch. 331, 1 Wkly. Rep. 155; Renard v. Levinstein, 10 L. T. Rep. N. S. 94, 11 L. T. Rep. N. S. 79, 3 New Rep. 665. Discovery before plea see Jones v. Pratt, 6 H. & N. 697, 7 Jur. N. S. 978, 30 L. J. Exch. 365, 4 L. T. Rep. N. S. 411, 9 Wkly. Rep. 696; Thomas v. Tillie, 17 Ir. C. L. 783. May have discovery of names of purchasers. Murray v. Clayton, L. R. 15 Eq. 115, 42 L. J. Ch. 191, 27 L. T. Rep. N. S. 664, 21 Wkly. Rep. 498; Tetley v. Easton, 18 C. B. 643, 25 L. J. C. P. 293, 86 E. C. L. 643; Crossley v. Stewart, 7 L. T. Rep. N. S. 848, 1 New Rep. 426. Discovery not used oppressively to compel disclosure of secret processes. Ashworth v. Roberts, 45 Ch. D. 623, 60 L. J. Ch. 27, 63 L. T. Rep. N. S. 160, 39 Wkly. Rep. 170.

Canadian practice.—Discovery of secret process cannot be had until the validity of the patent is established. Dickerson v. Radcliffe, 17 Ont. Pr. 586.

54. Verification on "belief" is insufficient. It should be positive. Rubber Tire Wheel Co. v. Davie, 100 Fed. 85. But see Elliott, etc., Book-Typewriter Co. v. Fisher Typewriter Co., 109 Fed. 330.

Assignee may verify. Thompson v. Jewett, 23 Fed. Cas. No. 13,961.

Equitable owner may verify. Goodyear v. Allyn, 10 Fed. Cas. No. 5,555, 6 Blatchf. 33, 3 Fish. Pat. Cas. 374.

55. See cases cited *infra*, this note.

Objection to the jurisdiction of the court may be taken by plea. Edison Electric Light Co. v. U. S. Electric Lighting Co., 35 Fed. 134.

Reissue departing from original.—The defense that a reissue sued on is invalid because it covers an invention not included in the original may be presented by a special plea. Hubbell v. De Land, 14 Fed. 471, 11 Biss. 382.

The defense of laches may be presented by plea. Edison Electric Light Co. v. Equitable L. Assur. Soc., 55 Fed. 478.

Date of patent.—A defense to a suit for infringement on the ground that the patent bears date more than six months later than the notice given to the applicant of the allowance of the application may properly be taken by plea. Western Electric Co. v. North Electric Co., 135 Fed. 79, 67 C. C. A. 553.

56. Hubbell v. De Land, 14 Fed. 471, 11



(2) **REQUISITES AND SUFFICIENCY.** The allegations of the plea should be direct and distinct,<sup>57</sup> and must be limited to a single defense or issue, unless, by permission of the court, defendant is allowed to plead double.<sup>58</sup> A plea may contain an averment of several facts, but they must all conduce to a single point of defense.<sup>59</sup> If the plea contains more than one defense, the practice is not to confine defendant to his first ground of defense by striking out the others, but to allow him either to set down the pleas as an answer, or to put him to his election as to which of the pleas he will abide by.<sup>60</sup>

(3) **EFFECT OF SETTING DOWN FOR ARGUMENT.** By setting down pleas for argument, a complainant admits the facts, but not the conclusions, pleaded therein.<sup>61</sup>

(B) *Answer*—(1) **MATTERS REQUIRED TO BE RAISED BY ANSWER.** Defenses which go to the merits and relate in no wise to matters in abatement or in bar must be raised by answer.<sup>62</sup> But where the infringement complained of has not been committed by defendant but by another person, this issue may be tendered by plea.<sup>63</sup> So also the defenses mentioned in the statute<sup>64</sup> must be set up by answer and not by plea.<sup>65</sup>

(2) **REQUISITES AND SUFFICIENCY.** The allegations of the answer must be sufficiently definite and precise to inform plaintiff what defense he has to meet.<sup>66</sup> It must include all matters of defense on which defendant intends to rely, except

Biss. 382; *Sharp v. Reissner*, 9 Fed. 445, 20 Blatchf. 10.

57. *Westinghouse, etc., Co. v. Stanley*, 65 Fed. 321.

58. *Schnauffer v. Aste*, 148 Fed. 867; *Western Electric Co. v. North Electric Co.*, 135 Fed. 79, 67 C. C. A. 553; *Giant Powder Co. v. Safety Nitro Powder Co.*, 19 Fed. 509.

59. *Reissner v. Anness*, 20 Fed. Cas. No. 11,686, 3 Ban. & A. 148, 12 Off. Gaz. 842.

60. *Reissner v. Anness*, 20 Fed. Cas. No. 11,686, 3 Ban. & A. 148, 12 Off. Gaz. 842.

61. *General Electric Co. v. New England Electric Mfg. Co.*, 128 Fed. 738, 63 C. C. A. 448; *Edison Electric Light Co. v. Equitable L. Assur. Co.*, 55 Fed. 478.

By taking issue upon a plea the complainant admits its sufficiency. *Birdseye v. Heilner*, 26 Fed. 147.

62. See cases cited *infra*, this note.

The defenses of lack of invention and non-infringement cannot be made by plea, but only by answer. *Glucose Sugar Refining Co. v. Douglass, etc., Co.*, 145 Fed. 949; *Western Electric Co. v. North Electric Co.*, 135 Fed. 79, 67 C. C. A. 553; *Union Switch, etc., Co. v. Philadelphia, etc., R. Co.*, 69 Fed. 833; *Leatherbee v. Brown*, 69 Fed. 590; *Korn v. Wiebusch*, 33 Fed. 50; *Sharp v. Reissner*, 9 Fed. 445, 20 Blatchf. 10.

**Issues raised by answer.**—Where a bill for infringement of a patent against a non-resident defendant alleged infringement in the district where the suit was brought, which allegation was denied in the answer, the issue as to infringement is limited to infringement within such district. *Gray v. Grinberg*, 159 Fed. 138 [*affirming* 147 Fed. 732].

63. *Leatherbee v. Brown*, 69 Fed. 590.

64. U. S. Rev. St. (1878) § 4920.

65. *Carnrick v. McKesson*, 8 Fed. 807, 19 Blatchf. 369.

The defenses of a prior patent or previous description in a printed publication must be

set up in an answer, and not in a plea. *Carnrick v. McKesson*, 8 Fed. 807, 19 Blatchf. 369.

**A defense of prior invention and use** cannot be raised by plea, but only by answer. *Arrott v. Standard Sanitary Mfg. Co.*, 113 Fed. 389.

66. See cases cited *infra*, this note.

If fraud or subterfuge is relied on, the allegations must point out specifically the details thereof. *American Sulphite Pulp Co. v. Howland Falls Pulp Co.*, 70 Fed. 986 [*reversed* on other grounds in 80 Fed. 395, 25 C. C. A. 500]; *Clark v. Scott*, 5 Fed. Cas. No. 2,833, 9 Blatchf. 301, 5 Fish. Pat. Cas. 245, 2 Off. Gaz. 4; *Doughty v. West*, 7 Fed. Cas. No. 4,029, 2 Fish. Pat. Cas. 553; *Gear v. Grosvenor*, 10 Fed. Cas. No. 5,291, 6 Fish. Pat. Cas. 314, Holmes 215, 3 Off. Gaz. 380, holding that an allegation that an extension of a patent was procured by fraud, misrepresentation, and in violation of law is simply an allegation of a conclusion of law from facts—which facts are not pleaded.

The denial of infringement, it has been held, must be specific and unevasive. *Chase v. Fillebrown*, 58 Fed. 374; *Miller v. Buchanan*, 5 Fed. 366; *Jordan v. Wallace*, 13 Fed. Cas. No. 7,523, 5 Fish. Pat. Cas. 185, 8 Phila. (Pa.) 165.

The issue of abandonment must be tendered by clear and specific averments. *Western Electric Co. v. Sperry Electric Co.*, 58 Fed. 186, 7 C. C. A. 164.

The defense of prior patent is insufficient without a distinct averment that the invention had been before patented. *Saunders v. Allen*, 53 Fed. 109.

**A denial of the novelty of the invention** described in the patent named in the bill, specifying it by number, is sufficient to raise the issue of invention, although the title of the patent as stated in the answer may be technically inaccurate. *Robinson v. Ameri-*



such as are proper subjects of a plea or a demurrer.<sup>67</sup> Defenses not set up in the answer will not be considered by the court in rendering its decision.<sup>68</sup> More than one defense may be presented in an answer in equity,<sup>69</sup> provided they are not inconsistent;<sup>70</sup> but each should be separately and clearly alleged without condition or qualification.<sup>71</sup> They ought not to be blended in the same allegations where they depend upon different principles.<sup>72</sup>

(3) AMENDMENT. The general rules governing the allowance of amendments to answers in equity cases are applicable in suits for the infringement of patents.<sup>73</sup> An amendment will not be allowed where it appears that the matter of the proposed amendment could, with reasonable diligence, have been sooner introduced into the answer<sup>74</sup> where it would be inconsistent with the answer as filed;<sup>75</sup> or where, upon the state of facts shown by the movant's affidavits, plaintiff's patent would not be defeated.<sup>76</sup> Nor will a motion to amend be regarded favorably where the new defense is dependent wholly on parol evidence.<sup>77</sup> Authority to grant the amendment being established, the court may properly allow it to be entered *nunc pro tunc*.<sup>78</sup>

(4) ADMISSIONS IN ANSWER. An allegation of infringement in the bill should be answered distinctly and unequivocally, and if defendant does not deny or disprove it the fact of infringement is admitted.<sup>79</sup> The fact thus admitted must be

can Car, etc., Co., 135 Fed. 693, 68 C. C. A. 331.

67. See Robinson Pat. § 1115.

68. Session v. Romadka, 145 U. S. 29, 12 S. Ct. 799, 36 L. ed. 609; Puetz v. Bransford, 31 Fed. 458; Burden v. Corning, 4 Fed. Cas. No. 2,143, 2 Fish. Pat. Cas. 477; Howes v. Nute, 12 Fed. Cas. No. 6,790, 4 Cliff. 173, 4 Fish. Pat. Cas. 263; Jennings v. Pierce, 13 Fed. Cas. No. 7,283, 3 Ban. & A. 361, 15 Blatchf. 42; Jordan v. Dobson, 13 Fed. Cas. No. 7,519, 2 Abb. 398, 4 Fish. Pat. Cas. 232, 7 Phila. (Pa.) 533; Pitts v. Edmonds, 19 Fed. Cas. No. 11,191, 1 Biss. 168, 2 Fish. Pat. Cas. 52; Williams v. Boston, etc., R. Co., 29 Fed. Cas. No. 17,716, 4 Ban. & A. 441, 17 Blatchf. 21, 16 Off. Gaz. 906; Wonson v. Peterson, 30 Fed. Cas. No. 17,934, 3 Ban. & A. 249, 13 Off. Gaz. 548; Wyeth v. Stone, 30 Fed. Cas. No. 18,107, 2 Robb Pat. Cas. 23, 1 Story 273. Compare Coupe v. Royer, 155 U. S. 565, 15 S. Ct. 199, 39 L. ed. 263; Dunlap v. Schofield, 152 U. S. 244, 14 S. Ct. 576, 38 L. ed. 426; Lowell Mfg. Co. v. Hogg, 70 Fed. 787.

The defense of prior use should be pleaded, or notice given before trial, with particulars of time, place, and persons. Klein v. Seattle, 63 Fed. 702 [affirmed in 77 Fed. 200, 23 C. C. A. 114].

Want of novelty as a defense to a suit for infringement must be specially alleged. Guidet v. Barber, 11 Fed. Cas. No. 5,857, 5 Off. Gaz. 149; Jordan v. Dobson, 13 Fed. Cas. No. 7,519, 2 Abb. 398, 4 Fish. Pat. Cas. 232, 7 Phila. (Pa.) 533.

The defense of non-patentability can be availed of without setting it up in the answer. Hendy v. Golden State, etc., Iron Works, 127 U. S. 370, 8 S. Ct. 1275, 32 L. ed. 207; Guidet v. Barber, 11 Fed. Cas. No. 5,857, 5 Off. Gaz. 149.

69. Graham v. Mason, 10 Fed. Cas. No. 5,671, 4 Cliff. 88, 5 Fish. Pat. Cas. 1; Jones v. Sewall, 13 Fed. Cas. No. 7,495, 3 Cliff.

563, 6 Fish. Pat. Cas. 343, 3 Off. Gaz. 630.

70. National Mfg. Co. v. Meyers, 7 Fed. 355.

Defenses are inconsistent when they cannot both be true, but where there are different defenses and they may all be true, although entirely different in their nature, they are not inconsistent. National Mfg. Co. v. Meyers, 7 Fed. 355.

71. Graham v. Mason, 10 Fed. Cas. No. 5,671, 4 Cliff. 88, 5 Fish. Pat. Cas. 1.

72. Jones v. Sewall, 13 Fed. Cas. No. 7,495, 3 Cliff. 563, 6 Fish. Pat. Cas. 343, 3 Off. Gaz. 630.

73. See EQUITY, 16 Cyc. 1.

Absence of laches.—The amendment of an answer may be permitted where there has been no laches or delay, where the application was made as soon as the new facts were discovered, and there is nothing contradictory or inconsistent between the answer as filed and the amendment proposed to be made. Morehead v. Jones, 17 Fed. Cas. No. 9,791, 3 Wall. Jr. 306.

74. India Rubber Comb Co. v. Phelps, 13 Fed. Cas. No. 7,025, 8 Blatchf. 85, 4 Fish. Pat. Cas. 315; Ruggles v. Eddy, 20 Fed. Cas. No. 12,118, 1 Ban. & A. 92, 11 Blatchf. 524.

75. Pentlarge v. Beeston, 19 Fed. Cas. No. 10,964, 4 Ban. & A. 23, 15 Blatchf. 347.

76. Richardson v. Croft, 11 Fed. 800.

77. India Rubber Comb Co. v. Phelps, 13 Fed. Cas. No. 7,025, 8 Blatchf. 85, 4 Fish. Pat. Cas. 315.

78. Roemer v. Simon, 95 U. S. 214, 24 L. ed. 384.

79. Chase v. Fillebrown, 58 Fed. 374; Lane v. Sovereign, 43 Fed. 890; Globe Nail Co. v. Superior Nail Co., 27 Fed. 454; Ely v. Monson, etc., Mfg. Co., 8 Fed. Cas. No. 4,431, 4 Fish. Pat. Cas. 64; Goodyear v. Day, 10 Fed. Cas. No. 5,566; Jordan v. Wallace, 13 Fed. Cas. No. 7,523, 5 Fish. Pat. Cas. 185, 8 Phila. 165.



accepted as established,<sup>80</sup> but the admission need go no further than its terms necessarily imply.<sup>81</sup>

(5) NOTICE OF SPECIAL MATTER — (a) NECESSITY. Under the statute<sup>82</sup> persons sued as infringers in a suit in equity, if they give the required notice in their answer, may prove at the final hearing the same special matters in defense to the charge of infringement as those which defendant, in an action at law, may set up under like conditions.<sup>83</sup> Notices of the kind, when the suit is in equity, may be given in the answer or amended answer,<sup>84</sup> and must be filed fully thirty days before trial.<sup>85</sup> Under such a pleading and notice, the respondent in an equity suit may prove that the patentee was not the original and first inventor of the alleged improvement, or that it had been patented or described in some printed publication, or that the invention had been in public use or on sale in this country for more than two years prior to the application; and the provision is that the judgment or decree must be in favor of the defending party if he proves any one or more of these special matters.<sup>86</sup> Where the defenses of prior invention, knowledge, or use is set up, the answer must allege the names and places of residence of those whom they intend to prove have possessed prior knowledge of the thing, and where the same has been used.<sup>87</sup> Testimony of witnesses examined in a case as to alleged prior use, etc., by parties of whom no notice was given in the answer, is incompetent;<sup>88</sup> such testimony is admissible only for the purpose of showing the state of the art at the time of the patentee's invention.<sup>89</sup> But notice of the names and places of residence of the witnesses by whom it is intended to prove such prior knowledge and use is not required.<sup>90</sup> The defenses authorized by statute<sup>91</sup> are separate and independent defenses; and each requires

80. *Jones v. Morehead*, 1 Wall. (U. S.) 155, 17 L. ed. 662; *Lane v. Sovereign*, 43 Fed. 890; *Jordan v. Wallace*, 13 Fed. Cas. No. 7,523, 5 Fish. Pat. Cas. 185, 8 Phila. (Pa.) 165.

81. *Jones v. Morehead*, 1 Wall. (U. S.) 155, 17 L. ed. 662.

82. U. S. Rev. St. (1878) § 4920.

83. *Bates v. Coe*, 98 U. S. 31, 25 L. ed. 68.

The option which is given by statute to file the general issue and give notice does not take away the right to set up the special matter in a plea. *Phillips v. Combstock*, 19 Fed. Cas. No. 11,099, 4 McLean 525, 2 Robb Pat. Cas. 724.

84. *Bates v. Coe*, 98 U. S. 31, 25 L. ed. 68.

85. *Brunswick v. Holzalb*, 4 Fed. Cas. No. 2,057.

Plaintiff is entitled to the thirty days whether the matter be set up by plea or notice. *Phillips v. Combstock*, 19 Fed. Cas. No. 11,099, 4 McLean 525, 2 Robb Pat. Cas. 724.

86. *Bates v. Coe*, 98 U. S. 31, 25 L. ed. 68.

87. *Anderson v. Miller*, 129 U. S. 70, 9 S. Ct. 224, 32 L. ed. 635; *Bates v. Coe*, 98 U. S. 31, 25 L. ed. 68; *Seymour v. Osborne*, 11 Wall. (U. S.) 516, 20 L. ed. 33; *Agawam Woolen Co. v. Jordan*, 7 Wall. (U. S.) 583, 19 L. ed. 177; *Tatum v. Eby*, 60 Fed. 403 (holding that an allegation that a prior machine was built by a person named is not an allegation of prior use by that person); *Brown v. Hall*, 4 Fed. Cas. No. 2,008, 6 Blatchf. 401, 3 Fish. Pat. Cas. 531; *Earl v. Dexter*, 8 Fed. Cas. No. 4,242, 1 Ban. & A. 400, *Holmes* 412, 6 Off. Gaz. 729; *Graham v. Mason*, 10 Fed. Cas. No. 5,671, 4 Cliff. 88, 5 Fish. Pat. Cas. 1; *Orr v. Merrill*, 18 Fed.

Cas. No. 10,591, 2 Robb Pat. Cas. 331, 1 Woodb. & M. 376.

Place of use essential.—A notice of a defense of prior use which recites the names and residences of the alleged users, but wholly omits to describe the place of such use, is fatally defective. *Diamond Match Co. v. Schenck*, 71 Fed. 521 [*affirmed* in 77 Fed. 208, 23 C. C. A. 122].

Prior patents relied on by a defendant in a suit for infringement as anticipations of the one in suit must be pleaded (*Jones v. Cyphers*, 115 Fed. 324 [*affirmed* in 126 Fed. 753, 62 C. C. A. 21]; *Odiorne v. Denney*, 18 Fed. Cas. No. 10,431, 3 Ban. & A. 287, 13 Off. Gaz. 965, 1 N. J. L. J. 183); otherwise they cannot be considered for that purpose, but only to show the state of the art, and to limit the claims involved (*Jones v. Cyphers*, *supra*).

88. *Stevenson v. Magowan*, 31 Fed. 824; *Bragg v. Stockton*, 27 Fed. 509; *Collender v. Griffith*, 6 Fed. Cas. No. 3,000, 11 Blatchf. 213, 3 Off. Gaz. 689; *Decker v. Grote*, 7 Fed. Cas. No. 3,726, 10 Blatchf. 331, 6 Fish. Pat. Cas. 143, 3 Off. Gaz. 65; *La Baw v. Hawkins*, 14 Fed. Cas. No. 7,960, 1 Ban. & A. 428, 6 Off. Gaz. 724.

89. *Kennedy v. Solar Refining Co.*, 69 Fed. 715; *Stevenson v. Magowan*, 31 Fed. 824; *Geier v. Goettinger*, 10 Fed. Cas. No. 5,299, 1 Ban. & A. 553, 7 Off. Gaz. 563; *La Baw v. Hawkins*, 14 Fed. Cas. No. 7,960, 1 Ban. & A. 428, 6 Off. Gaz. 724.

90. *Woodbury Patent Planing Mach. Co. v. Keith*, 101 U. S. 479, 25 L. ed. 939; *Allis v. Buckstaff*, 13 Fed. 879; *Wilton v. Railroads*, 30 Fed. Cas. No. 17,857, 2 Robb Pat. Cas. 641, 1 Wall. Jr. 192.

91. U. S. Rev. St. (1878) § 4920.



its appropriate notice or answer in order to let in evidence to establish the defense.<sup>92</sup>

(b) **SUFFICIENCY.** In giving such notice, the respondent is not bound to be so specific as to relieve the other from all inquiry or effort to investigate the facts. If he fairly supplies his adversary with the means of verifying his proof it is all that can be required;<sup>93</sup> and he is not bound by his notice to impose an unnecessary and embarrassing restriction on his own right of producing proof of what he asserts.<sup>94</sup>

(c) **VERIFICATION.** The notice required to be given by the statute<sup>95</sup> need not be under oath.<sup>96</sup>

(d) **WAIVER.** The absence of notice of want of novelty is waived where the testimony of witnesses to prove such defense is received without objection.<sup>97</sup>

(iii) **CROSS BILL.** The general rules in regard to the filing of a cross bill apply to cross bills filed in patent suits.<sup>98</sup> Thus it must be germane to the original bill,<sup>99</sup> and must not include mere matters of defense.<sup>1</sup>

(iv) **SUPPLEMENTAL BILL.** The general rules relating to supplemental bills apply in suits for infringement of patents.<sup>2</sup>

(v) **DEMURRER AND EXCEPTIONS.** The filing of a demurrer or exceptions is controlled by the ordinary rules of equity pleading.<sup>3</sup> If the patent is void on its

92. *Meyers v. Busby*, 32 Fed. 670, 13 Sawy. 33.

93. *Wise v. Allis*, 9 Wall. (U. S.) 737, 19 L. ed. 784 (holding that it is sufficient, in a suit for infringing a patent for such large objects as millstones, to state the names and addresses of the witnesses without stating the particular mill in which the stones were used); *Smith v. Frazer*, 22 Fed. Cas. No. 13,048, 5 Fish. Pat. Cas. 543, 2 Off. Gaz. 175, 3 Pittsb. (Pa.) 397.

94. *Wise v. Allis*, 9 Wall. (U. S.) 737, 19 L. ed. 784.

95. U. S. Rev. St. (1878) § 4920.

96. *Campbell v. New York*, 45 Fed. 243.

97. *Crouch v. Speer*, 6 Fed. Cas. No. 3,438, 1 Ban. & A. 145, 6 Off. Gaz. 187; *Roemer v. Simon*, 20 Fed. Cas. No. 11,997, 1 Ban. & A. 138, 5 Off. Gaz. 555 [affirmed in 95 U. S. 214, 24 L. ed. 384].

98. See cases cited *infra*, this section.

99. *Welsbach Light Co. v. Cosmopolitan Incandescent Gaslight Co.*, 78 Fed. 639; *New Departure Bell Co. v. Hardware Specialty Co.*, 62 Fed. 462; *International Tooth-Crown Co. v. Carmichael*, 44 Fed. 350; *Johnson R. Signal Co. v. Union Switch, etc.*, Co., 43 Fed. 331; *Curran v. St. Charles Car Co.*, 32 Fed. 835.

1. *Welsbach Light Co. v. Cosmopolitan Incandescent Gaslight Co.*, 78 Fed. 639; *Atkins v. Parke*, 61 Fed. 953, 10 C. C. A. 189; *Puetz v. Bransford*, 32 Fed. 318.

2. **Newly discovered evidence.**—Supplemental bills in the nature of a bill of review permitted upon newly discovered evidence. *Diamond Drill, etc., Co. v. Kelley*, 138 Fed. 833; *Kelley v. Diamond Drill, etc., Co.*, 136 Fed. 855, 69 C. C. A. 599; *Municipal Signal Co. v. Gamewell Fire-Alarm Tel. Co.*, 77 Fed. 452. *Contra*, where the evidence might have been discovered originally. *Westinghouse Electric, etc., Co. v. Stanley Instrument Co.*, 138 Fed. 823, 71 C. C. A. 189; *Bennett v. Schooley*, 77 Fed. 352.

**New infringement.**—Supplemental bill is permitted as to new infringement since original bill. *Westinghouse Air Brake Co. v. Christensen Engineering Co.*, 126 Fed. 764. *Contra*, *Chicago Grain Door Co. v. Chicago, etc., R. Co.*, 137 Fed. 101.

**Supplemental bill setting up adjudication in other circuits** is permitted. *Electrical Accumulator Co. v. Brush Electric Co.*, 44 Fed. 602.

**Supplemental bill bringing in other defendants overruled.** *Tubman v. Wason Mfg. Co.*, 44 Fed. 429.

**Suit on original patent cannot be continued as to reissue by supplemental bill** see *Fry v. Quinlan*, 9 Fed. Cas. No. 5,140, 13 Blatchf. 205. *Contra*, *Woodworth v. Stone*, 30 Fed. Cas. No. 18,021, 2 Robb Pat. Cas. 296, 3 Story 749.

3. Thus the point that the allegations of the bill are insufficient may be taken by demurrer. *Hutton v. Star Slide Seat Co.*, 60 Fed. 747; *Hanlon v. Primrose*, 56 Fed. 600; *Coop v. Dr. Savage Physical Development Inst.*, 47 Fed. 899; *International Terra-Cotta Lumber Co. v. Maurer*, 44 Fed. 618; *Mershon v. J. F. Pease Furnace Co.*, 24 Fed. 741, 23 Blatchf. 329; *Fischer v. O'Shaughnessy*, 6 Fed. 92.

**Demurrer for insufficiency overruled** see *Bragg Mfg. Co. v. Hartford*, 56 Fed. 292; *Allis v. Stowell*, 15 Fed. 242; *Perry v. Corning*, 19 Fed. Cas. No. 11,004, 7 Blatchf. 195; *Woodworth v. Edwards*, 30 Fed. Cas. No. 18,014, 2 Robb Pat. Cas. 610, 3 Woodb. & M. 120.

**Reference in bill to patents not produced** does not place them before the court for consideration on demurrer. *Bowers v. Bucyrus Co.*, 132 Fed. 39; *Warner Bros. Co. v. Warren-Featherbone Co.*, 97 Fed. 604.

**Patentability not admitted by demurrer** see *Kaolatype Engraving Co. v. Hoke*, 30 Fed. 444.

**Exceptions for discovery** see *Graham v.*



face the point may be made by and determined on demurrer.<sup>4</sup> In determining the question of validity the court will take judicial notice of matters of common knowledge.<sup>5</sup>

(vi) *AMENDMENTS, VARIANCE, AND MULTIFARIOUSNESS.* The ordinary rules which govern equity pleading are held applicable in respect of the amendment of pleadings in suits brought for the infringement of patents.<sup>6</sup> They are like-

Mason, 10 Fed. Cas. No. 5,671, 4 Cliff. 88, 5 Fish. Pat. Cas. 1.

Exceptions for surplage see *Stirrat v. Excelsior Mfg. Co.*, 44 Fed. 142.

4. *Richards v. Chase Elevator Co.*, 158 U. S. 299, 15 S. Ct. 831, 39 L. ed. 991 [*affirming* 40 Fed. 165]; *Jacks-Evans Mfg. Co. v. Hemp*, 140 Fed. 254, 71 C. C. A. 646; *American Salesbook Co. v. Carter-Crume Co.*, 125 Fed. 499 [*reversed* on other grounds in 129 Fed. 1004, 62 C. C. A. 679]; *Strom Mfg. Co. v. Weir Frog Co.*, 83 Fed. 170, 27 C. C. A. 502 [*affirming* 75 Fed. 279]; *Covert v. Travers Bros. Co.*, 70 Fed. 788; *Heaton-Peninsular Button-Fastener Co. v. Schlocht-meyer*, 69 Fed. 592; *Root v. Sontag*, 47 Fed. 309; *Bottle Seal Co. v. De la Vergne Bottle, etc., Co.*, 47 Fed. 59; *Fougeres v. Murbarger*, 44 Fed. 292; *West v. Rae*, 33 Fed. 45; *Kaola-type Engraving Co. v. Hoke*, 30 Fed. 444.

Invalidity must be obvious and not doubtful see *Hogan v. Westmoreland Specialty Co.*, 154 Fed. 66, 83 C. C. A. 178; *General Electric Co. v. Campbell*, 137 Fed. 600; *Regensberg v. American Exch. Cigar Co.*, 130 Fed. 549; *American Fibre-Chamois Co. v. Buckskin-Fibre Co.*, 72 Fed. 508, 18 C. C. A. 662; *Cleveland Faucet Co. v. Vulcan Brass Co.*, 72 Fed. 505; *Caldwell v. Powell*, 71 Fed. 970 [*reversed* on other grounds in 73 Fed. 488, 19 C. C. A. 592]; *Covert v. Travers Bros. Co.*, 70 Fed. 788; *Heaton-Peninsular Button-Fastener Co. v. Schlocht-meyer*, 69 Fed. 592; *Drainage Constr. Co. v. Englewood Sewer Co.*, 67 Fed. 141; *Rodwell Mfg. Co. v. Housman*, 58 Fed. 870; *Hanlon v. Primrose*, 56 Fed. 600; *Goebel v. American R. Supply Co.*, 55 Fed. 825; *Standard Oil Co. v. Southern Pac. Co.*, 42 Fed. 295; *Eclipse Mfg. Co. v. Adkins*, 36 Fed. 554; *Dick v. Oil Well Supply Co.*, 25 Fed. 105.

Unless invalidity is so clear that no evidence could change the conclusion, a demurrer will not be sustained. *A. R. Milner Seating Co. v. Yesbera*, 111 Fed. 386, 49 C. C. A. 397; *Neidich v. Fosbenner*, 108 Fed. 266; *Electric Vehicle Co. v. Winton Motor-Carriage Co.*, 104 Fed. 814; *Ballou v. Potter*, 88 Fed. 786; *Patent Button Co. v. Consolidated Fastener Co.*, 84 Fed. 189; *Blessing v. John Trageser Steam Copper Works*, 34 Fed. 753.

Sufficiency of disclosure in patent will not be passed upon on demurrer. *Dade v. Boorum, etc., Co.*, 121 Fed. 135.

Prior art will not be investigated on demurrer. *Rowe v. Blodgett, etc., Co.*, 87 Fed. 868.

Identity with prior expired patents to the same inventor will be considered on demurrer. *Russell v. Kern*, 64 Fed. 581 [*affirmed* in 69 Fed. 94, 16 C. C. A. 154].

Invalidity of reissue when compared to original patent will be determined on demurrer where original patent and reissue before court. *Edison v. American Mutoscope, etc., Co.*, 127 Fed. 361; *Adams, etc., Mfg. Co. v. Meyrose*, 12 Fed. 440.

Cases in which demurrer sustained and patent held void see *Lamson Consol. Service Co. v. Siegel-Cooper Co.*, 106 Fed. 734; *Lyons v. Bishop*, 95 Fed. 154; *E. Ingraham Co. v. E. N. Welch Mfg. Co.*, 92 Fed. 1019, 35 C. C. A. 163; *Warren Featherbone Co. v. Warner Bros. Co.*, 92 Fed. 990; *E. Ingraham Co. v. E. N. Welch Mfg. Co.*, 87 Fed. 1000; *Conley v. Marum*, 83 Fed. 309; *Strom Mfg. Co. v. Weir Frog Co.*, 75 Fed. 279.

Cases in which demurrer overruled see *Farrie Coloring Co. v. Alexander Smith, etc., Carpet Co.*, 109 Fed. 328; *Lyons v. Drucker*, 106 Fed. 416, 45 C. C. A. 368; *J. Elwood Lee Co. v. B. F. Goodrich Co.*, 105 Fed. 627; *Electric Vehicle Co. v. Winton Motor-Carriage Co.*, 104 Fed. 814; *Fairies Mfg. Co. v. Brown*, 102 Fed. 508; *Beer v. Walbridge*, 100 Fed. 465, 40 C. C. A. 496; *Higgin Mfg. Co. v. Scherer*, 100 Fed. 459, 40 C. C. A. 491; *L. E. Waterman Co. v. Vassar College*, 99 Fed. 564; *Warren Featherbone Co. v. Warner Bros. Co.*, 92 Fed. 990; *Chandler Adjustable Chair, etc., Co. v. Heywood Bros., etc., Co.*, 91 Fed. 163; *Ballou v. Potter*, 88 Fed. 786; *Noe v. Prentice*, 18 Fed. Cas. No. 10,284a.

5. *Phillips v. Detroit*, 111 U. S. 604, 4 S. Ct. 580, 28 L. ed. 532; *Terhune v. Phillips*, 99 U. S. 592, 25 L. ed. 293; *Brown v. Piper*, 91 U. S. 37, 23 L. ed. 200; *Strom Mfg. Co. v. Weir Frog Co.*, 83 Fed. 170, 27 C. C. A. 502; *Caldwell v. Powell*, 71 Fed. 970 [*reversed* on other grounds in 73 Fed. 488, 19 C. C. A. 592]; *Heaton-Peninsular Button-Fastener Co. v. Schlocht-meyer*, 69 Fed. 592 [*affirmed* in 72 Fed. 520, 18 C. C. A. 674]; *Root v. Sontag*, 47 Fed. 309; *Eclipse Mfg. Co. v. Adkins*, 36 Fed. 554; *Kaolatype Engraving Co. v. Hoke*, 30 Fed. 444; *Knapp v. Benedict*, 26 Fed. 627.

Court must distinguish between special knowledge and common and general knowledge see *American Fibre-Chamois Co. v. Buckskin-Fibre Co.*, 72 Fed. 508, 18 C. C. A. 662; *Cleveland Faucet Co. v. Vulcan Brass Co.*, 72 Fed. 505. There must be no doubt that the knowledge is common. *Lalance, etc., Mfg. Co. v. Mosheim*, 48 Fed. 452.

6. Incomplete or indefinite allegations of the bill may be cured by amendment (*Union Switch, etc., Co. v. Philadelphia, etc., R. Co.*, 68 Fed. 914; *New Departure Bell Co. v. Bevin Bros. Mfg. Co.*, 64 Fed. 859 [*reversed* on other grounds in 73 Fed. 469, 19 C. C. A. 534]; *Ross v. Ft. Wayne*, 58 Fed. 404 [*reversed* on other grounds in 63 Fed. 466, 11 C. C. A. 288]; *Edison Electric Light Co. v.*



wise held applicable in respect of multifariousness,<sup>7</sup> and variance between the allegations and proofs.<sup>8</sup>

**14. EVIDENCE<sup>9</sup>—a. In General.** The ordinary rules of evidence are applicable to suits for infringement, so far as the special nature of the right in controversy permits and except where modified by special statutory provisions.<sup>10</sup>

*Mather Electric Co.*, 53 Fed. 244; *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 20 Fed. 505, and amendment is permitted to bring in some new fact (*John R. Williams Co. v. Miller, etc., Mfg. Co.*, 108 Fed. 967; *Patent-Button Co. v. Pilcher*, 95 Fed. 479; *Westinghouse Electric, etc., Co. v. Mustard*, 87 Fed. 336; *Reay v. Berlin, etc., Envelope Co.*, 30 Fed. 448; *Reay v. Raynor*, 19 Fed. 308; *Holste v. Robertson*, 4 Ch. D. 9, 46 L. J. Ch. 1, 35 L. T. Rep. N. S. 457, 25 Wkly. Rep. 35; *Penn v. Bibby*, L. R. 1 Eq. 548).

**Amendment of answer.**—The answer may be amended by giving new names of witnesses or new facts of anticipations. *Roemer v. Simon*, 95 U. S. 214, 24 L. ed. 384; *Standard Elevator Interlock Co. v. Ramsey*, 130 Fed. 151; *Campbell v. New York*, 45 Fed. 243; *Babcock, etc., Co. v. Pioneer Iron-Works*, 34 Fed. 338; *Morehead v. Jones*, 17 Fed. Cas. No. 9,791, 3 Wall. Jr. 306. Amendment to answer refused where facts should have been discovered and alleged originally (*India Rubber Comb Co. v. Phelps*, 13 Fed. Cas. No. 7,025, 8 Blatchf. 85, 4 Fish. Pat. Cas. 315); or where amendment would not change the decision (*Richardson v. Croft*, 11 Fed. 800).

**Amendment to deny former admissions** will be refused. *Pentlargo v. Beeston*, 19 Fed. Cas. No. 10,964, 4 Ban. & A. 23, 15 Blatchf. 347; *Ruggles v. Eddy*, 20 Fed. Cas. No. 12,118, 1 Ban. & A. 92, 11 Blatchf. 524.

**7. Patents capable of conjoint use.**—Suit on several patents is not multifarious where they are capable of conjoint use and such use is alleged. *Gamewell Fire-Alarm Tel. Co. v. Chillicothe*, 7 Fed. 351; *Gillespie v. Cummings*, 10 Fed. Cas. No. 5,434, 1 Ban. & A. 587, 3 Sawy. 259; *Meerse v. Allen*, 16 Fed. Cas. No. 9,393a; *Nourse v. Allen*, 18 Fed. Cas. No. 10,367, 4 Blatchf. 376, 3 Fish. Pat. Cas. 63. Unless conjoint use by defendant is alleged, a suit on several patents is multifarious. *Western Tel. Mfg. Co. v. American Electric Tel. Co.*, 137 Fed. 603; *Russell v. Winchester Repeating Arms Co.*, 97 Fed. 634; *Louden Mach. Co. v. Ward*, 96 Fed. 232; *Union Switch, etc., Co. v. Philadelphia, etc., R. Co.*, 69 Fed. 833; *Hayes v. Dayton*, 8 Fed. 702, 18 Blatchf. 420; *Hayes v. Bickelhaupt*, 11 Fed. Cas. No. 6,261b, 19 Off. Gaz. 177; *Nellis v. McLanahan*, 17 Fed. Cas. No. 10,999, 6 Fish. Pat. Cas. 286.

A bill primarily for infringement is not rendered multifarious by setting out a contract between plaintiff and defendant binding defendant not to contest the validity of the patent. *Dunham v. Bent*, 72 Fed. 60.

A bill claiming relief for interfering patents and infringement is not multifarious. *Stonemetz Printers' Mach. Co. v. Brown Co.*, 46 Fed. 72.

A bill on expired and unexpired patents is not multifarious.—*Huntington Dry Pulverizer Co. v. Virginia-Carolina Chemical Co.*, 130 Fed. 558; *Roemer v. Logowitz*, 20 Fed. Cas. No. 11,996.

A bill for infringement praying cancellation of assignment is not multifarious. *Atherton Mach. Co. v. Atwood Morrison Co.*, 102 Fed. 949, 43 C. C. A. 72.

A bill praying relief from infringement of a patent and unfair competition is multifarious. *George Frost Co. v. Kora Co.*, 136 Fed. 487 [affirmed in 140 Fed. 987, 71 C. C. A. 19]; *Ball, etc., Fastener Co. v. Cohn*, 90 Fed. 664.

A bill joining infringement of a patent and slander is multifarious. *Fougeres v. Murbarger*, 44 Fed. 292.

A bill to enjoin infringement and the use of the name applied to the article by the patentee is not multifarious. *Adam v. Folger*, 120 Fed. 260, 56 C. C. A. 540; *Jaros Hygienic Underwear Co. v. Fleecce Hygiene Underwear Co.*, 60 Fed. 622.

*8. Tryon v. White*, 24 Fed. Cas. No. 14,208, Pet. C. C. 96, 1 Robb Pat. Cas. 64.

9. See, generally, EVIDENCE.

10. See, generally, EVIDENCE.

**Prior patents and publications.**—Prior patents are admissible in actions at law under the general issue without any special notice, and in equity suits without any averment in the answer touching the subject, to show the state of the art (*Grier v. Wilt*, 120 U. S. 412, 7 S. Ct. 718, 30 L. ed. 712; *Jones v. Cyphers*, 126 Fed. 753, 62 C. C. A. 21; *Parsons v. New Home Sewing Mach. Co.*, 125 Fed. 386 [affirmed in 134 Fed. 394, 67 C. C. A. 392]; *Myers v. Sternheim*, 97 Fed. 625, 38 C. C. A. 345; *American Saddle Co. v. Hogg*, 1 Fed. Cas. No. 315, 5 Fish. Pat. Cas. 353, *Holmes* 133, 2 Off. Gaz. 59. But see *Clark v. Adie*, 3 Ch. D. 134, 45 L. J. Ch. 228, 35 L. T. Rep. N. S. 349, 24 Wkly. Rep. 1007 [affirmed in 2 App. Cas. 423, 46 L. J. Ch. 598, 27 L. T. Rep. N. S. 1, 26 Wkly. Rep. 451]; *Atty.-Gen. v. Taylor*, Prec. Ch. 59, 24 Eng. Reprint 29), and to aid the court in the construction of a patent sued on (*Grier v. Wilt*, *supra*; *Eachus v. Broomall*, 115 U. S. 429, 6 S. Ct. 229, 29 L. ed. 419; *Parsons v. New Home Sewing Mach. Co.*, *supra*), but not to show want of novelty in the invention claimed in complainant's patent (*Grier v. Wilt*, *supra*; *American Saddle Co. v. Hogg*, *supra*; *Howe v. Williams*, 12 Fed. Cas. No. 6,778, 2 Cliff. 245, 2 Fish. Pat. Cas. 395), or for the purpose of showing anticipation (*Jones v. Cyphers*, *supra*. See also *Myers v. Brown*, 102 Fed. 250, 42 C. C. A. 320), and a prior foreign publication is competent as evidence in regard to the state of the art, and as a foundation for the inquiry



**b. Presumptions and Burden of Proof.** The patent is presumptively valid and the burden is on defendant to show its invalidity<sup>11</sup> beyond a reasonable

whether it required invention to pass from a structure set forth in the publication to the patented structure (*French v. Carter*, 137 U. S. 239, 11 S. Ct. 90, 34 L. ed. 664). Patents relied on must be properly introduced. *Oregon Imp. Co. v. Excelsior Coal Co.*, 132 U. S. 215, 10 S. Ct. 54, 33 L. ed. 344; *Seymour v. Osborne*, 11 Wall. (U. S.) 516, 20 L. ed. 33; *Vermont Farm Mach. Co. v. Gibson*, 56 Fed. 143, 5 C. C. A. 451; *Alaska Refrigerator Co. v. Wisconsin Refrigerator Co.*, 47 Fed. 324; *National Pump Cylinder Co. v. Simmons Hardware Co.*, 18 Fed. 324, 5 McCrary 592; *Cahoon v. Ring*, 4 Fed. Cas. No. 2,292, 1 Cliff. 592, 1 Fish. Pat. Cas. 397; *Grover, etc., Sewing-Mach. Co. v. Sloat*, 11 Fed. Cas. No. 5,846, 2 Fish. Pat. Cas. 112. Ex parte affidavits are not admissible. *Lilienthal v. Washburn*, 8 Fed. 707, 4 Woods 65.

**Decision and evidence in interference** involving different parties are not admissible. *Westinghouse Electric, etc., Co. v. Roberts*, 125 Fed. 6.

**Admissions or declarations.**—It is competent to prove admissions or declarations by a party to the suit bearing upon the question at issue. *National Cash-Register Co. v. Leland*, 94 Fed. 502, 37 C. C. A. 372; *Rose v. Hirsh*, 77 Fed. 469, 23 C. C. A. 246; *Wright v. Postel*, 44 Fed. 352; *Sugar Apparatus Mfg. Co. v. Yaryan Mfg. Co.*, 43 Fed. 140; *Thacher Heating Co. v. Drummond*, 23 Fed. Cas. No. 13,865, 3 Ban. & A. 138. Admissions by the inventor are not binding against the assignee. *Wilson v. Simpson*, 9 How. (U. S.) 109, 13 L. ed. 66.

**Opinion expressed before suit is not binding.** *Osgood Dredge Co. v. Metropolitan Dredge Co.*, 75 Fed. 670, 21 C. C. A. 491.

**Testimony that witness never heard of invention before plaintiff made it is not admissible.** *Hitchcock v. Shoninger Melodeon Co.*, 11 Fed. Cas. No. 6,537.

**Evidence of purchase by plaintiff's agent from defendant for purpose of showing infringement is admissible.** *Badische Anilin, etc., Fabrik v. Klopstein*, 125 Fed. 543; *De Florez v. Reynolds*, 7 Fed. Cas. No. 3,742, 3 Ban. & A. 292, 14 Blatchf. 505. *Contra*, *Byam v. Bullard*, 4 Fed. Cas. No. 2,262, 1 Curt. 100.

**Names of customers.**—Defendant is not compelled to give names of customers where infringement and validity denied. *Roberts v. Walley*, 14 Fed. 167.

**Experiments conducted with a view to litigation are looked on with distrust.** *Young v. Fernie*, 4 Giffard 577, 10 Jur. N. S. 926, 10 L. T. Rep. N. S. 861, 4 New Rep. 218, 12 Wkly. Rep. 901, 66 Eng. Reprint 836.

**Communications to patent agent as such are not privileged.** *Moseley v. Victoria Rubber Co.*, 55 L. T. Rep. N. S. 482.

**Inadmissible evidence** see *St. Paul Plow-Works v. Starling*, 140 U. S. 184, 11 S. Ct. 803, 35 L. ed. 404; *Blanchard v. Putnam*, 8

Wall. (U. S.) 420, 19 L. ed. 433; *Harper, etc., Co. v. Wilgus*, 56 Fed. 587, 6 C. C. A. 45; *Seibert Cylinder Oil-Cup Co. v. William Powell Co.*, 38 Fed. 600; *Judson v. Cope*, 14 Fed. Cas. No. 7,565, 1 Bond 327, 1 Fish. Pat. Cas. 615.

**Weight of evidence** see *Brill v. St. Louis Car Co.*, 80 Fed. 909; *Dobson v. Graham*, 49 Fed. 17 [affirmed in 154 U. S. 501, 14 S. Ct. 1145, 38 L. ed. 1076]; *Evans v. Eaton*, 8 Fed. Cas. No. 4,559, Pet. C. C. 322, 1 Robb Pat. Cas. 68; *Woodman v. Stimpson*, 30 Fed. Cas. No. 17,979, 3 Fish. Pat. Cas. 98 [reversed on other grounds in 10 Wall. 117, 19 L. ed. 866].

**Rebuttal.**—*Prima facie* evidence cannot be put in as rebuttal. *Smith v. Uhrich*, 94 Fed. 865; *American Paper Barrel Co. v. Laraway*, 28 Fed. 141; *Cahoon v. Ring*, 4 Fed. Cas. No. 2,292, 1 Cliff. 592, 1 Fish. Pat. Cas. 397; *Stainthorp v. Humiston*, 22 Fed. Cas. No. 13,281, 4 Fish. Pat. Cas. 107.

**Invention prior to date proved by defendant may be shown on rebuttal.** *St. Paul Plow-Works v. Starling*, 140 U. S. 184, 4 S. Ct. 803, 35 L. ed. 404 [affirming 29 Fed. 790].

**11. Atwood-Morrison Co. v. Sipp Electric Co.**, 136 Fed. 859 [reversed on other grounds in 142 Fed. 149]; *De Lamar v. De Lamar Min. Co.*, 110 Fed. 538 [affirmed in 117 Fed. 240, 54 C. C. A. 272]; *National Co. v. Belcher*, 71 Fed. 876, 18 C. C. A. 375; *William v. Bernard*, 41 Fed. 358; *American Bell Tel. Co. v. Molecular Tel. Co.*, 32 Fed. 214, 23 Blatchf. 253; *Hoe v. Cottrell*, 1 Fed. 597, 17 Blatchf. 546; *Allen v. Blunt*, 1 Fed. Cas. No. 217, 2 Robb Pat. Cas. 530, 2 Woodb. & M. 121; *Brady v. Atlantic Works*, 3 Fed. Cas. No. 1,794, 2 Ban. & A. 436, 4 Cliff. 408, 10 Off. Gaz. 702; *Brown v. Whittemore*, 4 Fed. Cas. No. 2,033, 5 Fish. Pat. Cas. 524, 2 Off. Gaz. 248; *Howes v. Nute*, 12 Fed. Cas. No. 6,790, 4 Cliff. 173, 4 Fish. Pat. Cas. 263; *Jordan v. Dobson*, 13 Fed. Cas. No. 7,519, 2 Abb. 398, 4 Fish. Pat. Cas. 232, 7 Phila. (Pa.) 533; *Pitts v. Hall*, 19 Fed. Cas. No. 11,192, 2 Blatchf. 229, Fish. Pat. Rep. 441.

**Where it does not appear that the patent was granted after proper consideration of the prior art, the presumption of validity is not so strong.** *American Soda Fountain Co. v. Sample*, 130 Fed. 145, 64 C. C. A. 497; *Cleveland Foundry Co. v. Kaufmann*, 126 Fed. 658 [reversed on other grounds in 135 Fed. 360, 68 C. C. A. 658]; *Earle v. Wanamaker*, 87 Fed. 740. Where defendant shows use by others before application the burden of proof shifts to patentee to show prior invention. *Clark Thread Co. v. Willimantic Linen Co.*, 140 U. S. 481, 11 S. Ct. 846, 35 L. ed. 521; *Michigan Cent. R. Co. v. Consolidated Car-Heating Co.*, 67 Fed. 121, 14 C. C. A. 232; *Caverly v. Deere*, 52 Fed. 758.

**Presumption as to date of invention.**—The date of application printed in the patent is presumably the date of invention. *Drewson*



doubt.<sup>12</sup> But the burden is on plaintiff to prove infringement,<sup>13</sup> and that notice of his rights was given by marking the patented article.<sup>14</sup> He must also prove facts which will show the amount of damages.<sup>15</sup>

**c. Evidence as to Invalidity of Patent.** Evidence of any fact tending to show that the patent is invalid is admissible,<sup>16</sup> provided proper basis for it is laid in the pleadings or under the general issue and provided thirty days' notice in writing is given to plaintiff or his attorney. To prove previous invention, knowledge, or use of a thing patented defendant must state the names of the patentees, dates of the patents, the names and residences of the alleged prior users, and where and by whom the invention was used.<sup>17</sup>

*v. Hartje Paper Mfg. Co.*, 131 Fed. 734, 65 C. C. A. 548.

Technical defenses must be clearly proved. *A. B. Dick Co. v. Fuerth*, 57 Fed. 834.

12. *Deering v. Winona Harvester Works*, 155 U. S. 286, 15 S. Ct. 118, 39 L. ed. 153; *Washburn, etc., Mfg. Co. v. Beat 'Em All Barbed-Wire Co.*, 143 U. S. 275, 12 S. Ct. 443, 36 L. ed. 154; *Western Electric Co. v. Home Tel. Co.*, 85 Fed. 649; *Osgood Dredge Co. v. Metropolitan Dredging Co.*, 75 Fed. 670, 21 C. C. A. 491; *Frankfort Whisky Process Co. v. Mill Creek Distilling Co.*, 37 Fed. 533; *Tompkins v. Gage*, 24 Fed. Cas. No. 14,088, 5 Blatchf. 268, 2 Fish. Pat. Cas. 577; *Wood v. Cleveland Rolling-Mill Co.*, 30 Fed. Cas. No. 17,941, 4 Fish. Pat. Cas. 550.

13. Infringement is a tort which must be proved and not left to conjecture. *Bates v. Coe*, 98 U. S. 31, 25 L. ed. 68; *Elizabeth v. American Nicholson Pavement Co.*, 97 U. S. 126, 24 L. ed. 1000; *National Casket Co. v. Stolts*, 135 Fed. 534, 68 C. C. A. 84; *King v. Anderson*, 90 Fed. 500; *Stirling Co. v. Pierpoint Boiler Co.*, 72 Fed. 780, 77 Fed. 1007, 22 C. C. A. 680; *Masten v. Hunt*, 51 Fed. 216 [affirmed in 55 Fed. 78, 5 C. C. A. 42]; *Royer v. Chicago Mfg. Co.*, 20 Fed. 853; *National Car-Brake Shoe Co. v. Detroit, etc., R. Co.*, 4 Fed. 224; *Cook v. Howard*, 6 Fed. Cas. No. 3,160, 4 Fish. Pat. Cas. 269; *Dixon v. Moyer*, 7 Fed. Cas. No. 3,931, 1 Robb Pat. Cas. 324, 4 Wash. 68; *Hodge v. Hudson River R. Co.*, 12 Fed. Cas. No. 6,559, 6 Blatchf. 85, 3 Fish. Pat. Cas. 410; *Hudson v. Draper*, 12 Fed. Cas. No. 6,834, 4 Cliff. 178, 4 Fish. Pat. Cas. 256; *Parker v. Stiles*, 18 Fed. Cas. No. 10,749, 5 Fish. Pat. Rep. 319, 5 McLean 44; *Sands v. Wardwell*, 21 Fed. Cas. No. 12,306, 3 Cliff. 277; *Betts v. Willmott*, L. R. 6 Ch. 239, 25 L. T. Rep. N. S. 188, 19 Wkly. Rep. 369.

Use of entire combination and not merely part must be shown. *Vance v. Campbell*, 1 Black (U. S.) 427, 17 L. ed. 168; *Tatum v. Gregory*, 41 Fed. 142.

Sale at defendant's place of business by an employee is presumably a sale by defendant. *Hutler v. De Q. Bottle Stopper Co.*, 128 Fed. 283, 62 C. C. A. 652.

Use of device before patent raises no presumption of infringement afterward. *Brill v. St. Louis Car Co.*, 80 Fed. 909.

In a suit against a mere user evidence should be convincing. *Marcus v. Sutton*, 124 Fed. 74.

Where infringement is not explicitly denied, little proof is necessary. *Hutter v. De Q.*

*Bottle Stopper Co.*, 119 Fed. 190; *Gear v. Fitch*, 10 Fed. Cas. No. 5,290, 3 Ban. & A. 573, 16 Off. Gaz. 1231; *Goodyear v. Berry*, 10 Fed. Cas. No. 5,556, 2 Bond 189, 3 Fish. Pat. Cas. 439.

Failure of defendant to disclose what he uses justifies presumption of infringement. *Read v. Schulze-Berge*, 78 Fed. 493; *Ely v. Monson, etc., Mfg. Co.*, 8 Fed. Cas. No. 4,431, 4 Fish. Pat. Cas. 64; *Piper v. Brown*, 19 Fed. Cas. No. 11,181, 6 Fish. Pat. Cas. 240, *Holmes* 196, 3 Off. Gaz. 97.

Identity of product raises presumption that process is the same. *Matheson v. Campbell*, 77 Fed. 280.

Where use is proved the burden is on defendant to show license. *Armat Moving Picture Co. v. Edison Mfg. Co.*, 121 Fed. 559 [reversed on other grounds in 125 Fed. 939, 60 C. C. A. 380]; *Searls v. Bouton*, 12 Fed. 140, 20 Blatchf. 426; *Watson v. Smith*, 7 Fed. 350; *Day v. New England Car-Spring Co.*, 7 Fed. Cas. No. 3,688.

Insufficient proof of infringement.—*Edison Electric Light Co. v. Kaelber*, 76 Fed. 804; *Commos v. Somers*, 49 Fed. 920; *Judson Mfg. Co. v. Burge-Donahoe Co.*, 47 Fed. 463; *Parsons v. Colgate*, 15 Fed. 600, 21 Blatchf. 171; *Standard Measuring Mach. Co. v. Teague*, 15 Fed. 390.

Sufficient proof of infringement see *White v. Hunter*, 47 Fed. 819; *Schneider v. Missouri Glass Co.*, 36 Fed. 582; *Kiesele v. Haas*, 32 Fed. 794; *Peterson v. Simpkins*, 25 Fed. 486.

14. *Lorain Steel Co. v. New York Switch, etc., Co.*, 153 Fed. 205.

Effect of admission of notice see *Lorain Steel Co. v. New York Switch, etc., Co.*, 153 Fed. 205.

15. *Robertson v. Blake*, 94 U. S. 728, 24 L. ed. 245; *Lee v. Pillsbury*, 49 Fed. 747; *National Car-Brake Shoe Co. v. Terre Haute Car, etc., Co.*, 19 Fed. 514; *Burdell v. Denig*, 4 Fed. Cas. No. 2,142, 2 Fish. Pat. Cas. 588; *Carter v. Baker*, 5 Fed. Cas. No. 2,472, 4 Fish. Pat. Cas. 404, 1 Sawy. 512. See also *supra*, XIII, C, 12, a, b.

Where the amount of actual damages is not proved, nominal damages only may be collected. *New York v. Ransom*, 23 How. (U. S.) 487, 16 L. ed. 515.

Doubts resolved against wanton infringer see *Rose v. Hirsh*, 94 Fed. 177, 36 C. C. A. 132, 51 L. R. A. 801.

16. See *supra*, XIII, A, 1.

17. U. S. Rev. St. (1878) § 4920. And see *supra*, XIII, C, 3, d.



d. **Expert Witnesses.** It is proper in patent cases to produce the testimony of expert witnesses to explain the inventions and the differences between inventions;<sup>18</sup> but their testimony is not necessarily accepted as controlling contrary to the judgment of the court,<sup>19</sup> nor is mere opinion evidence admissible.<sup>20</sup>

e. **Estoppel.** Disclaimers<sup>21</sup> and admissions made in the prosecution of the application in the patent office are binding upon the patentee and copies of the office records are admissible to prove them.<sup>22</sup> Defendant cannot as against his assignee produce evidence to show that the patent assigned by him is invalid or that the assignee's title is not good.<sup>23</sup>

f. **Evidence as to Infringement.** Evidence is admissible which tends to show whether or not the claims of the patent properly construed apply to the alleged infringing device. Prior patents and publications are admissible as bearing upon the scope but not the validity of the patent in suit, even where they are not set up in the pleadings or formal notice.<sup>24</sup>

g. **Secret Inventions.** A witness is not required to disclose a secret invention or discovery made or owned by himself.<sup>25</sup>

h. **Proving Patents and Patent Office Records.** A certified copy of any record, book, paper, or drawing belonging to the patent office and of letters

18. *Fenton Mfg. Co. v. Office Specialty Co.*, 12 App. Cas. (D. C.) 201; *National Cash-Register Co. v. Leland*, 94 Fed. 502, 37 C. C. A. 372; *American Linoleum Mfg. Co. v. Nairn Linoleum Co.*, 44 Fed. 755; *Conover v. Rapp*, 6 Fed. Cas. No. 3,124, 4 Fish. Pat. Cas. 57; *Hudson v. Draper*, 12 Fed. Cas. No. 6,834, 4 Cliff. 178, 4 Fish. Pat. Cas. 256; *Badische Anilin, etc., Fabrik v. Levenstein*, 24 Ch. D. 156, 52 L. J. Ch. 704, 48 L. T. Rep. N. S. 822, 31 Wkly. Rep. 913 [affirmed in 12 App. Cas. 710, 57 L. T. Rep. N. S. 853]; *Seed v. Higgins*, 8 H. L. Cas. 550, 6 Jur. N. S. 1264, 30 L. J. Q. B. 314, 3 L. T. Rep. N. S. 101, 11 Eng. Reprint 544. Where difficult questions are involved, experts are necessary. *Fay v. Mason*, 127 Fed. 325, 62 C. C. A. 159; *Waterman v. Shipman*, 55 Fed. 982, 5 C. C. A. 371; *Miller v. Smith*, 5 Fed. 359. Where questions involved are clear, experts should not be allowed. *Ely v. Monson, etc., Mfg. Co.*, 8 Fed. Cas. No. 4,431, 4 Fish. Pat. Cas. 64. Differences in designs may be pointed out. *Myers v. Sternheim*, 97 Fed. 625, 38 C. C. A. 345.

Model is the best evidence of character of machine. *Swift v. Whisen*, 23 Fed. Cas. No. 13,700, 2 Bond 115, 3 Fish. Pat. Cas. 343.

19. *Overweight Counterbalance Elevator Co. v. Improved Order Red Men's Hall Assoc.*, 94 Fed. 155, 36 C. C. A. 125; *Hanifen v. Godshalk Co.*, 84 Fed. 649, 28 C. C. A. 507; *Spaulding v. Tucker*, 22 Fed. Cas. No. 13,220, Deady 649.

Evidence of experiments accepted where not contradicted. *Badische Anilin, etc., Fabrik v. Klipstein, etc., Co.*, 125 Fed. 543; *A. B. Dick Co. v. Belke*, 86 Fed. 149.

Testimony of experts as to the result of experiments is not to be lightly accepted. *National Co. v. Belcher*, 71 Fed. 876, 18 C. C. A. 375.

Conflict of testimony see *Béné v. Jeantet*, 129 U. S. 683, 9 S. Ct. 428, 32 L. ed. 803.

20. *Corning v. Burden*, 15 How. (U. S.) 252, 14 L. ed. 683; *National Cash-Register*

*Co. v. Leland*, 94 Fed. 502, 37 C. C. A. 372; *Lee v. Pillsbury*, 49 Fed. 747.

21. See *supra*, IX, E.

22. *Crawford v. Heysinger*, 123 U. S. 589, 8 S. Ct. 399, 31 L. ed. 269; *Corning v. Burden*, 15 How. (U. S.) 252, 14 L. ed. 683; *Philadelphia, etc., Co. v. Stimpson*, 14 Pet. (U. S.) 448, 10 L. ed. 535; *Richardson v. Campbell*, 72 Fed. 525; *Emerson v. Hogg*, 8 Fed. Cas. No. 4,440, 2 Blatchf. 1, Fish. Pat. Rep. 77. See *supra*, X, A, 5.

23. See *supra*, VI, F, 3.

24. *Grier v. Wilt*, 120 U. S. 412, 7 S. Ct. 718, 30 L. ed. 712; *Brown v. Piper*, 91 U. S. 37, 23 L. ed. 200; *Jones v. Cyphers*, 126 Fed. 753, 62 C. C. A. 21; *Parsons v. New Home Sewing Mach. Co.*, 125 Fed. 386 [affirmed in 134 Fed. 394, 67 C. C. A. 392]; *Myers v. Brown*, 102 Fed. 250, 42 C. C. A. 320; *Universal Winding Co. v. Willimantic Linen Co.*, 82 Fed. 228; *Dayton Loop, etc., Co. v. Ruhl*, 55 Fed. 649; *Forschner v. Baumgarten*, 26 Fed. 858; *American Saddle Co. v. Hogg*, 1 Fed. Cas. No. 315, 5 Fish. Pat. Cas. 353, *Holmes* 133, 2 Off. Gaz. 59; *Middletown Tool Co. v. Judd*, 17 Fed. Cas. No. 9,536, 3 Fish. Pat. Cas. 141; *Westlake v. Cartler*, 29 Fed. Cas. No. 17,451, 6 Fish. Pat. Cas. 519, 4 Off. Gaz. 636.

Evidence held insufficient to show sale of infringing article within district essential to give jurisdiction see *Gray v. Grinberg*, 147 Fed. 732 [affirmed in 159 Fed. 138].

25. U. S. Rev. St. (1878) § 4908 [U. S. Comp. St. (1901) p. 3390]; *Stokes Bros. Mfg. Co. v. Heller*, 56 Fed. 297; *Dobson v. Graham*, 49 Fed. 17.

Other methods of performing the invention claimed in the patent are not protected as secret under U. S. Rev. St. (1878) § 4908 [U. S. Comp. St. (1901) p. 3390]. *Dornan v. Keefer*, 49 Fed. 462.

Patent office rule of secrecy of application has been held not to apply in court. *Diamond Match Co. v. Oshkosh Match Works*, 63 Fed. 984.



patent may be received in evidence in place of the originals.<sup>26</sup> A copy of a foreign patent certified by the commissioner of patents of the United States will be accepted as *prima facie* evidence of the fact of the granting of such patent and of the date and contents thereof.<sup>27</sup> The printed copies of specifications and drawings of patents deposited in the capitols of the various states and territories and certified by the commissioner of patents will be received as evidence of all matters therein contained.<sup>28</sup>

**i. Judicial Notice.** Courts may properly take judicial notice of facts that may be regarded as part of the common knowledge of every person of ordinary understanding and intelligence.<sup>29</sup> The court is permitted to avail itself of common knowledge in regard to matters of science, and by that knowledge to define the scope of the patent.<sup>30</sup> The court may take judicial notice of a thing in common use throughout the country.<sup>31</sup> The court may refer to dictionaries and encyclopedias for the definition and scope of scientific terms or names, when necessary to go outside of the record, or where the testimony of experts is conflicting.<sup>32</sup> For the purpose of ascertaining the state of the art the court may take judicial notice of what is disclosed by its own records in a previous case involving devices appertaining to the same art.<sup>33</sup> The courts will not take judicial notice of patents or inventions.<sup>34</sup>

**15. ISSUES, PROOF, AND VARIANCE.** The issue of fraud in the reissue of a patent can only be raised by distinct and special allegations in the plea or answer.<sup>35</sup> The general rule that the proof and pleading must correspond applies to actions at law and suits in equity for infringement of patents.<sup>36</sup> In actions at law for

26. U. S. Rev. St. (1878) § 892 [U. S. Comp. St. (1901) p. 673]; *Crawford v. Heysinger*, 123 U. S. 589, 8 S. Ct. 399, 31 L. ed. 269; *Corning v. Burden*, 15 How. (U. S.) 252, 14 L. ed. 683; *Philadelphia, etc., Co. v. Stimpson*, 14 Pet. (U. S.) 448, 10 L. ed. 535; *Richardson v. Campbell*, 72 Fed. 525; *Emerson v. Hogg*, 8 Fed. Cas. No. 4,440, 2 Blatchf. 1, Fish. Pat. Rep. 77.

**Assignment of patent.**—That an assignment of a patent was recorded and is produced and put in evidence by a subsequent assignee in a suit for infringement is sufficient evidence of its delivery. *Shelby Steel Tube Co. v. Delaware Seamless Tube Co.*, 151 Fed. 64 [affirmed on other grounds in 160 Fed. 928].

27. U. S. Rev. St. (1878) § 893 [U. S. Comp. St. (1901) p. 673].

Foreign patent may be proved by copy under seal of country. *Gatling v. Newell*, 9 Ind. 572; *Schoerken v. Swift*, 7 Fed. 469, 19 Blatchf. 209.

28. U. S. Rev. St. (1878) § 894 [U. S. Comp. St. (1901) p. 673].

29. *Phillips v. Detroit*, 111 U. S. 604, 4 S. Ct. 580, 28 L. ed. 532; *King v. Gallun*, 109 U. S. 99, 3 S. Ct. 85, 27 L. ed. 870.

Of facts cited in encyclopedias, dictionaries, or other publications, judicial notice will not be taken unless they are of such universal notoriety and so generally understood that they may be regarded as forming part of the common knowledge of every person. *Kaolatype Engraving Co. v. Hoke*, 30 Fed. 444.

30. *Knapp v. Benedict*, 26 Fed. 627.

31. *Black Diamond Coal-Min. Co. v. Excelsior Coal Co.*, 156 U. S. 611, 15 S. Ct. 482, 39 L. ed. 553; *Phillips v. Detroit*, 116 U. S.

604, 4 S. Ct. 580, 28 L. ed. 532; *King v. Gallun*, 109 U. S. 99, 3 S. Ct. 85, 27 L. ed. 870; *Slawson v. Grand St., etc., R. Co.*, 107 U. S. 649, 2 S. Ct. 663, 27 L. ed. 576; *Terhune v. Phillips*, 99 U. S. 592, 25 L. ed. 293; *Brown v. Piper*, 91 U. S. 37, 23 L. ed. 200; *Root v. Sontag*, 47 Fed. 309.

Where the court has the slightest doubt that such was the fact, it will not take judicial notice that certain similar articles exhibited at the argument were in use before the date of the patent. *Lalance, etc., Mfg. Co. v. Mosheim*, 48 Fed. 452.

32. *Panzl v. Battle Island Paper, etc., Co.*, 132 Fed. 607.

33. *American Salesbook Co. v. Carter-Crume Co.*, 125 Fed. 499 [reversed in open court without opinion in 129 Fed. 1004, 62 C. C. A. 679]; *Cushman Paper-Box Mach. Co. v. Goddard*, 95 Fed. 664, 37 C. C. A. 221.

34. *American Salesbook Co. v. Carter-Crume Co.*, 125 Fed. 499 [reversed in open court without opinion in 129 Fed. 1004, 62 C. C. A. 679]; *Bottle Seal Co. v. De la Vergne Bottle, etc., Co.*, 47 Fed. 59.

35. *Blake v. Stafford*, 3 Fed. Cas. No. 1,504, 6 Blatchf. 195, 3 Fish. Pat. Cas. 294.

36. *New York Belting, etc., Co. v. New Jersey Car-Spring, etc., Co.*, 48 Fed. 556 [reversed on other grounds in 53 Fed. 810, 4 C. C. A. 21]; *Allis v. Buckstaff*, 13 Fed. 879; *Roberts v. Buck*, 20 Fed. Cas. No. 11,897, 6 Fish. Pat. Cas. 325, *Holmes* 224, 3 Off. Gaz. 268.

The court cannot take notice of any proof concerning which there is not a corresponding allegation. *Serls v. Bouton*, 12 Fed. 140, 20 Blatchf. 426; *Marks v. Fox*, 6 Fed. 727, 18 Blatchf. 502; *Howe v. Williams*, 12 Fed. Cas. No. 6,778, 2 Cliff. 245, 2 Fish. Pat. Cas. 395.



infringements of patents the defendant may, under the general issue, show the prior state of the art,<sup>37</sup> or that the patentee is not the original inventor,<sup>38</sup> or give in evidence the act of congress relating to his rights.<sup>39</sup> So too defendant may give evidence of the use of a machine by other persons in other places than those mentioned in a notice of special matter, where the general issue is pleaded.<sup>40</sup> An averment in a declaration in an action for infringement that disclaimers were duly and legally executed in writing and accepted by the commissioner is sufficient to enable plaintiff to give evidence of their execution as required by statute.<sup>41</sup>

**16. TRIALS IN ACTIONS AT LAW — a. In General.** The ordinary rules of practice and procedure in civil actions apply.<sup>42</sup>

**b. Questions For Court and Jury.** It is for the court to instruct the jury as to the law,<sup>43</sup> and this includes a definition of the scope and meaning of the patent,<sup>44</sup> and it is for the jury to find the facts and apply the law as expounded.<sup>45</sup>

**Slightest variance fatal.**—When a declaration in an action for the infringement of a patent right professes to set forth the specification in the patent as part of the grant, the slightest variance is fatal. *Tryon v. White*, 24 Fed. Cas. No. 14,208, Pet. C. C. 96, 1 Robb Pat. Cas. 64.

**37.** *Brown v. Piper*, 91 U. S. 37, 23 L. ed. 200.

**38.** *Evans v. Eaton*, 8 Fed. Cas. No. 4,559, Pet. C. C. 322, 1 Robb Pat. Cas. 68, holding further that, where the general issue is pleaded, there is no limitation of the period in which defendant may show that the patentee is not the original inventor.

**39.** *Kneass v. Schuylkill Bank*, 14 Fed. Cas. No. 7,875, 1 Robb Pat. Cas. 303, 4 Wash. 9.

**40.** *Evans v. Eaton*, 8 Fed. Cas. No. 4,559, Pet. C. C. 322, 1 Robb Pat. Cas. 68.

**41.** *Van Hook v. Wood*, 28 Fed. Cas. No. 16,854.

**42.** Exception as to defense under U. S. Rev. St. (1878) § 4920; *McClurg v. Kingsland*, 1 How. (U. S.) 202, 11 L. ed. 102.

**Setting aside verdict** see *Aiken v. Bemis*, 1 Fed. Cas. No. 109, 2 Robb Pat. Cas. 644, 3 Woodb. & M. 348; *Blanchard's Gun-Stock Turning Factory v. Jacobs*, 3 Fed. Cas. No. 1,520, 2 Blatchf. 69, Fish. Pat. Rep. 158.

**Motion to withdraw jury for surprise** see *Foote v. Silsby*, 9 Fed. Cas. No. 4,916, 1 Blatchf. 445, Fish. Pat. Rep. 268.

**Feigned issue awarded** see *Foote v. Silsby*, 9 Fed. Cas. No. 4,918, 1 Blatchf. 545, Fish. Pat. Rep. 357.

**Objections and exceptions.**—Objection to evidence must be seasonably made (*Pettibone v. Pennsylvania Steel Co.*, 134 Fed. 889; *Brown v. Hall*, 4 Fed. Cas. No. 2,008, 6 Blatchf. 401, 3 Fish. Pat. Cas. 531; *Lock v. Pennsylvania R. Co.*, 15 Fed. Cas. No. 8,438), and must be definite (*Barker v. Stowe*, 2 Fed. Cas. No. 994, 3 Ban. & A. 337, 15 Blatchf. 49, 14 Off. Gaz. 559). Exceptions must also be taken seasonably. *Foote v. Silsby*, 9 Fed. Cas. No. 4,916, 1 Blatchf. 445, Fish. Pat. Rep. 268 [affirmed in 14 How. 218, 14 L. ed. 394].

**Records and exhibits.**—The court may order the production of records and exhibits (*Diamond Match Co. v. Oshkosh Match Works*, 63 Fed. 984; *Johnson Steel Street-*

*Rail Co. v. North Branch Steel Co.*, 48 Fed. 191; *Wisner v. Dodds*, 14 Fed. 655), but it will not order the filing of an ink copy of exhibit (*Tubman v. Wason Mfg. Co.*, 44 Fed. 429).

**Experiments.**—The court will not order defendant to conduct his experiments in the presence of plaintiff's witnesses. *Simonds Rolling-Mach. Co. v. Hathorn Mfg. Co.*, 83 Fed. 490.

**Witness ordered to answer certain questions** see *Coop v. Dr. Savage Physical Development Inst.*, 48 Fed. 239, 47 Fed. 899; *Dela-mater v. Reinhardt*, 43 Fed. 76; *Turrell v. Spaeth*, 24 Fed. Cas. No. 14,267, 2 Ban. & A. 185, 8 Off. Gaz. 986.

**Infringement** is a question for the jury. *Clark v. Adie*, 2 App. Cas. 315, 46 L. J. Ch. 585, 36 L. T. Rep. N. S. 923; *Macnamara v. Hulse*, C. & M. 471, 41 E. C. L. 258; *De la Rue v. Dickinson*, 7 E. & B. 738, 3 Jur. N. S. 841, 5 Wkly. Rep. 754, 90 E. C. L. 738; *Seed v. Higgins*, 8 H. L. Cas. 550, 6 Jur. N. S. 1264, 30 L. J. Q. B. 314, 3 L. T. Rep. N. S. 101, 11 Eng. Reprint 544.

**43.** *Coupe v. Royer*, 155 U. S. 565, 15 S. Ct. 199, 39 L. ed. 263; *Graham v. Earl*, 82 Fed. 737; *Many v. Jagger*, 16 Fed. Cas. No. 9,055, 1 Blatchf. 372, Fish. Pat. Rep. 222; *Parker v. Stiles*, 18 Fed. Cas. No. 10,749, Fish. Pat. Rep. 319, 5 McLean 44; *Hill v. Evans*, 4 De G. F. & J. 288, 8 Jur. N. S. 525, 31 L. J. Ch. 457, 6 L. T. Rep. N. S. 90, 65 Eng. Ch. 223, 45 Eng. Reprint 1195.

**44.** *Coupe v. Royer*, 155 U. S. 565, 15 S. Ct. 199, 39 L. ed. 263; *Marsh v. Quick-Meal Stove Co.*, 51 Fed. 203; *National Car-Brake Shoe Co. v. Terre Haute Car, etc., Co.*, 19 Fed. 514; *Clark Patent Steam, etc., Regulator Co. v. Copeland*, 5 Fed. Cas. No. 2,866, 2 Fish. Pat. Cas. 221; *Bovill v. Plimm*, 11 Exch. 718; *Seed v. Higgins*, 8 H. L. Cas. 550, 6 Jur. N. S. 1264, 30 L. J. Q. B. 314, 3 L. T. Rep. N. S. 101, 11 Eng. Reprint 544.

**Until the evidence is in the court** may refuse to construe the patent. *Young v. Fermie*, 4 Giffard 577, 10 Jur. N. S. 926, 10 L. T. Rep. N. S. 861, 4 New Rep. 218, 12 Wkly. Rep. 901, 66 Eng. Reprint 836.

**45.** *Battin v. Taggart*, 17 How. (U. S.) 74, 15 L. ed. 37; *Foote v. Silsby*, 9 Fed. Cas. No. 4,916, 1 Blatchf. 445, Fish. Pat. Rep.



The jury must determine the question of identity of the alleged infringing device,<sup>46</sup> the question of the validity of the patent,<sup>47</sup> and the amount of damages.<sup>48</sup> In a clear case the court may direct the jury to bring in a verdict for defendant.<sup>49</sup>

**17. HEARING IN SUITS IN EQUITY—a. Questions Determined.** Where defendant denies the infringement and avers that the alleged infringing article was made under a later patent than that sued upon, the court may, in a plain case, determine the question of infringement by an inspection and comparison of the two patents.<sup>50</sup> The construction placed on the claims of a patent by the court on

268; *Goodyear v. Bishop*, 10 Fed. Cas. No. 5,559, 2 Fish. Pat. Cas. 154; *Parker v. Stiles*, 18 Fed. Cas. No. 10,749, Fish. Pat. Rep. 319, 5 McLean 44; *Poppenhusen v. Falke*, 19 Fed. Cas. No. 11,279, 4 Blatchf. 493, 2 Fish. Pat. Cas. 181.

**Expression of opinion.**—The court may express opinion upon a fact which is clear. *Bollmans v. Parry*, 3 Fed. Cas. No. 1,612.

**46.** *Coupe v. Royer*, 155 U. S. 565, 15 S. Ct. 199, 39 L. ed. 263; *Tucker v. Spalding*, 13 Wall. (U. S.) 453, 20 L. ed. 515; *Tyler v. Boston*, 7 Wall. (U. S.) 327, 19 L. ed. 93; *Singer Mfg. Co. v. Cramer*, 109 Fed. 652, 48 C. C. A. 588; *Graham v. Earl*, 82 Fed. 737; *May v. Fond du Lac County*, 27 Fed. 691; *Blanchard's Gun-Stock Turning Factory v. Warner*, 3 Fed. Cas. No. 1,521, 1 Blatchf. 258, Fish. Pat. Rep. 184; *Matthews v. Skates*, 16 Fed. Cas. No. 9,291, 1 Fish. Pat. Cas. 602; *Parker v. Stiles*, 17 Fed. Cas. No. 10,749, Fish. Pat. Rep. 319, 5 McLean 44; *Pennock v. Dialogue*, 19 Fed. Cas. No. 10,941, 1 Robb Pat. Cas. 466, 4 Wash. 538 [*affirmed* in 2 Pet. 1, 7 L. ed. 327]; *Smith v. Higgins*, 22 Fed. Cas. No. 13,058; *Tatham v. Le Roy*, 23 Fed. Cas. No. 13,761.

**On demurrer to evidence** court may instruct jury to find for defendant. *Royer v. Schultz Belting Co.*, 28 Fed. 850.

In a plain case the court may determine infringement by comparing article and patent. *Connors v. Ormsby*, 148 Fed. 13, 78 C. C. A. 181; *Hardwick v. Masland*, 71 Fed. 887; *Jennings v. Kibbe*, 10 Fed. 669, 20 Blatchf. 353.

**47.** *Battin v. Taggart*, 17 How. (U. S.) 74, 15 L. ed. 37; *Graham v. Earl*, 82 Fed. 737; *Carver v. Braintree Mfg. Co.*, 5 Fed. Cas. No. 2,485, 2 Robb Pat. Cas. 141, 2 Story 432; *Sullivan v. Redfield*, 23 Fed. Cas. No. 13,597, 1 Paine 441, 1 Robb Pat. Cas. 477; *Teese v. Phelps*, 23 Fed. Cas. No. 13,818, McAllister 17.

**Anticipation** is a question for the jury. *Keyes v. Grant*, 118 U. S. 25, 6 S. Ct. 974, 30 L. ed. 54; *Bischoff v. Wethered*, 9 Wall. (U. S.) 812, 19 L. ed. 829; *Turrill v. Michigan, etc., R. Co.*, 1 Wall. (U. S.) 491, 17 L. ed. 668; *Hunt Bros. Fruit Packing Co. v. Cassidy*, 53 Fed. 257, 3 C. C. A. 525; *Waterman v. Thomson*, 29 Fed. Cas. No. 17,260, 2 Fish. Pat. Cas. 461.

In England anticipation by prior patents is for the court. *Bush v. Fox*, 5 H. L. Cas. 707, 2 Jur. N. S. 1029, 25 L. J. Exch. 251, 4 Wkly. Rep. 675, 10 Eng. Reprint 1080; *Booth v. Kennard*, 2 H. & N. 84, 26 L. J. Exch. 305,

5 Wkly. Rep. 607; *Thomas v. Foxwell*, 5 Jur. N. S. 37 [*affirmed* in 6 Jur. N. S. 271]. Invention is a question for the jury. *Willis v. Miller*, 121 Fed. 985, 58 C. C. A. 286; *San Francisco Bridge Co. v. Keating*, 68 Fed. 351, 15 C. C. A. 476.

**Sufficiency of description** is a question for the jury. *Wood v. Underhill*, 5 How. (U. S.) 1, 12 L. ed. 23; *Reutgen v. Kanowrs*, 20 Fed. Cas. No. 11,710, 1 Robb Pat. Cas. 1, 1 Wash. 168.

**Abandonment** is a question for the jury. *Godfrey v. Eames*, 1 Wall. (U. S.) 317, 17 L. ed. 684; *Kendall v. Winsor*, 21 How. (U. S.) 322, 16 L. ed. 165.

**Fraud** is a question for the jury. *Hogg v. Emerson*, 11 How. (U. S.) 587, 13 L. ed. 824; *Reutgen v. Kanowrs*, 20 Fed. Cas. No. 11,710, 1 Robb Pat. Cas. 1, 1 Wash. 168.

**Reading to the jury** the decision of another court as to validity is improper. *Arely v. De Loriea*, 55 Fed. 323, 5 C. C. A. 116.

**Where anticipated in patents** the court may so instruct the jury. *Market St. Cable R. Co. v. Rowley*, 155 U. S. 621, 15 S. Ct. 224, 39 L. ed. 284.

If a patent is void on its face, the court may so instruct. *Roberts v. Bennett*, 135 Fed. 193, 69 C. C. A. 533; *Langdon v. De Groot*, 14 Fed. Cas. No. 8,059, 1 Paine 203, 1 Robb Pat. Cas. 433.

**Sufficiency of description** is a question for the jury. *Bickford v. Skewes*, 1 Q. B. 938, 1 G. & D. 736, 6 Jur. 167, 41 E. C. L. 848; *Betts v. Menzies*, 10 H. L. Cas. 117, 9 Jur. N. S. 29, 31 L. J. Q. B. 233, 7 L. T. Rep. N. S. 110, 11 Wkly. Rep. 1, 11 Eng. Reprint 970.

**48.** *National Car-Brake Shoe Co. v. Terre Haute Car, etc., Co.*, 19 Fed. 514; *Alden v. Dewey*, 1 Fed. Cas. No. 153, 2 Robb Pat. Cas. 17, 1 Story 336; *Allen v. Blunt*, 1 Fed. Cas. No. 217, 2 Robb Pat. Cas. 530, 2 Woodb. & M. 121; *Goodyear v. Bishop*, 10 Fed. Cas. No. 5,559, 2 Fish. Pat. Cas. 154; *Grant v. —*, 10 Fed. Cas. No. 5,701; *Johnson v. Root*, 13 Fed. Cas. No. 7,409, 2 Cliff. 108, 2 Fish. Pat. Cas. 291; *Stephens v. Felt*, 22 Fed. Cas. No. 13,368, 2 Blatchf. 37, Fish. Pat. Rep. 144.

**49.** *Keyes v. Grant*, 118 U. S. 25, 6 S. Ct. 974, 30 L. ed. 54.

**50.** *Hardwick v. Masland*, 71 Fed. 887.

Unless the character of the invention has so little complexity that expert evidence is not necessary to aid the court in understanding whether one patent, or several patents considered together, describe the devices or combination of devices which are the subject-



granting a preliminary injunction should be followed at the final hearing, where there has been no substantial change in the cause so far as it relates to the question of construction.<sup>51</sup> The court will not determine a moot question at the final hearing, as where no infringement is found the court will not pass upon the question of the novelty of a patented invention.<sup>52</sup> Where the patent is recent, the specification obscure, and the proof of infringement meager and unsatisfactory, the court will not grant an injunction, even upon a final hearing, but will retain the bill for a certain period and require complainant to bring an action at law, in which case the bill will stand dismissed, unless the action at law is brought within the time limited.<sup>53</sup>

**b. Submission of Issues to Jury.** The circuit court may impanel a jury of not less than five and not more than twelve persons and submit to them such questions of fact arising in the cause as the court shall deem expedient.<sup>54</sup>

**c. Reception of Evidence.** Documentary evidence set forth in defendant's answer will not be received after the cause has been submitted upon plaintiff's evidence;<sup>55</sup> but it has been held that, where it is an important point in the defense that a reissued patent is broader in its scope than the original, the case will be reopened to enable defendant to introduce testimony tending to show that fact, it being alleged that such testimony is newly discovered.<sup>56</sup> The court will not, on complainant's motion, compel defendant to file an exhibit in a form different from that already filed by him.<sup>57</sup> Complainant is entitled as a matter of right to introduce evidence in rebuttal,<sup>58</sup> but not after the argument has com-

matter of the subsequent patent, the court will examine a large number of patents prior in date to that of complainant, which patents have been offered in evidence to sustain the defense of want of novelty. *Waterman v. Shipman*, 55 Fed. 982, 5 C. C. A. 371.

In a suit upon design patents, the absence of evidence of identity does not make it improper for the court to compare such patent and the alleged infringing articles offered in evidence, the designs being of a simple character. *Jennings v. Kibbe*, 10 Fed. 669, 29 Blatchf. 353.

51. *Sessions v. Gould*, 60 Fed. 753 [affirmed in 63 Fed. 1001, 11 C. C. A. 546, 550].

52. *Saxe v. Hammond*, 21 Fed. Cas. No. 12,411, 1 Ban. & A. 629, *Holmes* 456, 7 Off. Gaz. 781.

53. *Muscan Hair Mfg. Co. v. American Hair Mfg. Co.*, 17 Fed. Cas. No. 9,970, 4 Blatchf. 174, 1 Fish. Pat. Cas. 320.

54. Act Feb. 16, 1875, 18 U. S. St. at L. 316 [U. S. Comp. St. (1901) p. 526]; *Watt v. Starke*, 101 U. S. 247, 25 L. Ed. 826. In case of doubt the court may in its discretion award an issue to be tried by jury. *Gray v. Halkyard*, 28 Fed. 854; *Allen v. Sprague*, 1 Fed. Cas. No. 238, 1 Blatchf. 567, Fish. Pat. Rep. 388; *Brooks v. Bicknell*, 4 Fed. Cas. No. 1,944, 3 McLean 250, 2 Robb Pat. Cas. 118; *Parker v. Hatfield*, 18 Fed. Cas. No. 10,736, Fish. Pat. Rep. 94, 4 McLean 61; *Sicles v. Pacific Mail Steamship Co.*, 22 Fed. Cas. No. 12,842; *Van Hook v. Pendleton*, 28 Fed. Cas. No. 16,851, 1 Blatchf. 187, Fish. Pat. Rep. 120.

That an issue to be tried by jury not granted at the mere request of a party see *Brooks v. Norcross*, 4 Fed. Cas. No. 1,957, 2 Fish. Pat. Cas. 661; *Goodyear v. Day*, 10 Fed. Cas. No. 5,566.

Issue for jury refused see *Buchanan v. Howland*, 4 Fed. Cas. No. 2,074, 5 Blatchf.

151, 2 Fish. Pat. Cas. 341; *Ely v. Monson*, etc., Mfg. Co., 8 Fed. Cas. No. 4,431, 4 Fish. Pat. Cas. 64.

Court may order trial at law see *Booth v. Garely*, 3 Fed. Cas. No. 1,646, 1 Blatchf. 247, Fish. Pat. Rep. 154; *Brooks v. Bicknell*, 4 Fed. Cas. No. 1,944, 3 McLean 250, 2 Robb Pat. Cas. 118; *Bryan v. Stevens*, 4 Fed. Cas. No. 2,066a.

**English practice.**—Court may in its discretion direct issue of fact to be tried by jury. *Bovill v. Hitchcock*, L. R. 3 Ch. 417, 37 L. J. Ch. 223, 16 Wkly. Rep. 321; *Davenport v. Goldberg*, 2 Hem. & M. 282, 5 New Rep. 484, 71 Eng. Reprint 472. In the absence of special circumstances the issues will be tried before the court and not before a jury. *Patent Mar. Invention Co. v. Chadburn*, L. R. 16 Eq. 447, 26 L. T. Rep. N. S. 614, 21 Wkly. Rep. 745.

55. *Peterson v. Simpkins*, 25 Fed. 486.

56. *Johnson v. Beard*, 13 Fed. Cas. No. 7,371, 2 Ban. & A. 50, 8 Off. Gaz. 435.

57. *Tubman v. Wason Mfg. Co.*, 44 Fed. 429, where the complainant moved that the court order defendant to file an ink drawing of an exhibit which was already on file in pencil, and the court held that such an order would be improper, counsel for defendant having a right, at defendant's risk, to offer an exhibit in one form or another.

58. *Cahoon v. Ring*, 4 Fed. Cas. No. 2,292, 1 Cliff. 592, 1 Fish. Pat. Cas. 397, holding, however, that the fresh evidence which may be introduced is limited strictly to rebutting evidence, and hence evidence of any experiments upon the machine in question cannot be introduced by plaintiff in his rebutting testimony.

On the ground of surprise leave may be granted to complainant to introduce evidence in rebuttal. *Pouopard v. Fardell*, 18



menced.<sup>59</sup> Under a general denial of the patentee's priority of invention, evidence of prior knowledge and use, taken without objection, is competent at the final hearing, not only as demonstrative of the state of the art, so as to limit the construction of the patent,<sup>60</sup> but also on the question of the validity of the patent.<sup>61</sup> So too where an objection was not distinctly made when the evidence was taken such evidence is deemed waived and is competent at the final hearing.<sup>62</sup>

**d. Dismissal** — (I) *AT WHAT STAGE OF CAUSE ALLOWABLE*. The court may, in its discretion, permit defendant at the close of complainant's proofs to present by a motion to dismiss a jurisdictional question,<sup>63</sup> or a question of the legal sufficiency of the proof of title to the patent,<sup>64</sup> without requiring defendant to abide by the case as then made in the event that his motion shall be overruled.

(II) *GROUND*S. The bill will be dismissed,<sup>65</sup> without regard to the answer,<sup>66</sup> where it appears that letters patent are void on their face because the process or device described therein is not patentable. That defendant has, by his action in selling his alleged patent, necessarily abandoned his intention to infringe is no sufficient ground, after the testimony has been taken, for dismissing the bill and remanding plaintiff to his remedy at law.<sup>67</sup> If a suit commenced to restrain from infringing letters patent and to recover profits and damages be begun so late that under the rules of the court no injunction can be obtained before the expiration of the patent, the bill should be dismissed for want of jurisdiction.<sup>68</sup>

(III) *DISMISSAL WITHOUT PREJUDICE*. Where the alleged infringement has been disproved, an application for dismissal without prejudice, as to one of the defendants, will be denied.<sup>69</sup>

(IV) *OPERATION AND EFFECT*. Dismissal of the bill for failure to show an infringement does not estop plaintiff or his assigns from again suing the same defendant for infringing the same patent.<sup>70</sup>

**18. INTERLOCUTORY DECREE AND ACCOUNTING** — **a. Interlocutory Decree**. Where the finding is in favor of the validity and infringement of the patent, an interlocutory decree for the complainant is entered and the cause is referred to a master to ascertain the amount to be recovered.<sup>71</sup>

Wkly. Rep. 59. See also *Penn v. Jack*, L. R. 2 Eq. 314, 14 L. T. Rep. N. S. 495, 14 Wkly. Rep. 760.

59. *Stainthorp v. Humiston*, 22 Fed. Cas. No. 13,281, 4 Fish. Pat. Cas. 107, holding, however, that where defendant relies on defenses other than the alienage of complainant, the latter may introduce evidence to rebut proof that he was not an alien, upon payment of all costs incurred by defendant in proving the alienage of complainant.

60. *Zane v. Soffe*, 110 U. S. 200, 3 S. Ct. 562, 28 L. ed. 119.

61. *Zane v. Soffe*, 110 U. S. 200, 3 S. Ct. 562, 28 L. ed. 119; *Webster Loom Co. v. Higgins*, 105 U. S. 580, 26 L. ed. 1177.

62. *Barker v. Stowe*, 2 Fed. Cas. No. 994, 3 Ban. & A. 337, 15 Blatchf. 49, 14 Off. Gaz. 559.

63. *Streat v. American Rubber Co.*, 115 Fed. 634.

64. *De Laval Separator Co. v. Vermont Farm-Mach. Co.*, 109 Fed. 813.

65. *Slawson v. Grand St.*, etc., R. Co., 107 U. S. 649, 2 S. Ct. 663, 27 L. ed. 576; *Brown v. Piper*, 91 U. S. 37, 23 L. ed. 200; *Quirolo v. Ardito*, 1 Fed. 610, 17 Blatchf. 400; *Passaic Zinc Co. v. Spear*, 18 Fed. Cas. No. 10,789. See also *Terhune v. Phillips*, 99 U. S. 592, 25 L. ed. 293; *Dunbar v. Meyers*, 94 U. S. 187, 24 L. ed. 34; *Wills v. Scranton Cold*

*Storage, etc., Co.*, 153 Fed. 181, 82 C. C. A. 355 [affirming 147 Fed. 525].

66. *Slawson v. Grand St.*, etc., R. Co., 107 U. S. 649, 2 S. Ct. 663, 27 L. ed. 576; *Brown v. Piper*, 91 U. S. 37, 23 L. ed. 200; *Conderman v. Clements*, 147 Fed. 915, 78 C. C. A. 51; *Quirolo v. Ardito*, 1 Fed. 610, 17 Blatchf. 400.

67. *Winchester Repeating Arms Co. v. American Buckle, etc., Co.*, 54 Fed. 703.

68. *Clark v. Wooster*, 119 U. S. 322, 7 S. Ct. 217, 30 L. ed. 392, holding, however, that where the suit is begun in such time that an injunction can be obtained before the expiration of the patent, although only three days remain for it to run, it is within the discretion of the court to take jurisdiction; and if it does, it may, without enjoining defendant, proceed to grant the other incidental relief asked for.

69. *Archer v. Arnd*, 31 Fed. 475 [affirmed in 140 U. S. 668, 11 S. Ct. 1015, 35 L. ed. 599].

70. *Steam-Gauge, etc., Co. v. Meyrose*, 27 Fed. 213.

71. *Timolat v. Philadelphia Pneumatic Tool Co.*, 130 Fed. 903; *Campbell Printing-Press, etc., Co. v. Manhattan R. Co.*, 49 Fed. 930; *Whitney v. Boston, etc., R. Co.*, 48 Fed. 444; *Andrews v. Creegan*, 7 Fed. 477, 19 Blatchf. 113; *Allen v. Blunt*, 1 Fed. Cas. No.



**b. Proceedings in Accounting.** The authority of the master and the proceedings before him are controlled by the ordinary rules of equity practice.<sup>72</sup> On

215, 1 Blatchf. 480, Fish. Pat. Rep. 303, 8 N. Y. Leg. Obs. 105; Bullock Printing-Press Co. v. Jones, 4 Fed. Cas. No. 2,132, 3 Ban. & A. 195, 13 Off. Gaz. 124; Carew v. Boston Elastic Fabric Co., 5 Fed. Cas. No. 2,397, 3 Cliff. 356, 5 Fish. Pat. Cas. 90, 1 Off. Gaz. 91.

For form of interlocutory decree see Providence Rubber Co. v. Goodyear, 9 Wall. (U. S.) 788, 19 L. ed. 566.

Decree held too broad see Littlefield v. Perry, 21 Wall. (U. S.) 205, 22 L. ed. 577; Creamer v. Bowers, 30 Fed. 185.

Time after complainant has sold his patent cannot be included in accounting. Goss Printing Press Co. v. Scott, 134 Fed. 880. Defendant is the only party accounting within the meaning of equity rule 79. Goss Printing Press Co. v. Scott, 148 Fed. 393.

Construction of particular decree see New York Grape Sugar Co. v. American Grape Sugar Co., 42 Fed. 455.

Where the decree is reversed the testimony may be used in a subsequent accounting. Campbell v. New York, 35 Fed. 504, 1 L. R. A. 48.

Further report.—The case may be referred back to master for further report. Ruggles v. Eddy, 20 Fed. Cas. No. 12,116, 2 Ban. & A. 627, 12 Off. Gaz. 716; Whitney v. Mowry, 29 Fed. Cas. No. 17,593, 4 Fish. Pat. Cas. 141. On exceptions to the master's report, a former decision in the case as to the rule of damages must be followed. Webster Loom Co. v. Higgins, 39 Fed. 462.

Compliance with interlocutory order to keep an account see Wilder v. Gayler, 29 Fed. Cas. No. 17,648, 1 Blatchf. 511, Fish. Pat. Rep. 317.

Where damages are trivial, the case will not be referred to a master. Bradford v. Belknap Motor Co., 105 Fed. 63.

Where no infringement is shown, the suit will be dismissed. American Wood-Paper Co. v. Heft, 1 Fed. Cas. No. 322, 3 Fish. Pat. Cas. 316; Saxe v. Hammond, 21 Fed. Cas. No. 12,411, 1 Ban. & A. 629, Holmes 456, 7 Off. Gaz. 781.

A request for dismissal without prejudice will be refused where infringement is disproved. Archer v. Arnd, 31 Fed. 475 [affirmed in 140 U. S. 668, 11 S. Ct. 1015, 35 L. ed. 599]. Moot questions will not be decided. Sprague Electric R., etc., Co. v. Steel Motor Co., 105 Fed. 959.

After interlocutory decree court will not advise parties whether different article infringes. Thomas, etc., Co. v. Electric Porcelain Co., 114 Fed. 407.

English practice.—An account will be refused where it is clear that there were no profits. Bergmann v. Macmillan, 17 Ch. D. 423, 44 L. T. Rep. N. S. 794, 29 Wkly. Rep. 890. An account where complicated may be by inquiry in chambers. Betts v. De Vitre, 11 L. T. Rep. N. S. 533, 5 New Rep. 165. Defendant may be ordered to permit inspection

of factory and machines. Garrard v. Edge, 58 L. J. Ch. 397, 60 L. T. Rep. N. S. 557, 37 Wkly. Rep. 501; Germ Milling Co. v. Robinson, 55 L. J. Ch. 287, 53 L. T. Rep. N. S. 696, 34 Wkly. Rep. 194; Jones v. Lee, 25 L. J. Exch. 241; Singer Mfg. Co. v. Wilson, 12 L. T. Rep. N. S. 140, 5 New Rep. 505, 13 Wkly. Rep. 560. Form of order for inspection. Davenport v. Jepson, 1 New Rep. 307.

**72. Mode of procedure.**—The master appoints a day for proceeding with the reference, and gives notice, by mail or otherwise, to the parties or their solicitors. The solicitor should be notified, whether the party is or not; although, probably, under rule 75, notice to the party is a good notice. If defendant does not appear, the master proceeds *ex parte* and makes out the profits and damages, if he can, from the evidence produced by plaintiff. If it appears that an account of profits is necessary to a just decision of the cause, and is desired by plaintiff, he makes an order that defendant furnish an account by a certain day, and adjourns the hearing to that day. Defendant should be served personally with a notice of this adjournment, and of the order to produce his account, if it is intended to move for an attachment in case he fails to appear. The service may be made by any disinterested person, and need not be by the marshal. If defendant then fails to appear and account, he will be in contempt. Kerosene Lamp-Heater Co. v. Fisher, 1 Fed. 91.

**Damages and profits.**—The master determines damages and profits. Reedy v. Western Electric Co., 83 Fed. 709, 28 C. C. A. 27 [affirming 66 Fed. 163]; Rumford Chemical Works v. Hecker, 20 Fed. Cas. No. 12,134, 2 Ban. & A. 386, 11 Off. Gaz. 330; Turrill v. Illinois Cent. R. Co., 24 Fed. Cas. No. 14,272, 5 Biss. 344 [reversed in part in 94 U. S. 695, 24 L. ed. 238].

The master should take an account to the time of his report and if defendant has changed his machine should determine if the new machine is substantially like the old one. Hoe v. Scott, 87 Fed. 220; Knox v. Great Western Quicksilver Min. Co., 14 Fed. Cas. No. 7,907, 4 Ban. & A. 25, 7 Reporter 325, 6 Sawy. 430, 14 Off. Gaz. 897; Tatham v. Lowber, 23 Fed. Cas. No. 13,765, 4 Blatchf. 86 [reversed on other grounds in 22 How. 132, 16 L. ed. 366].

The liability of each defendant should be determined. Herring v. Gage, 12 Fed. Cas. No. 6,422, 3 Ban. & A. 396, 15 Blatchf. 124; Tatham v. Lowber, 23 Fed. Cas. No. 13,765, 4 Blatchf. 86.

Determination of cost of manufacture see Mast v. Superior Drill Co., 154 Fed. 45, 83 C. C. A. 157.

The questions of validity and infringement are not open before the master. Skinner v. Vulcan Iron-Works, 39 Fed. 870; Celluloid Mfg. Co. v. Comstock, etc., Co., 27 Fed.



an account before a master for damages for infringement of a patent, evidence of license contracts made between complainant and other responsible parties, by which they were to pay a royalty for the use of the patented device, is admissible.<sup>73</sup> He is bound by the terms of the interlocutory decree.<sup>74</sup>

**19. Costs<sup>75</sup>—a. In Actions at Law.** The ordinary rule as to costs prevails,<sup>76</sup> except as affected by delay in filing a disclaimer.<sup>77</sup>

358; *Turrill v. Illinois Cent. R. Co.*, 24 Fed. Cas. No. 14,272, 5 Biss. 344; *Whitney v. Mowry*, 29 Fed. Cas. No. 17,594, 4 Fish. Pat. Cas. 207. *Compare* *Walker Patent Pivoted Bin Co. v. Miller*, 146 Fed. 249.

**Proof of damages.**—Master not called upon to suggest how profits and damages may be proved. *Garretson v. Clark*, 10 Fed. Cas. No. 5,250, 4 Ban. & A. 536, 16 Off. Gaz. 806.

**Report of oral evidence.**—Master not required to report oral evidence unless requested at the time. *Hammacher v. Wilson*, 32 Fed. 796.

**Where evidence is introduced both as to damages and profits, it is proper for the master to report his findings and conclusions upon each line of evidence separately.** *Mast v. Superior Drill Co.*, 154 Fed. 45, 83 C. C. A. 157.

**Where the master by his rulings limits the scope of the inquiry, the matter may properly be presented to the court for decision by a motion for instructions to the master.** *Walker Patent Pivoted Bin Co. v. Miller*, 146 Fed. 249.

**Burden of proof.**—The burden is on the complainant to show affirmatively the amount of profits. *Mosher v. Joyce*, 51 Fed. 441, 2 C. C. A. 322 [affirming 45 Fed. 205]; *Hammacher v. Wilson*, 32 Fed. 796; *Black v. Munson*, 3 Fed. Cas. No. 1,463, 2 Ban. & A. 623, 14 Blatchf. 265 [affirmed in 111 U. S. 122, 4 S. Ct. 326, 28 L. ed. 372]; *Webster v. New Brunswick Carpet Co.*, 29 Fed. Cas. No. 17,338, 2 Ban. & A. 67, 9 Off. Gaz. 203. Circumstances may place the burden on defendant of showing what part of profits not due to patented part. *Cimiotti Unhairing Co. v. Bowsky*, 113 Fed. 698; *American Nicholson Pavement Co. v. Elizabeth*, 1 Fed. Cas. No. 309, 1 Ban. & A. 439, 6 Off. Gaz. 764 [modified in 97 U. S. 126, 24 L. ed. 1000].

**Admissibility of evidence.**—Evidence that other devices were capable of use is incompetent. *American Nicholson Pavement Co. v. Elizabeth*, 1 Fed. Cas. No. 309, 1 Ban. & A. 439, 6 Off. Gaz. 764 [modified in 97 U. S. 126, 24 L. ed. 1000]. Evidence as to cost of manufacture is admissible. *Mast v. Superior Drill Co.*, 154 Fed. 45, 83 C. C. A. 157.

**73.** *Mast v. Superior Drill Co.*, 154 Fed. 45, 83 C. C. A. 157. Evidence as to the comparative profits of the patented and similar devices may be competent. *Webster Loom Co. v. Higgins*, 39 Fed. 462; *Black v. Thorne*, 3 Fed. Cas. No. 1,466, 1 Ban. & A. 155, 12 Blatchf. 20, 7 Off. Gaz. 176; *Garretson v. Clark*, 10 Fed. Cas. No. 5,250, 4 Ban. & A. 536, 16 Off. Gaz. 806.

**Weight of evidence.**—Rulings of master as to the weight of evidence not disturbed where reasonable. *Welling v. La Bau*, 35

Fed. 301; *Creamer v. Bowers*, 35 Fed. 206; *Welling v. La Bau*, 34 Fed. 40; *Hammacher v. Wilson*, 32 Fed. 796; *Wooster v. Thorn, ton*, 26 Fed. 274 [affirmed in 136 U. S. 651, 10 S. Ct. 1074, 34 L. ed. 550]; *Piper v. Brown*, 19 Fed. Cas. No. 11,181, 6 Fish. Pat. Cas. 240, *Holmes* 196, 3 Off. Gaz. 97.

**Setting up alleged new infringements by supplemental bill** see *Murray v. Orr*, etc., *Hardware Co.*, 153 Fed. 369, 82 C. C. A. 445.

**Setting aside.**—The master's report may be set aside for manifest error of law or fact. *Greenleaf v. Yale Lock Mfg. Co.*, 10 Fed. Cas. No. 5,783, 4 Ban. & A. 583, 17 Blatchf. 253, 17 Off. Gaz. 625; *Steam Stonecutter Co. v. Windsor Mfg. Co.*, 22 Fed. Cas. No. 13,335, 4 Ban. & A. 445, 17 Blatchf. 24.

**Recommitting case.**—The case may be re-committed for specific findings. *Webster Loom Co. v. Higgins*, 43 Fed. 673. It will not be recommitted for immaterial error. *Zane v. Peck*, 13 Fed. 475.

**Exceptions.**—Exceptions overruled where error is not pointed out. *Turrill v. Illinois Cent. R. Co.*, 24 Fed. Cas. No. 14,272, 5 Biss. 344 [reversed in part in 94 U. S. 695, 24 L. ed. 238]. Exceptions overruled and order for recount refused. *Timken v. Olin*, 41 Fed. 169; *Morris v. Union Form Co.*, 39 Fed. 468; *Garretson v. Clark*, 10 Fed. Cas. No. 5,248, 3 Ban. & A. 352, 15 Blatchf. 70, 14 Off. Gaz. 485 [affirmed in 111 U. S. 120, 4 S. Ct. 291, 28 L. ed. 371].

**English practice.**—In accounting before master the court may make an order for discovery and the production of defendant's books. *Saccharin Corp. v. Chemicals, etc., Co.*, [1900] 2 Ch. 556, 69 L. J. Ch. 820, 83 L. T. Rep. N. S. 206, 49 Wkly. Rep. 1; *Saxby v. Easterbrook*, L. R. 7 Exch. 207, 41 L. J. Exch. 113, 26 L. T. Rep. N. S. 439, 20 Wkly. Rep. 751. Question of validity is not in issue. *Clark v. Adie*, 3 Ch. D. 134, 45 L. J. Ch. 228, 35 L. T. Rep. N. S. 349, 24 Wkly. Rep. 1107 [affirmed in 2 App. Cas. 423, 46 L. J. Ch. 598, 37 L. T. Rep. N. S. 1, 25 Wkly. Rep. 45].

**74.** *Hoe v. Scott*, 87 Fed. 220; *Skinner v. Vulcan Iron Works*, 39 Fed. 870; *Turrill v. Illinois Cent. R. Co.*, 24 Fed. Cas. No. 14,272, 5 Biss. 344; *Whitney v. Mowry*, 29 Fed. Cas. No. 17,594, 4 Fish. Pat. Cas. 207; *Williams v. Leonard*, 29 Fed. Cas. No. 17,726, 9 Blatchf. 476, 5 Fish. Pat. Cas. 381.

**75.** See, generally, **COSTS**.

**76.** *Corser v. Brattleboro Overall Co.*, 93 Fed. 809; *Kneass v. Schuyllkill Bank*, 14 Fed. Cas. No. 7,876, Fish. Pat. Rep. 1, 4 Wash. 106; *Merchant v. Lewis*, 17 Fed. Cas. No. 9,437, 1 Bond 172. See *infra*, XIII, C, 19, b.

**77.** *Sessions v. Romadka*, 145 U. S. 29, 12 S. Ct. 799, 36 L. ed. 609; *Dunbar v. Meyers*,



**b. In Suits in Equity.** In infringement suits costs are awarded to the successful party unless there are special circumstances which render this unjust.<sup>78</sup> Where some of the claims sued on are void, costs for the complainant are usually refused, although the decree is in his favor upon other claims.<sup>79</sup> Costs may be divided in

94 U. S. 187, 24 L. ed. 34; *Smith v. Nichols*, 21 Wall. (U. S.) 112, 22 L. ed. 566; *Peek v. Frame*, 19 Fed. Cas. No. 10,904, 5 Fish. Pat. Cas. 211.

Copies of patents are not part of costs. *Ryan v. Gould*, 32 Fed. 754; *Wooster v. Handy*, 23 Fed. 49, 23 Blatchf. 112; *Woodruff v. Barney*, 30 Fed. Cas. No. 17,983, 1 Bond 528, 2 Fish. Pat. Cas. 244.

78. See, generally, COSTS, 11 Cyc. 1.

Costs to successful party refused under special circumstances.—*Green v. Lynn*, 81 Fed. 387; *Lowell Mfg. Co. v. Whittall*, 71 Fed. 515; *Consolidated Brake-Shoe Co. v. Chicago, etc., R. Co.*, 69 Fed. 412; *Marks Adjustable Folding Chair Co. v. Wilson*, 43 Fed. 302; *Hayes v. Bickelhaupt*, 23 Fed. 183; *Tyler v. Galloway*, 13 Fed. 477, 21 Blatchf. 66; *American Wood-Paper Co. v. Heft*, 1 Fed. Cas. No. 322, 3 Fish. Pat. Cas. 316; *Hussey v. Bradley*, 12 Fed. Cas. No. 6,946, 5 Blatchf. 134, 2 Fish. Pat. Cas. 362; *Prime v. Brandon Mfg. Co.*, 19 Fed. Cas. No. 11,421, 4 Ban. & A. 379, 16 Blatchf. 453; *Smith v. Woodruff*, 22 Fed. Cas. No. 13,128a, 6 Fish. Pat. Cas. 476.

Recovery of nominal damages.—Where nominal damages only are found, cost of reference to master taxed against complainant. *Kansas City Hay Press Co. v. Devol*, 127 Fed. 363; *Hill v. Smith*, 32 Fed. 753; *Everest v. Buffalo Lubricating Oil Co.*, 31 Fed. 742; *Kirby v. Armstrong*, 5 Fed. 801, 10 Biss. 135. *Compare Calkins v. Bertrand*, 8 Fed. 755, 10 Biss. 445, holding that where nominal damages only are allowed the taxation of costs depends on circumstances.

Unnecessary costs.—No costs unnecessarily accumulated will be allowed. *Brunswick-Balke-Collender Co. v. Klump*, 131 Fed. 93; *Ford v. Kurtz*, 12 Fed. 789, 11 Biss. 324.

Where the decree drawn by the successful party is not in accordance with the judgment, no costs can be allowed him on appeal. *Hatch Storage Battery Co. v. Electric Storage Battery Co.*, 100 Fed. 975, 41 C. C. A. 133; *Shute v. Morley Sewing Mach. Co.*, 64 Fed. 368, 12 C. C. A. 356.

Expense of accounting.—Defendant must bear the expense of accounting in the first instance. *Urner v. Kayton*, 17 Fed. 539, 21 Blatchf. 428.

Compensation of master.—In Massachusetts plaintiff must pay master's compensation in the first instance to be recovered as costs. *Macdonald v. Shepard*, 10 Fed. 919.

Prior to entry of decree taxing costs, each party pays his own costs. *U. S. Printing Co. v. American Playing-Card Co.*, 81 Fed. 506.

Where an execution for costs is returned unsatisfied, a receiver will not be appointed to take possession of the patent. *Thayer v. Hart*, 24 Fed. 558, 23 Blatchf. 303.

English practice.—No costs are allowed un-

less the judge certifies that particulars are proved. *Wilcox v. Janes*, [1897] 2 Ch. 71, 66 L. J. Ch. 525, 45 Wkly. Rep. 474; *Longbottom v. Shaw*, 43 Ch. D. 46, 58 L. J. Ch. 734, 61 L. T. Rep. N. S. 325, 37 Wkly. Rep. 792; *Honiball v. Bloomer*, 3 C. L. R. 167, 10 Exch. 538, 1 Jur. N. S. 188, 24 L. J. Exch. 11, 3 Wkly. Rep. 71; *Gillett v. Wilby*, 9 C. & P. 334, 38 E. C. L. 201; *Needham v. Oxley*, 8 L. T. Rep. N. S. 604, 2 New Rep. 388, 11 Wkly. Rep. 852. A party is not entitled to costs on issues decided against him. *Phillips v. Ivel Cycle Co.*, 62 L. T. Rep. N. S. 392. Division of costs see *Losche v. Hague*, 7 Dowl. P. C. 495, 3 Jur. 409, 8 L. J. Exch. 251, 5 M. & W. 387. A certificate that particulars of objection were proved or were reasonable may be given by appellate court. *Cole v. Saqui*, 40 Ch. D. 132, 58 L. J. Ch. 237, 59 L. T. Rep. N. S. 877, 37 Wkly. Rep. 109; *Germ Milling Co. v. Robinson*, 55 L. T. Rep. N. S. 282. A certificate is necessary only where there was an actual trial and not where suit was discontinued. *Curtis v. Platt*, 16 C. B. N. S. 465, 10 Jur. N. S. 823, 33 L. J. C. P. 255, 10 L. T. Rep. N. S. 383, 111 E. C. L. 465; *Greaves v. Eastern R. Co.*, 1 E. & E. 961, 5 Jur. N. S. 733, 28 L. J. Q. B. 290, 7 Wkly. Rep. 453, 102 E. C. L. 961. Certificate that the validity of the patent came in question see *Gillett v. Green*, 9 Dowl. P. C. 219, 10 L. J. Exch. 124, 7 M. & W. 347; *Haslem Co. v. Hall*, 5 Rep. Pat. Cas. 1, 23; *American Steel, etc., Co. v. Glover*, 50 Wkly. Rep. 284. No certificate that validity came in question will be given for defendant. *Badische Anilin, etc., Fabrik v. Levinstein*, 29 Ch. D. 366, 53 L. T. Rep. N. S. 750. Certificate refused see *Wilcox v. Janes*, [1897] 2 Ch. 71, 66 L. J. Ch. 525, 45 Wkly. Rep. 474; *Longbottom v. Shaw*, 43 Ch. D. 46, 58 L. J. Ch. 734, 61 L. T. Rep. N. S. 325, 37 Wkly. Rep. 792; *United Tel. Co. v. Harrison*, 21 Ch. D. 720, 51 L. J. Ch. 705, 46 L. T. Rep. N. S. 620, 30 Wkly. Rep. 724; *Bovill v. Hadley*, 17 C. B. N. S. 435, 10 L. T. Rep. N. S. 650, 112 E. C. L. 435; *Stocker v. Rodgers*, 1 C. & K. 99, 47 E. C. L. 99. Cost on amendment see *Edison Tel. Co. v. India Rubber Co.*, 17 Ch. D. 137, 29 Wkly. Rep. 496; *Penn v. Bebbly*, L. R. 1 Eq. 548. Case may be continued to settle costs. *Geary v. Norton*, 1 De G. & Sm. 9, 63 Eng. Reprint 949.

Canadian practice.—Treble costs may be allowed in Canada. *Huntingdon v. Lutz*, 10 Can. L. J. 46; *Hunter v. Carrick*, 28 Grant Ch. (U. C.) 489.

79. Metallic Extraction Co. v. Brown, 110 Fed. 665, 49 C. C. A. 147; *Thomson-Houston Electric Co. v. Elmira, etc., R. Co.*, 71 Fed. 886; *Stewart v. Mahoney*, 5 Fed. 302; *Yale, etc., Mfg. Co. v. North*, 30 Fed. Cas. No. 18,123, 5 Blatchf. 455, 3 Fish. Pat. Cas. 279.



the discretion of the court.<sup>80</sup> The ordinary rules as to what constitute taxable costs apply.<sup>81</sup> They do not include copies of patents, record, and exhibit models.<sup>82</sup>

**20. APPEAL AND ERROR**<sup>83</sup>—**a. In Actions at Law.** Any final judgment at law in a patent suit may be reviewed by the circuit court of appeal by writ of error,<sup>84</sup> but the judgment of the court of appeals in patent matters is final and not reviewable by the supreme court except by certification by the court of appeals or by writ of certiorari from the supreme court.<sup>85</sup>

**b. In Suits in Equity**—(i) **FINAL DECREE.** An appeal may be taken to the circuit court of appeals from any final decree in a patent suit if taken within six months after the entry of the decree.<sup>86</sup>

(ii) **INTERLOCUTORY DECREE.** An appeal may be taken to the court of

*Compare* Pennsylvania Diamond Drill Co. v. Simpson, 29 Fed. 288, where one patent void, costs divided.

**Disclaimer.**—No costs will be allowed unless proper disclaimer was filed before suit. *O'Reilly v. Morse*, 15 How. (U. S.) 62, 14 L. ed. 601; *General Electric Co. v. Crouse-Hinds Electric Co.*, 147 Fed. 718; *Fairbanks v. Stickney*, 123 Fed. 79, 59 C. C. A. 209; *Worden v. Searls*, 21 Fed. 406; *Munday v. Lidgerwood Mfg. Co.*, 20 Fed. 191; *Proctor v. Brill*, 16 Fed. 791; *Sharp v. Tift*, 2 Fed. 697, 18 Blatchf. 132; *Aiken v. Dolan*, 1 Fed. Cas. No. 110, 3 Fish. Pat. Cas. 197; *Christman v. Rumsey*, 5 Fed. Cas. No. 2,704, 4 Ban. & A. 506, 17 Blatchf. 148, 17 Off. Gaz. 903, 58 How. Pr. (N. Y.) 114; *Myers v. Frame*, 17 Fed. Cas. No. 9,991, 8 Blatchf. 446, 4 Fish. Pat. Cas. 493; *Taylor v. Archer*, 23 Fed. Cas. No. 13,778, 8 Blatchf. 315, 4 Fish. Pat. Cas. 449. The rule against costs without disclaimer applies only to the claims in issue in the suit. *National Electric Signaling Co. v. De Forest Wireless Tel. Co.*, 140 Fed. 449; *Gamewell Fire-Alarm Tel. Co. v. Municipal Signal Co.*, 77 Fed. 490, 23 C. C. A. 250; *American Bell Tel. Co. v. Spencer*, 8 Fed. 509. The rule applies only to the lower court and not to the costs on appeal. *Kahn v. Starrels*, 136 Fed. 597, 69 C. C. A. 371.

*80. Dobson v. Bigelow Carpet Co.*, 114 U. S. 439, 5 S. Ct. 945, 29 L. ed. 177 [*reversing* 10 Fed. 385]; *Ide v. Trorlicht, etc., Carpet Co.*, 115 Fed. 137, 53 C. C. A. 341; *Brill v. Delaware County, etc., R. Co.*, 109 Fed. 901; *Tesla Electric Co. v. Scott*, 101 Fed. 524; *Fisk v. West Bradley, etc., Mfg. Co.*, 9 Fed. Cas. No. 4,830a, 19 Off. Gaz. 545; *Garretson v. Clark*, 10 Fed. Cas. No. 5,250, 4 Ban. & A. 536, 16 Off. Gaz. 806, 10 Fed. Cas. No. 5,248, 3 Ban. & A. 352, 15 Blatchf. 70, 14 Off. Gaz. 485 [*affirmed* in 111 U. S. 120, 4 S. Ct. 291, 28 L. ed. 371]; *Troy Iron, etc., Factory Co. v. Corning*, 24 Fed. Cas. No. 14,198, 10 Blatchf. 223, 6 Fish. Pat. Cas. 85.

*81. Parks v. Booth*, 102 U. S. 96, 26 L. ed. 54.

The costs of the reference to the master for an account of profits and damages are assessed. *Kansas City Hay Press Co. v. Devol*, 127 Fed. 363; *Hill v. Smith*, 32 Fed. 753; *American Diamond Drill Co. v. Sullivan*, 32 Fed. 552, 23 Blatchf. 144; *Everest v. Buffalo Lubricating Oil Co.*, 31 Fed. 742;

*Kirby v. Armstrong*, 5 Fed. 801, 10 Biss. 135.

**82. Ordinary models are not taxable as costs.** *Cornelly v. Markwald*, 24 Fed. 187, 23 Blatchf. 248; *Wooster v. Handy*, 23 Fed. 49, 23 Blatchf. 112; *Parker v. Bigler*, 18 Fed. Cas. No. 10,726, 1 Fish. Pat. Cas. 285. *Contra*, *Hathaway v. Roach*, 11 Fed. Cas. No. 6,213, 2 Woodb. & M. 63.

Model of plaintiff's patent may be taxable but not others. *Wooster v. Handy*, 23 Fed. 49, 23 Blatchf. 112; *Hussey v. Bradley*, 12 Fed. Cas. No. 6,946a, 5 Blatchf. 210; *Woodruff v. Barney*, 30 Fed. Cas. No. 17,986, 1 Bond 528, 2 Fish. Pat. Cas. 244.

Drawings exhibit is not taxable. *Wooster v. Handy*, 23 Fed. 49, 23 Blatchf. 112.

Copies of patents are not taxed. *Ryan v. Gould*, 32 Fed. 754; *Woodruff v. Barney*, 30 Fed. Cas. No. 17,986, 1 Bond 528, 2 Fish. Pat. Cas. 244.

Certified copy of file wrapper of plaintiff's patent is not allowed. *Ryan v. Gould*, 32 Fed. 754.

**English practice.**—Expense of model and scientific witnesses may be allowed. *Batley v. Kynock*, L. R. 20 Eq. 632, 44 L. J. Ch. 565, 33 L. T. Rep. N. S. 45.

**83. See, generally, APPEAL AND ERROR.**

**84. Act March 3, 1891, § 6, 26 U. S. St. at L. 828 [U. S. Comp. St. (1901) p. 549].**

Facts will not be reviewed. *American Sales Book Co. v. Bullivant*, 117 Fed. 255, 54 C. C. A. 287; *Singer Mfg. Co. v. Brill*, 54 Fed. 380, 4 C. C. A. 374.

**85. Act March 3, 1891, § 6, 26 U. S. St. at L. 828 [U. S. Comp. St. (1901) p. 549];** *Columbus Watch Co. v. Robbins*, 148 U. S. 266, 13 S. Ct. 594, 37 L. ed. 445.

**86. Act March 3, 1891, §§ 6, 11, 26 U. S. St. at L. 828, 829 [U. S. Comp. St. (1901) pp. 549, 552].**

Final and interlocutory decrees distinguished and authorities reviewed see *Standard Elevator Co. v. Crane Elevator Co.*, 76 Fed. 767, 22 C. C. A. 549.

**Evidence considered.**—Patents set up in the answer in a suit for infringement as a part of the prior art, printed and indexed in the record on appeal, and referred to in the briefs, and in relation to which witnesses were examined, all without objection, will not be excluded from consideration by the appellate court because they were not formally marked as exhibits by the examiner. *Smyth*



appeals from an interlocutory order or decree granting, continuing, or refusing to dissolve an injunction.<sup>87</sup> Such appeal must be taken within thirty days and is

*Mfg. Co. v. Sheridan*, 149 Fed. 208, 79 C. C. A. 166.

87. Act March 3, 1891, § 7, 26 U. S. St. at L. 828 [U. S. Comp. St. (1901) p. 550].

A decree finding some of the claims of a patent valid and others invalid, awarding a perpetual injunction and referring the cause to a master to determine profits is, although termed an interlocutory decree, final to the extent that it will permit cross appeals. *Chicago Wooden Ware Co. v. Miller Ladder Co.*, 133 Fed. 541, 66 C. C. A. 517. And see *Lockwood v. Wickes*, 75 Fed. 118, 21 C. C. A. 257; *Columbus Watch Co. v. Robbins*, 52 Fed. 337, 3 C. C. A. 103; *Reeves v. Keystone Bridge Co.*, 20 Fed. Cas. No. 11,661, 2 Ban. & A. 256, 9 Off. Gaz. 885, 11 Phila. (Pa.) 498. *Contra*, *Thomson-Houston Electric Co. v. Nassau Electric R. Co.*, 112 Fed. 676, 50 C. C. A. 421; *Marden v. Campbell Printing-Press, etc., Co.*, 67 Fed. 809, 15 C. C. A. 26.

**Who may appeal.**—Licensee who joins patentee with him as complainant may appeal without consent of patentee. *Excelsior Wooden Pipe Co. v. Seattle*, 117 Fed. 140, 55 C. C. A. 156.

**Appealable decisions.**—Overruling motion to dismiss as to one complainant is a final decision and appealable. *Brush Electric Co. v. Electric Imp. Co.*, 51 Fed. 557, 2 C. C. A. 373. Award to complainant of part of fine imposed on defendant for contempt is appealable. *Christensen Engineering Co. v. Westinghouse Air Brake Co.*, 135 Fed. 774, 68 C. C. A. 476. Appeal lies from an interlocutory decree granting a perpetual injunction and an account of damages. *Richmond v. Atwood*, 52 Fed. 10, 2 C. C. A. 596, 17 L. R. A. 615; *Dudley E. Jones Co. v. Munger Improved Cotton Mach. Mfg. Co.*, 50 Fed. 785, 1 C. C. A. 668. Refusal of a rehearing is not appealable. *Boston, etc., R. Co. v. Pullman's Palace Car Co.*, 51 Fed. 305, 2 C. C. A. 172. Refusal to permit disclaimer after decision is not appealable. *Roemer v. Neumann*, 132 U. S. 103, 10 S. Ct. 12, 33 L. ed. 277. An order vacating service of process is not a final decree. *L. E. Waterman Co. v. Parker Pen Co.*, 107 Fed. 141, 46 C. C. A. 203. No appeal is allowed to settle costs. *Gamewell Fire-Alarm Tel. Co. v. Municipal Signal Co.*, 77 Fed. 490, 23 C. C. A. 250. Alternative order granting injunction or requiring bond will not be reviewed on appeal. *Union Blue-Flame Oil Stove Co. v. Silver*, 128 Fed. 925, 63 C. C. A. 110; *Stearns-Roger Mfg. Co. v. Brown*, 114 Fed. 939, 52 C. C. A. 559.

**Dismissal.**—One of several appellants cannot dismiss an appeal. *Marsh v. Nichols*, 120 U. S. 598, 7 S. Ct. 704, 30 L. ed. 796.

New evidence cannot be introduced after appeal even by stipulation. *F. C. Austin Mfg. Co. v. American Wellworks*, 121 Fed. 76, 57 C. C. A. 330.

**Amendment.**—Where a decree dismissing a bill is affirmed permission to amend not al-

lowed. *Martin, etc., Cash-Carrier Co. v. Martin*, 71 Fed. 519, 18 C. C. A. 234; *American Bell Tel. Co. v. U. S.*, 68 Fed. 542, 15 C. C. A. 569.

**Ruling on interlocutory appeal followed on appeal from final decree** see *Cimiotti Unhairing Co. v. Nearsal Unhairing Co.*, 123 Fed. 479, 59 C. C. A. 58.

**Questions considered on appeal.**—The court will not consider points not made below. *Lane v. Levi*, 21 App. Cas. (D. C.) 168. A pleading cannot be objected to as insufficient for the first time on appeal. *Smith, etc., Mfg. Co. v. Mellon*, 58 Fed. 705, 7 C. C. A. 439.

**Refusal to increase damages** will not be disturbed on appeal. *Topliff v. Topliff*, 145 U. S. 156, 12 S. Ct. 825, 36 L. ed. 658; *Kissinger-Ison Co. v. Bradford Belting Co.*, 123 Fed. 91, 59 C. C. A. 221. An appeal on interlocutory decree raises no question as to damages recoverable. *Metallic Extraction Co. v. Brown*, 104 Fed. 345, 43 C. C. A. 568. The court will not consider patents on which injunction was refused. *Diamond State Iron Co. v. Goldie*, 84 Fed. 972, 28 C. C. A. 589.

**Scope of review and disposition of appeal.**—While the court may review the merits of the entire case upon the record before it and in a clear case may order the dismissal of the bill (*Co-operating Merchants' Co. v. Hallock*, 128 Fed. 596, 64 C. C. A. 104; *Marden v. Campbell Printing-Press, etc., Mfg. Co.*, 67 Fed. 809, 15 C. C. A. 26; *Gamewell Fire-Alarm Tel. Co. v. Municipal Signal Co.*, 61 Fed. 208, 9 C. C. A. 450; *Curtis v. Overman Wheel Co.*, 58 Fed. 784, 7 C. C. A. 493; *Consolidated Piedmont Cable Co. v. Pacific Cable R. Co.*, 58 Fed. 226, 7 C. C. A. 195; *American Paper Pail, etc., Co. v. National Folding Box, etc., Co.*, 51 Fed. 229, 2 C. C. A. 165; *Dudley E. Jones Co. v. Munger Improved Cotton Mach. Mfg. Co.*, 50 Fed. 785, 1 C. C. A. 668), on appeal from an order granting a preliminary injunction the court of appeals will not review the merits of the entire case, but only whether the injunction was improvidently granted (*Adam v. Folger*, 120 Fed. 260, 56 C. C. A. 540; *Kilmer Mfg. Co. v. Griswold*, 67 Fed. 1017, 15 C. C. A. 161; *Jensen v. Norton*, 64 Fed. 662, 12 C. C. A. 608; *Hart v. Buckner*, 54 Fed. 925, 5 C. C. A. 1; *Blount v. Societe Anonyme, etc.*, 53 Fed. 98, 3 C. C. A. 455; *Columbus Watch Co. v. Robbins*, 52 Fed. 337, 3 C. C. A. 103). An interlocutory order granting a preliminary injunction will not be reversed except where there was an abuse of discretion. *F. C. Austin Mfg. Co. v. American Wellworks*, 121 Fed. 76, 57 C. C. A. 330; *American Fur Refining Co. v. Cimiotti Unhairing Co.*, 118 Fed. 838, 55 C. C. A. 513; *Loew Filter Co. v. German-American Filter Co.*, 107 Fed. 949, 47 C. C. A. 94; *Pacific Steam Whaling Co. v. Alaska Packers' Assoc.*, 100 Fed. 462, 40 C. C. A. 494; *Société*



given precedence in the appellate court.<sup>88</sup> Supersedeas on appeal will be granted only under special circumstances.<sup>89</sup>

**21. REHEARING.** The ordinary rules against rehearings except under exceptional circumstances are strictly applied in suits for infringement,<sup>90</sup> and the granting thereof rests in the discretion of the court.<sup>91</sup> Whether a rehearing will be granted depends on the facts of each case and the effect which the granting or refusal of the application will have on the rights of the parties respectively.<sup>92</sup> While under certain circumstances a rehearing may be granted upon discovery of new evidence,<sup>93</sup> it will not be granted upon discovery of new evidence which as far as appears was accessible and should have been produced originally,<sup>94</sup> nor where the new evidence is not clear and satisfactory and such as would have changed the decision.<sup>95</sup> As a condition of granting a rehearing the court may require the

*Anonyme, etc. v. Allen*, 90 Fed. 815, 33 C. C. A. 282. Where the patent has expired, an appeal on an interlocutory decree granting an injunction will be dismissed. *National Folding-Box, etc., Co. v. Robertson*, 104 Fed. 552, 44 C. C. A. 29; *Lockwood v. Wickes*, 75 Fed. 118, 21 C. C. A. 257; *Gamewell Fire-Alarm Tel. Co. v. Municipal Signal Co.*, 61 Fed. 208, 9 C. C. A. 450. Questions considered from the standpoint of the lower court and adjudications in other circuits sustaining the patent have the same weight upon appeal as below. *Consolidated Fastener Co. v. Hays*, 100 Fed. 984; *Consolidated Fastener Co. v. Littauer*, 84 Fed. 164, 28 C. C. A. 133; *Thomson-Houston Electric Co. v. Ohio Brass Co.*, 80 Fed. 712, 26 C. C. A. 107; *Bresnahan v. Tripp Grant Leveller Co.*, 72 Fed. 920, 19 C. C. A. 237; *Duplex Printing-Press Co. v. Campbell Printing-Press, etc., Mfg. Co.*, 69 Fed. 250, 16 C. C. A. 220; *American Paper Pail, etc., Co. v. National Folding Box, etc., Co.*, 51 Fed. 229, 2 C. C. A. 165. The court of appeals is not bound by adjudications in other circuits relied on by court below. *Stover Mfg. Co. v. Mast*, 89 Fed. 333, 32 C. C. A. 231; *Thomson-Houston Electric Co. v. Hoosick R. Co.*, 82 Fed. 461, 27 C. C. A. 419. A finding as to the fact of infringement will not be disturbed where there is evidence in the record tending to show infringement. *Dobson v. Dornan*, 118 U. S. 10, 6 S. Ct. 946, 30 L. ed. 63.

<sup>88.</sup> Act March 3, 1891, § 7, 26 U. S. St. at L. 828 [U. S. Comp. St. (1901) p. 550]; *Raymond v. Royal Baking-Powder Co.*, 76 Fed. 465, 22 C. C. A. 276.

<sup>89.</sup> *Timolat v. Philadelphia Pneumatic Tool Co.*, 130 Fed. 903; *Edison v. American Muto-scope Co.*, 110 Fed. 664 [reversed on other grounds in 114 Fed. 926, 52 C. C. A. 546]; *Thomson-Houston Electric Co. v. Ohio Brass Co.*, 78 Fed. 142; *National Heeling-Mach. Co. v. Abbott*, 77 Fed. 462. And see *Penn v. Bibby*, L. R. 3 Eq. 308, 36 L. J. Ch. 277, 15 Wkly. Rep. 192; *Lister v. Leather*, 3 Jur. N. S. 433, 5 Wkly. Rep. 550; *Flower v. Lloyd*, 36 L. T. Rep. N. S. 444.

<sup>90.</sup> Operation of supersedeas.—An appeal with supersedeas does not operate as a license to continue infringement. *Bissell Carpet-Sweeper Co. v. Goshen Sweeper Co.*, 72 Fed. 545, 19 C. C. A. 25.

<sup>91.</sup> *In re Gamewell Fire-Alarm Tel. Co.*, 73

Fed. 908, 20 C. C. A. 111; *Searls v. Worden*, 11 Fed. 501.

For cases in which rehearing granted see *Campbell Printing-Press, etc., Co. v. Marden*, 70 Fed. 339; *Campbell v. New York*, 36 Fed. 260; *American Diamond Rock-Boring Co. v. Sheldons*, 24 Fed. 374, 23 Blatchf. 286; *Schneider v. Thill*, 21 Fed. Cas. No. 12,470b, 5 Ban. & A. 595.

<sup>91.</sup> *American Diamond Rock-Boring Co. v. Sheldon*, 1 Fed. 870, 18 Blatchf. 50.

After appeal, rehearing cannot be granted except by permission of the appellate court. *In re Potts*, 166 U. S. 263, 17 S. Ct. 520, 41 L. ed. 994; *American Soda Fountain Co. v. Sample*, 136 Fed. 857, 70 C. C. A. 415 [reversing 134 Fed. 402]; *Nutter v. Mossberg*, 118 Fed. 168.

<sup>92.</sup> *Pittsburgh Reduction Co. v. Cowles Electric Smelting, etc., Co.*, 121 Fed. 556.

<sup>93.</sup> *Diamond Drill, etc., Co. v. Kelley*, 138 Fed. 833 (evidence not accessible by the use of diligence); *Thomson-Houston Electric Co. v. Nassau Electric R. Co.*, 110 Fed. 646 (evidence not accessible by the use of diligence); *Webster Loom Co. v. Higgins*, 43 Fed. 673; *Johnson v. Beard*, 13 Fed. Cas. No. 7,371, 2 Ban. & A. 50, 8 Off. Gaz. 435; *Holste v. Robertson*, 4 Ch. D. 9, 46 L. J. Ch. 1, 35 L. T. Rep. N. S. 457, 25 Wkly. Rep. 35; *Wilson v. Gann*, 23 Wkly. Rep. 546.

<sup>94.</sup> *Panzl v. Battle Island Paper Co.*, 132 Fed. 607 [reversed on other grounds in 138 Fed. 48, 70 C. C. A. 474]; *Brill v. North Jersey St. R. Co.*, 125 Fed. 526; *Bliss v. Reed*, 113 Fed. 946; *Municipal Signal Co. v. National Electrical Mfg. Co.*, 97 Fed. 810; *New York Filter Co. v. O. H. Jewell Filter Co.*, 62 Fed. 582; *Electrical Accumulator Co. v. Julien Electric Co.*, 39 Fed. 490; *New York Grape Sugar Co. v. American Grape Sugar Co.*, 35 Fed. 212; *Burdsall v. Curran*, 31 Fed. 918; *Albany Steam Trap Co. v. Felthousen*, 26 Fed. 318; *Peterson v. Simpkins*, 25 Fed. 486; *Andrews v. Denslow*, 1 Fed. Cas. No. 372, 2 Ban. & A. 587, 14 Blatchf. 182; *De Florez v. Reynolds*, 7 Fed. Cas. No. 3,743, 4 Ban. & A. 331, 16 Blatchf. 397; *Nutter v. Rodgers*, 18 Fed. Cas. No. 10,393.

<sup>95.</sup> *Laches* bars the right to a rehearing. *Norton v. Walsh*, 49 Fed. 769.

<sup>95.</sup> *Sacks v. Brooks*, 85 Fed. 970; *Stuart v. St. Paul*, 63 Fed. 644; *Celluloid Mfg. Co. v. American Zylonite Co.*, 27 Fed. 750; *Ameri-*



moving party to pay his opponent's counsel fee for the previous argument,<sup>96</sup> or give an undertaking to pay the expense of additional testimony.<sup>97</sup>

**D. Threats of Suit.** Suit may be maintained by a manufacturer to enjoin a patentee from making baseless threats of suit for infringement against his customers,<sup>98</sup> but an injunction will not be granted where there is a reasonable doubt as to the propriety of defendant's actions.<sup>99</sup>

**E. Operation and Effect of Decision**<sup>1</sup>—1. IN GENERAL. The decision by a

can Bell Tel. Co. v. People's Tel. Co., 25 Fed. 725 [affirmed in 126 U. S. 1, 8 S. Ct. 778, 31 L. ed. 863]; Hayes v. Dayton, 20 Fed. 690; Robinson v. Sutter, 11 Fed. 798; Collins Co. v. Coes, 8 Fed. 517; Adair v. Thayer, 7 Fed. 920; Blandy v. Griffith, 3 Fed. Cas. No. 1,530, 6 Fish. Pat. Cas. 434; Hitchcock v. Tremaine, 12 Fed. Cas. No. 6,540, 9 Blatchf. 550, 5 Fish. Pat. Cas. 537, 1 Off. Gaz. 633; Kerosene Lamp Co. v. Littell, 14 Fed. Cas. No. 7,723.

96. Hake v. Brown, 44 Fed. 283.

97. Underwood v. Gerber, 37 Fed. 796, 2 L. R. A. 357.

98. Columbia Nat. Sand Dredging Co. v. Miller, 20 App. Cas. (D. C.) 245; Murjahn v. Hall, 119 Fed. 186; Farquhar Co. v. National Co., 102 Fed. 714, 42 C. C. A. 600, 49 L. R. A. 755; Computing Scale Co. v. National Computing Scale Co., 79 Fed. 962; Emack v. Kane, 34 Fed. 46. The action of a patentee in harassing purchasers with threats of litigation does not commend itself to a court of equity. American Fibre-Chamois Co. v. Port Huron Fibre-Garment Mfg. Co., 72 Fed. 516, 18 C. C. A. 670.

**English practice.**—Douglass v. Pintsch's Patent Lighting Co., [1897] 1 Ch. 176, 65 L. J. Ch. 919, 75 L. T. Rep. N. S. 332, 45 Wkly. Rep. 108; Fenner v. Wilson, [1893] 2 Ch. 656, 62 L. T. Ch. 984, 3 Reports 629, 68 L. T. Rep. N. S. 748, 42 Wkly. Rep. 57; Johnson v. Edge, [1892] 2 Ch. 1, 61 L. J. Ch. 262, 66 L. T. Rep. N. S. 44, 40 Wkly. Rep. 437; Axmann v. Lund, L. R. 18 Eq. 330, 43 L. J. Ch. 655, 31 L. T. Rep. N. S. 119, 22 Wkly. Rep. 789; Ellam v. Martyn, 68 L. J. Ch. 123, 79 L. T. Rep. N. S. 510, 47 Wkly. Rep. 212; Kurtz v. Spence, 57 L. J. Ch. 238, 58 L. T. Rep. N. S. 438; Fusee Vesta Co. v. Bryant, 56 L. T. Rep. N. S. 136. Threats must be followed with due diligence by suit or injunction granted. Colley v. Hart, 44 Ch. D. 179, 59 L. J. Ch. 308, 62 L. T. Rep. N. S. 424, 38 Wkly. Rep. 501; Challender v. Royle, 36 Ch. D. 425, 56 L. J. Ch. 995, 57 L. T. Rep. N. S. 734, 36 Wkly. Rep. 357; Rollins v. Hinks, L. R. 13 Eq. 355, 41 L. J. Ch. 358, 26 L. T. Rep. N. S. 56, 20 Wkly. Rep. 287; Household v. Fairburn, 51 L. T. Rep. N. S. 498. Filing suit promptly is a complete defense. Barrett v. Day, 43 Ch. D. 435, 59 L. J. Ch. 464, 62 L. T. Rep. N. S. 597, 38 Wkly. Rep. 362; Dunlop Pneumatic Tyre Co. v. New Seddon Pneumatic Tyre, etc., Co., 76 L. T. Rep. N. S. 405; Haskell Golf Ball Co. v. Hutchinson, 20 T. L. R. 606. Suit against third party is no defense. Combined Weighing Co. v. Automatic Weighing Mach. Co., 42 Ch. D. 665, 58 L. J. Ch. 709, 61 L. T. Rep. N. S. 474; Goulard v. Lindsay, 56 L. T. Rep. N. S. 506.

Suit must be against party threatened. Kensington, etc., Electric Lighting Co. v. Lane Fox Electrical Co., [1891] 2 Ch. 573, 64 L. T. Rep. N. S. 770, 39 Wkly. Rep. 650. Injunction will be refused where there is actual infringement. Barney v. United Tel. Co., 28 Ch. D. 394, 52 L. T. Rep. N. S. 573, 33 Wkly. Rep. 576; Incandescent Gas Light Co. v. New Incandescent Gas Light Co., 76 L. T. Rep. N. S. 47; Burnett v. Tak, 45 L. T. Rep. N. S. 743. *Contra*, Walker v. Clarke, 56 L. J. Ch. 239, 56 L. T. Rep. N. S. 111, 35 Wkly. Rep. 245. The validity of the patent is not in issue but only infringement. Kurtz v. Spence, 33 Ch. D. 579, 55 L. J. Ch. 919, 55 L. T. Rep. N. S. 317, 35 Wkly. Rep. 26 [affirmed in 36 Ch. D. 770, 58 L. T. Rep. N. S. 320, 36 Wkly. Rep. 438]. Threats in letters enjoined see Skinner v. Shew, [1893] 1 Ch. 413, 62 L. J. Ch. 196, 67 L. T. Rep. N. S. 696, 2 Reports 179, 41 Wkly. Rep. 217; Driffield, etc., Pure Linseed Cake Co. v. Waterloo Mills Cake, etc., Co., 31 Ch. D. 638, 55 L. J. Ch. 391, 54 L. T. Rep. N. S. 210, 34 Wkly. Rep. 360. Injunction refused where mere trade circular in good faith. Société Anonyme v. Tilghman's Patent Sand Blast Co., 25 Ch. D. 1, 53 L. J. Ch. 1, 49 L. T. Rep. N. S. 451, 32 Wkly. Rep. 71; Halsey v. Brotherhood, 15 Ch. D. 514, 49 L. J. Ch. 786, 43 L. T. Rep. N. S. 366, 29 Wkly. Rep. 9 [affirmed in 19 Ch. D. 386, 51 L. J. Ch. 233, 45 L. T. Rep. N. S. 640, 30 Wkly. Rep. 279]. Defendant must give particulars in support of threats. Union Electrical Power, etc., Co. v. Electrical Storage Co., 38 Ch. D. 325, 59 L. T. Rep. N. S. 427, 36 Wkly. Rep. 913; Wren v. Weild, L. R. 4 Q. B. 213, 38 L. J. Q. B. 88, 20 L. T. Rep. N. S. 277. May recover damages for threats where actual loss shown. Skinner v. Shew, [1894] 2 Ch. 581, 63 L. J. Ch. 826, 71 L. T. Rep. N. S. 110, 8 Reports 455.

99. Boston Diatiti Co. v. Florence Mfg. Co., 114 Mass. 69, 19 Am. Rep. 310; Hovey v. Rubber Tip Pencil Co., 33 N. Y. Super. Ct. 522 [affirmed in 57 N. Y. 119, 15 Am. Rep. 470]; Adriance v. National Harrow Co., 121 Fed. 827, 58 C. C. A. 163; Davison v. National Harrow Co., 103 Fed. 360; Computing Scale Co. v. National Computing Scale Co., 79 Fed. 962; New York Filter Co. v. Schwarzwald, 58 Fed. 577; Kelley v. Ypsilanti Dress-Stay Mfg. Co., 44 Fed. 19, 10 L. R. A. 686; Westinghouse Air-Brake Co. v. Carpenter, 32 Fed. 545; Baltimore Car Wheel Co. v. Bemis, 29 Fed. 95; Chase v. Tuttle, 27 Fed. 110; Pentlarge v. Pentlarge, 19 Fed. Cas. No. 10,965a, 14 Reporter 579.

1. See, generally, JUDGMENTS, 23 Cyc. 1106 *et seq.*



court of competent jurisdiction in a suit on letters patent is conclusive upon the parties to such suit and their privies.<sup>2</sup> The character of conclusiveness attaches only to final judgments or decrees,<sup>3</sup> and to those in which the validity of the patent was decided,<sup>4</sup> and it must appear that the judgment or decree was rendered after full consideration of the merits of the case.<sup>5</sup> While a judgment sustaining the validity of a patent does not operate as *res adjudicata* in a suit on the same patent against a different defendant,<sup>6</sup> respect for the stability of a judicial deci-

**Effect of previous adjudications upon granting of preliminary injunctions** see *supra*, XII, E, 4, b, (iv).

2. Westinghouse Electric, etc., Co. v. Stanley Electric Mfg. Co., 117 Fed. 309; Simonds Counter Mach. Co. v. Knox, 39 Fed. 702; McCloskey v. Hamill, 15 Fed. 750; Crandall v. Dare, 11 Fed. 902; Meyer v. Goodyear India-Rubber Glove Mfg. Co., 11 Fed. 891, 20 Blatchf. 91; Shoe Mach. Co. v. Cultan, [1896] 1 Ch. 667, 65 L. J. Ch. 314, 74 L. T. Rep. N. S. 166. *Compare* New Departure Bell Co. v. Hardware Specialty Co., 69 Fed. 152; Simonds Counter Mach. Co. v. Knox, 39 Fed. 702.

**Effect of sale of interest pending suit.**—The finding of the decree is binding upon the respondent in an infringement suit where he sold out his interest in the infringing business pending the hearing and gave up to his vendee the control and management of the suit. Gloucester Isinglass, etc., Co. v. Le Page, 30 Fed. 370.

Where a suit for infringement against a dealer is defended by the manufacturer at his own cost, the latter is bound by the decision in the case (*Sacks v. Kupferle*, 127 Fed. 569; *National Folding-Box, etc., Co. v. Dayton Paper-Noveltty Co.*, 95 Fed. 991), not only upon all the questions that were raised and determined in the suit, but also upon all that might have been raised and determined therein (*Eagle Mfg. Co. v. David Bradley Mfg. Co.*, 50 Fed. 193). But it has been held that the defense of prior adjudication is not available to a defendant, dismissed from a suit for infringement on its own application, on the ground that it employed counsel and defrayed the costs of the defense made by its co-defendant, unless it appears by clear and definite evidence that such fact was known to plaintiff. *Singer Mfg. Co. v. Cramer*, 109 Fed. 652, 48 C. C. A. 588.

If a reissued patent is for the same invention as that described in the original patent, a former decision is conclusive on the question of infringement. *Cammeyer v. Newton*, 4 Fed. Cas. No. 2,344, 4 Ban. & A. 159, 16 Off. Gaz. 720. *Contra*, *Wells v. Jacques*, 29 Fed. Cas. No. 17,398, 1 Ban. & A. 60, 5 Off. Gaz. 364.

The authority of a prior decision by an appellate court is not limited to the facts and defenses discussed in its opinion, but extends to all that were before it in the record. *Badische Anilin, etc., Fabrik v. Klipstein, etc.*, Co., 125 Fed. 543.

A decree as to what is an infringement is conclusive upon the parties and upon the master, and extends to everything sub-

stantially like the infringement decreed against. *Wooster v. Thornton*, 26 Fed. 274.

3. An interlocutory decree in an infringement suit does not render the validity of the patent *res adjudicata*. *Rumford Chemical Works v. Hecker*, 20 Fed. Cas. No. 12,133, 2 Ban. & A. 351, 10 Off. Gaz. 289, holding, however, that it does not follow that the controversy between the litigants remains open as it would have remained if there had been no previous adjudication. A decree in a prior suit for the infringement of a patent is none the less conclusive between the parties on the issues of validity and infringement because it was merely interlocutory, when the second suit was commenced, where it is set up therein as an adjudication by a supplemental bill, after having ripened into a final decree. *Bredin v. National Metal Weatherstrip Co.*, 147 Fed. 741 [*affirmed* in 157 Fed. 1003].

4. *Leonard v. Simplex Electric Heating Co.*, 145 Fed. 946.

5. *Steam-Gauge, etc., Co. v. Meyrose*, 27 Fed. 213; *Celluloid Mfg. Co. v. Tower*, 26 Fed. 451.

Where, in a suit for infringement, the bill is dismissed because of failure to show any infringement, the decree dismissing the bill will not estop plaintiff or his assigns from again suing the same defendant for infringing the same patent. *Steam-Gauge, etc., Co. v. Meyrose*, 27 Fed. 213.

A suit dismissed without prejudice is not a bar to a second suit, nor conclusive of any issue joined in favor of the complainant. *Robinson v. American Car, etc., Co.*, 135 Fed. 693, 68 C. C. A. 331.

The overruling of a demurrer which defendant refused to argue is not an adjudication in favor of patentability. *Wollensak v. Sargent*, 33 Fed. 840.

A decree pro confesso on a bill for infringement is conclusive so far at least as it is supported by the allegations of the bill. *Thomson v. Wooster*, 114 U. S. 104, 5 S. Ct. 788, 29 L. ed. 105. *Compare* *Everett v. Thatcher*, 8 Fed. Cas. No. 4,578, 3 Ban. & A. 435, 2 Flipp. 234, 16 Off. Gaz. 1046.

6. *Truman v. Carvill Mfg. Co.*, 87 Fed. 470; *Boyden Power-Brake Co. v. Westinghouse Air-Brake Co.*, 70 Fed. 816, 17 C. C. A. 430; *McMillan v. Conrad*, 16 Fed. 128, 5 McCrary 140.

A judgment for infringement against a manufacturer is not conclusive upon a subsequent purchaser and user of the manufactured articles either as to the validity of the patent or infringement. *Van Epps v. International Paper Co.*, 124 Fed. 542.



sion and a proper regard for the security of property in the same patent require that it shall not be disturbed, unless there was very palpable error.<sup>4</sup>

**2. RECOVERY BY PATENTEE AS VESTING TITLE IN INFRINGER.** A recovery of the profits for the use of a patented article does not vest the title in defendant;<sup>8</sup> but the recovery of profits and damages from the manufacturers of an infringing machine vests the title to the use in the purchaser of the article and debars the patentee from recovering from a user for the use thereof.<sup>9</sup> But this can only be held on a clear showing that the purchaser was using the same patented article as that involved in the suit between the patentee and the infringing manufacturer, and that the user was a vendee of such manufacturer;<sup>10</sup> and it would seem that to effect such a result it must further appear that the patentee's claim to profits and damages against the manufacturer has been actually paid and satisfied.<sup>11</sup>

**PATENT TO LAND.** See MINES AND MINERALS; PUBLIC LANDS.

**PATER EST QUEM NUPTIÆ DEMONSTRANT.** A maxim meaning "The nuptials show who is the father."<sup>1</sup>

**PATER, ET MATER, ET PUER SUNT UNA CARO.** A maxim meaning "The father, mother, and son are of one flesh."<sup>2</sup>

**PATERFAMILIAS OB ALTERIUS CULPAM TENETUR SIVE SERVI SIVE LIBERI.** A maxim meaning "The father is responsible for the misconduct of his child or his slave."<sup>3</sup>

**PATERNITY.** See BASTARDS; PARENT AND CHILD.

**PATH.** A term constantly used in our old acts as synonymous with "road."<sup>4</sup> (See, generally, PRIVATE ROADS; STREETS AND HIGHWAYS.)

**PATHOLOGICAL CONDITION.** A diseased condition of the body.<sup>5</sup> (See PATHOLOGY.)

A servant or agent sued separately for infringing a patent is not bound by a former decision against his principal upon the question of the validity of the patent. *Hayes v. Bickelhaupt*, 24 Fed. 806.

A decree declaring the invalidity of a patent is not a proceeding in rem, and does not prevent the same or another plaintiff from prosecuting a suit against another defendant, and establishing its validity upon the same or different evidence. *Consolidated Roller-Mill Co. v. George & Smith Middlings Purifier Co.*, 40 Fed. 305.

7. *Brill v. Washington R., etc., Co.*, 30 App. Cas. (D. C.) 255; *Voightmann v. Weis, etc., Cornice Co.*, 133 Fed. 298 [affirmed in 148 Fed. 848]; *Walker Patent Pivoted Bin Co. v. Miller*, 132 Fed. 823 [affirmed in 139 Fed. 134, 71 C. C. A. 398]; *Cutler-Hammer Mfg. Co. v. Hammer*, 124 Fed. 222 [affirmed in 128 Fed. 730, 63 C. C. A. 328]; *Rose v. Fretz*, 98 Fed. 112; *Norton v. San José Fruit-Packing Co.*, 83 Fed. 512, 27 C. C. A. 576; *Aeme Harvester Co. v. Forbes*, 69 Fed. 149; *Simonds Counter Mach. Co. v. Knox*, 39 Fed. 702; *Hussey v. Whitley*, 12 Fed. Cas. No. 6,950, 1 Bond 407, 2 Fish. Pat. Cas. 120.

8. *Spaulding v. Page*, 22 Fed. Cas. No. 13,219, 4 Fish. Pat. Cas. 641, 1 Sawy. 702, holding that a recovery based upon this rule of damages can only be for the use of the machine prior to the recovery, and ordinarily does not cover the value of the use for the entire period over which the patent right extends, or the period during which the particular machine is capable of being used. See also *Suffolk Mfg. Co. v. Hayden*,

3 Wall. (U. S.) 315, 18 L. ed. 76; *Tuttle v. Matthews*, 28 Fed. 98.

9. *Steam Stone-Cutter Co. v. Sheldons*, 21 Fed. 875; *Allis v. Stowell*, 16 Fed. 783; *Booth v. Seevers*, 3 Fed. Cas. No. 1,648a, 19 Off. Gaz. 1140; *Perrigo v. Spaulding*, 19 Fed. Cas. No. 10,994, 2 Ban. & A. 348, 13 Blatchf. 389, 12 Off. Gaz. 352; *Spaulding v. Page*, 22 Fed. Cas. No. 13,219, 4 Fish. Pat. Cas. 641, 1 Sawy. 702; *Steam Stonecutter Co. v. Windsor Mfg. Co.*, 22 Fed. Cas. No. 13,335, 4 Ban. & A. 445, 17 Blatchf. 24.

The adoption of the patent fee as the measure of damages for infringement by the use of a machine operates to vest in defendant the right to use the machine during the term of the patent. *Emerson v. Simm*, 8 Fed. Cas. No. 4,443, 6 Fish. Pat. Cas. 281, 3 Off. Gaz. 293; *Sickels v. Borden*, 22 Fed. Cas. No. 12,832, 3 Blatchf. 535.

10. *Allis v. Stowell*, 16 Fed. 783.

11. *Allis v. Stowell*, 16 Fed. 783.

1. *Anderson L. Dict.*

Applied in *Van Aernam v. Van Aernam*, 1 Barb. Ch. (N. Y.) 375, 377; *Woodward v. Blue*, 107 N. C. 407, 408, 12 S. E. 453, 22 Am. St. Rep. 897, 10 L. R. A. 662; *Padel-ford's Estate*, 7 Pa. Dist. 331, 332.

2. *Morgan Leg. Max. [citing Branch Max.]*.

3. *Morgan Leg. Max. [citing Tayler 314]*.

4. *Singleton v. Road Com'rs*, 2 Nott & M. (S. C.) 526, 527.

5. *Bacon v. U. S. Mutual Acc. Assoc.*, 123 N. Y. 304, 311, 25 N. E. 399, 20 Am. St. Rep. 748, 9 L. R. A. 617; *Dozier v. New York Fidelity, etc., Co.*, 46 Fed. 446, 449, 13 L. R. A. 114.







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